

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

165

United States Court of Appeals
for the District of Columbia

FILED AUG 21 1947

Joyce W. Stewart

JOINT APPENDIX

CLERK

United States Court of Appeals

DISTRICT OF COLUMBIA

No. 9574

Lawrence C. Kingland
CASPER W. OOMS, APPELLANT

v.

CARTER CARBURETOR CORPORATION, APPELLEE

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR
THE DISTRICT OF COLUMBIA

W. W. COCHRAN,
Solicitor, U. S. Patent Office,
Attorney for Appellant.

GILBERT P. RITTER,
Attorney for Appellee.

E. L. REYNOLDS,
Of Counsel for Appellant.
HUGH M. MORRIS,
GEORGE B. ERICSON,
Of Counsel for Appellee.

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(I)

United States Court of Appeals

DISTRICT OF COLUMBIA

No. 9574

CASPER W. OOMS, APPELLANT

v.

CARTER CARBURETOR CORPORATION, APPELLEE

*APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR
THE DISTRICT OF COLUMBIA*

JOINT APPENDIX

HMM/B. 1-6. 11/27/46. Filed Nov. 29, 1946. Charles
E. Stewart, Clerk.

In the District Court of the United States for the District of
Columbia

(Civil Action No. 37782)

CARTER CARBURETOR CORPORATION, A CORPORATION OF THE
STATE OF DELAWARE, 2820-56 NORTH SPRING AVENUE, ST.
LOUIS 7, MISSOURI, PLAINTIFF

vs.

CASPER W. OOMS, COMMISSIONER OF PATENTS, DEFENDANT

AMENDED COMPLAINT FOR JUDGMENT IN NATURE OF JUDGMENT
FOR MANDAMUS

No responsive pleading to plaintiff's complaint in the above
entitled action having been served, plaintiff, by authority of
Rule 15 of the Rules of Civil Procedure, amends its complaint
to read as follows:

(1)

1. This action is brought to obtain a judgment adjudging that the order of the Commissioner of Patents, entered July 19, 1946, in Interference No. 82,262, *Hunt vs. Coffey*, reversing, on Hunt's petition, the ruling of the Examiner of Interferences which dismissed Hunt's motion to shift the burden of proof, was made arbitrarily and without authority of law; commanding the Commissioner to set aside said order and to dismiss said petition; and commanding the Commissioner of Patents to order and direct the Examiner of Interferences having charge of said interference and the companion interferences No. 82,554 and No. 82,555, to disregard the purported order of the Commissioner of Patents entered July 19, 1946, and to proceed in said three interferences as if said order of the Commissioner of Patents of July 19, 1946, had not been made or entered.

2. Plaintiff, Carter Carburetor Corporation, is a corporation of the State of Delaware; the defendant, Casper W. Ooms, is the Commissioner of Patents of the United States, is an official resident of the District of Columbia, and is sued in his official capacity as such Commissioner.

3. Jurisdiction of this court is founded upon District of Columbia Code 1940, Title 11, sections 305, 306, 315, and 316.

4. On July 6, 1933, Irvén E. Coffey duly filed in the United States Patent Office an application for patent, Serial No. 679,201, for his invention of a Carburetor, and thereafter on June 29, 1937, letters patent of the United States No. 2,085,351 were issued thereon.

5. Plaintiff is the owner of the entire right, title, and interest in and to said patent No. 2,085,351 and has been the sole owner thereof at all times since said patent was issued.

6. On May 26, 1934, Scott F. Hunt filed in the United States Patent Office an alleged application for patent, Serial No. 727,648, for an invention in Carburetors, which said application is now pending.

7. An interference was duly declared on January 14, 1946, between the Hunt application Serial No. 727,648 and the Coffey patent No. 2,085,351, said interference being identified in the Patent Office as No. 82,262, *Hunt vs. Coffey*, and being now pending therein and no testimony having been taken.

8. Pursuant to the authority of section 483 Revised Statutes (U. S. C., title 35, sec. 6), the Commissioner of Patents, by and with the approval of the Secretary of Commerce, has established regulations, known as Rules of Practice in the United States Patent Office, for the conduct of proceedings in the Patent Office; said rules have the force and effect of

law, and are binding as well upon the Commissioner of Patents and all officials of the Patent Office as upon applicants for patents and parties to interferences.

9. Upon and by its institution and declaration on January 14, 1946, said Interference No. 82,262 became a contested case and jurisdiction thereof vested in the Examiner of Interferences by virtue of the provisions of Rule 101 of the said Rules of Practice, which then was and still is as follows:

"101. Upon the institution and declaration of the interference, as provided in rule 102, the examiner of interferences will take jurisdiction of the same, which will then become a contested case."

10. Rule 116 of the said Rules of Practice (as said Rule was at the time said interference was declared and as it has since remained) provides that:

"The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing the same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts."

11. In and by the said declaration of interference on January 14, 1946 and in conformity with said Rule 116, the party Coffey, whose application for his patent involved in said interference was filed prior to the filing in the Patent Office of the said Hunt application, became the senior party and the party Hunt became the junior party in said interference, and the burden of proof rested upon the junior party Hunt to overcome the presumption that the party Coffey was the prior inventor of the invention defined by the claims in issue in said interference.

12. On May 7, 1946, acting in accordance with the provisions of Rule 116 and Rule 118 of said Rules of Practice, the Examiner of Interferences assigned times for taking testimony in said interference as follows: testimony-in-chief of the junior party Hunt to close June 27, 1946; testimony of the senior party Coffey to close July 27, 1946; and rebuttal testimony of Hunt to close August 13, 1946.

13. On or about April 8, 1946 the party Hunt, acting under the provisions of Rule 122 of said Rules of Practice in the United States Patent Office, moved the Examiner of Interferences to shift the burden of proof in said Interference No. 82262. Plaintiff herein opposed that motion.

14. On June 5, 1946 the Examiner of Interferences dismissed Hunt's said motion to shift the burden of proof "without prejudice to his (Hunt's) right to urge at final hearing that he be given the benefit of the joint application (Hunt & Olson, Serial

No. 575,025) referred to therein." Exhibit A annexed hereto is a true copy of the said decision of June 5, 1946 of the Examiner of Interferences.

15. Rule 122 of said Rules of Practice regulating motions to shift the burden of proof in an interference provides that:

"The matter raised on a motion to shift the burden of proof may be reviewed at final hearing."

which said final hearing is before the Board of Examiners of Interferences upon which jurisdiction to determine the question of priority of invention is conferred by section 4904 Revised Statutes (U. S. C., title 35, sec. 52).

16. Rule 124 of said Rules of Practice is as follows:

"124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

"Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable." [Italics added.]

17. On or about the 14th day of June 1946, the party Hunt petitioned the Commissioner of Patents to review and reverse the ruling of the Examiner of Interferences as of June 5, 1946 dismissing Hunt's motion to shift the burden of proof in said Interference No. 82,262. Exhibit B annexed hereto is a true copy of Hunt's said petition.

18. Thereafter, on July 19, 1946 the Commissioner of Patents, acting through Hon. Thomas F. Murphy, Assistant Commissioner of Patents, granted the aforesaid petition of Hunt "to the extent indicated," whereby it was held that Hunt should be made the senior party in said Interference in that the judgment of the United States District Court for the District of Columbia in Civil Action No. 20,023, Bendix Aviation Corporation v. Coe, was *prima facie* evidence entitling the party Hunt to be awarded the benefit of the filing date of a joint application for patent of Hunt & Olson, Serial No. 575,025, filed November 14, 1931. Exhibit C annexed hereto is a true copy of the said decision of July 19, 1946 of the Assistant Commissioner of Patents.

19. On August 1, 1946 the party Coffey petitioned the Commissioner of Patents to reconsider and vacate the decision of July 19, 1946, of the Assistant Commissioner of Patents and to direct that Interference No. 82,262 be proceeded with in accordance with the said Rules of Practice and that all proceedings in said Interference be stayed pending a decision upon Coffey's petition. Exhibit D annexed hereto is a copy of Coffey's said petition of August 1, 1946.

20. Thereafter, on August 14, 1946, the Commissioner, acting through the said Hon. Thomas F. Murphy, Assistant Commissioner of Patents, denied Coffey's petition of August 1, 1946, holding that the Commissioner of Patents had the power to review and reverse the decision of April 8, 1946 of the Examiner of Interferences, dismissing Hunt's motion to shift the burden of proof, on the ground that:

"Hunt's petition was not considered as an appeal but as a petition to the supervisory authority of the Commissioner, and the action taken on the petition (presented by Hunt on June 14, 1946) was based on such authority."

21. Thereafter on August 29, 1946, the said Coffey presented a further petition to the Commissioner of Patents to vacate and set aside the order of the Commissioner of July 19, 1946, and to dismiss the aforesaid petition filed by Hunt on or about June 14, 1946, said further petition of Coffey showing to the Commissioner that he lacked any authority to make his said order of July 19, 1946, in this Interference in that—

(a) Under the Rules of Practice in the United States Patent Office, which have the force of law, the Commissioner is without power or authority to make any determinations either of fact or of law in any case where another and different procedure is definitely fixed by the Rules of Practice in the United States Patent Office;

(b) In making said order of July 19, 1946, the Commissioner had in effect set aside and nullified Rules 116 and 124 of said Rules of Practice;

(c) The said Coffey was not a party or privy to the aforesaid Civil Action No. 20,023 wherein Bendix Aviation Corporation was plaintiff and the Hon. Conway P. Coe was defendant, and that the judgment or record in a former action is not admissible in evidence as affecting, in any way, the rights of any person not a party or privy thereto;

(d) The transcript of the proceedings at the trial of said Civil Action No. 20023 reveals that no evidence of mistake in the filing of the Hunt and Olson joint application No. 575,025 or of diligence in discovering and disclosing such mistake to the Patent Office, was there adduced. A certified copy of the transcript of said proceeding was filed with Coffey's petition to the Commissioner.

Exhibit E annexed hereto is a true copy of the petition filed by Coffey on August 29, 1946.

22. On November 13, 1946 the Commissioner of Patents denied Coffey's said petition of August 29, 1946.

23. Plaintiff alleges that the petition to the Commissioner of Patents brought by said Hunt on or about June 14, 1946 was not a petition to have the Commissioner of Patents exercise his executive or administrative authority with respect to Interference 82,262. On the contrary, that petition was an application to the Commissioner to exercise appellate jurisdiction to review in law and in fact the decision of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof. It was a petition to have the Commissioner act arbitrarily and in direct violation and disregard of Patent Office Rules 116, 122, 124, 159, and 199, which have the force and effect of statute, and are binding upon the tribunals of the Patent Office including the Commissioner of Patents and the Assistant Commissioner. Plaintiff alleges that by Rule 124 the Commissioner was expressly denied the right to exercise appellate jurisdiction on Hunt's petition to shift the burden of proof with respect to the decision of the Examiner of Interferences in Interference 82,262.

Plaintiff alleges that after the adoption of the Rules of Practice in the United States Patent Office the only judicial power, if any, reserved to the Commissioner is that reserved by said Rules, particularly Rule 199. The exercise by him of all other judicial power is excluded and barred. The judicial power so reserved to the Commissioner does not include a right to review on the merits matters adjudged by the Examiner of Interferences on a motion to shift the burden of proof.

Plaintiff further alleges that any other supervisory authority of the Commissioner extends only to matters purely administrative and executive. It does not embrace the right, power, or authority to withhold from a particular applicant for a patent the benefit and advantages of Rules 116, 122, 124, and 159 as the Commissioner purported to do with respect to Coffey by his order of July 19, 1946.

24. Plaintiff alleges that the Commissioner of Patents by establishing the Rules of Practice in the United States Patent Office with the approval of the Secretary of Commerce, under R. S. section 483 (35 U. S. C. sec. 6) exercised and exhausted the supervisory judicial authority so conferred upon him, save in conformity with the provisions of the Rules so adopted. Plaintiff further alleges that in all cases wherein the conduct of proceedings in the Patent Office is regulated by rules established under the authority of section 483 of the Revised Statutes (U. S. C., title 35, sec. 6), including the pending Interference No. 82,262, the Commissioner of Patents must abide by said rules and is without authority or jurisdiction to act in contra-

vention of said rules, or to modify or abolish any thereof save with the approval of the Secretary of Commerce.

25. Plaintiff alleges that the order of the Commissioner of Patents of July 19, 1946 was made arbitrarily and without power or authority and in violation of Rules 101, 116, 122, 124, and 159 of the Rules of Practice in the United States Patent Office, which said rules were made under the authority of section 483 Revised Statutes (U. S. C., title 35, sec. 6) and have the force and effect of law.

26. Plaintiff alleges that the matter in issue in pending Interference No. 82262 is the question of priority of invention and that the said order of the Commissioner of Patents of July 19, 1946, determining that Hunt is entitled to the benefit of the filing date of the Hunt & Olson patent application Serial No. 575,025 and shifting the burden of proof in said interference and making Hunt the senior party therein, affects and relates to the issue of priority of invention.

27. Plaintiff alleges that the Acts of the Congress of March 2, 1927 (44 Stat. 1336), and August 5, 1939 (53 Stat. 1212), deprived the Commissioner of Patents of his appellate jurisdiction in interferences and conferred that jurisdiction upon the United States Court of Customs and Patent Appeals. Those statutes thus deprive the Commissioner of jurisdiction not only to resolve the issue of priority *per se*, but as well, jurisdiction to resolve *prima facie* or otherwise any underlying or subordinate issue involved therein.

28. Plaintiff avers that neither it nor Coffey was a party or privy to said Civil Action No. 20023, *Bendix Aviation Corporation vs. Coe*, and that the judgment, findings of fact and conclusions of law made therein are not binding either upon plaintiff or Coffey and, under established rules of evidence, are not admissible in evidence against plaintiff or Coffey in any action or proceeding, including pending Interference No. 82262; and plaintiff alleges that the order of the Commissioner of Patents of July 19, 1946 in said interference was made in violation of the established rule of evidence, long at rest, that a judgment *inter alios* is inadmissible in evidence and specifically in violation of Rule 159 of the Rules of Practice in the United States Patent Office, which provides that—

"159. * * * This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office."

29. On August 26, 1946, the party Coffey presented to the Examiner of Interferences in Interference No. 82,262 his motion to shift the burden of proof from Coffey to the party Hunt.

Under date of August 30, 1946, the Examiner of Interference notified the party Coffey that—

“In accordance with the Commissioner’s decision under date of July 19, 1946 (see lines 2 to 6, inclusive, p. 2) consideration of Coffey’s motion to shift the burden of proof is deferred to final hearing.”

30. On or about August 20, 1946 an interference, *Coffey vs. Hunt*, was declared between the Hunt application aforesaid Serial No. 727,648 and patent to Coffey No. 2,352,372, said interference being identified in the Patent Office as No. 82,555, and is now pending therein; no testimony has been taken. The dates of filing and the serial numbers of the respective applications were stated by the Examiner of Interferences thus:

“Irven E. Coffey filed March 31, 1937, No. 134,070, patented July 27, 1943, No. 2,325,372;

“Scott F. Hunt filed May 26, 1934, No. 727,648.”

31. By a communication to the Patent Office, dated October 15, 1946, Hunt called attention to the proceedings in Interference No. 82,262 and requested that the record in said Interference No. 82,555 be made to show Hunt entitled to the filing date of the Hunt and Olson application Serial No. 575,025, filed November 14, 1931. The party Coffey opposed that application of Hunt.

32. Under date of November 12, 1946, Coffey filed in said interference No. 82,555, motion to shift the burden of proof alleging, in part—

“The party Coffey is entitled to rely for constructive reduction to practice of the invention set forth in the count of this interference upon his patent No. 2,085,351, the application for which, Serial No. 679,201, was filed July 6, 1933, and of which the application for his patent No. 2,325,372 involved in this interference is a continuation in part, as expressly stated in said patent No. 2,325,372.”

33. By office letter of November 20, 1946, the Examiner of Interferences informed the parties to Interference No. 82,555 that,

“The Assistant Commissioner having ruled in the companion interference referred to by the party Hunt in his communication dated October 17, 1946, that Hunt should be given the benefit of the date of Hunt-Olson application Serial No. 575,025 with respect to claims including a claim corresponding to the issue of this interference, without consideration of a motion to shift the burden of proof, the record will be made to show

that Hunt is entitled to the filing date of the earlier Hunt-Olson application."

34. Plaintiff is the owner of the entire right, title, and interest in and to said patents No. 2,085,331 and No. 2,325,372 and has been the sole owner thereof at all times since said patents issued.

35. On or about August 20, 1946, an interference, *Hunt vs. Henning*, was declared between the Hunt application aforesaid Serial No. 727,648 and patent to Henning No. 2,306,251, said interference being identified in the Patent Office as No. 82,554 and is now pending therein; no testimony having been taken. The dates of filing and serial numbers of the respective applications were stated by the Examiner of Interferences thus:

"Scott F. Hunt filed May 26, 1934, No. 727,648;

"Otto Henning filed November 13, 1941, No. 418,980, patented December 22, 1942, No. 2,306,251, division of application filed November 17, 1931, No. 575,577."

36. By a communication to the Patent Office, dated October 15, 1946, Hunt called attention to the proceedings in Interference No. 82,262 and requested that if the failure, in Interference No. 82,554, to give to him the benefit of the filing date of the Hunt-Olson application Serial No. 575,025, filed November 14, 1931, was not inadvertent, that his communication be considered a motion to shift the burden of proof on the same grounds as those urged in Interference No. 82,262. Neither plaintiff nor Henning was a party nor a privy to Civil Action No. 20,023. The party Henning opposed said motion of Hunt.

37. By office letter of November 20, 1946, the Examiner of Interferences in No. 82,554 informed the parties thereto that—

"The Assistant Commissioner having ruled in the companion interference referred to by the party Hunt in his communication dated October 17, 1946, that Hunt should be given the benefit of the date of Hunt-Olson application Ser. No. 575,025 with respect to claims including a claim corresponding to the issue of this interference, without consideration of a motion to shift the burden of proof, the order of the parties in this interference now becomes *Henning v. Hunt*."

38. Plaintiff is the owner of the entire right, title and interest in and to said patent No. 2,306,251, and has been the sole owner thereof at all times since said patent issued.

39. By reason of the aforesaid acts of the Commissioner of Patents, plaintiff has been and is being denied in said Interferences No. 82,262, No. 82,554, and No. 82,555 the benefits and advantages of Rules 116, 122, 124, and 159 of the Rules of Practice in the United States Patent Office to which plaintiff

is entitled. Said rules have the force and effect of law. Plaintiff further alleges that it is the duty of the Commissioner of Patents under the law, not only to observe said rules himself but as well to see to it that said rules are complied with and enforced by the Examiners.

40. By reason of the said purported order of the Commissioner of Patents entered on or about July 19, 1946, the Examiner of Interferences having charge of Interferences No. 82,262, No. 82,554, and No. 82,555, is about to fix dates for the taking of testimony by the parties to said interferences with Coffey and Henning charged with the burden of proof. If Coffey and Henning are required to proceed under said burden of proof so illegally imposed upon them, the deprivation of their rights under the aforesaid Rules of Practice in the United States Patent Office and is remediless save by this action.

41. Plaintiff has exhausted all remedies for relief in the Patent Office and is remediless save by this action.

Wherefore, plaintiff demands judgment:

(1) That the Commissioner of Patents was without jurisdiction or authority in law to make his decision or order of July 19, 1946, in Interference No. 82,262, *Hunt vs. Coffey*, granting Hunt's petition to shift the burden of proof in that interference and denying to Coffey any and all rights under Rule 116 of the Rules of Practice in the United States Patent Office;

(2) That in denying Coffey's petition to vacate the Commissioner's decision of July 19, 1946 the Commissioner acted capriciously and arbitrarily and in violation of Rules 116, 122, 124, 159, and 199 of the Rules of Practice in the United States Patent Office;

(3) Commanding the Commissioner to vacate and set aside the said decision or order of July 19, 1946 and to dismiss the so-called petition of Scott F. Hunt to the Commissioner for an order shifting the burden of proof in Interference No. 82,262, *Hunt vs. Coffey*;

(4) Commanding the Commissioner of Patents to order and direct the Examiner of Interferences having charge of Interference No. 82,262, No. 82,554, and No. 82,555, to disregard the purported order of the Commissioner entered July 19, 1946, and to proceed in said three interferences as if said order had not been made or entered.

(5) Enjoining defendant herein, and all officials of the Patent Office under his control, from proceeding with said Interferences No. 82,262, No. 82,554, and No. 82,555 until the further order of this court; and

(6) For such other relief as to the court may seem just and proper.

CARTER CARBURETOR CORPORATION,
By Gilbert P. Ritter,
GILBERT P. RITTER,
Tower Building, Washington 5, D. C.,
Its Attorney.

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George R. Ericson,
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Hugh M. Morris,
HUGH M. MORRIS,
3018 DuPont Building,
Wilmington 41, Delaware,
Of Counsel.

CITY OF ST. LOUIS,
State of Missouri, ss:

M. F. Peterson, being duly sworn, deposes and says that he is Vice President of Carter Carburetor Corporation, the plaintiff in this action; that he has read the foregoing amended complaint and knows the contents hereof, and that he verily believes the facts stated therein to be true.

M. F. Peterson.
M. F. PETERSON.

Subscribed and sworn to before me this 27th day of November 1946.

A. A. KROW, *Notary Public.*

My commission expires May 8th, 1947.

In the District Court of the United States for the District of
Columbia

Civil Action No. 37782

CARTER CARBURETOR CORPORATION, PLAINTIFF

vs.

CASPER W. OOMS, COMMISSIONER OF PATENTS, DEFENDANT

Filed Feb. 6, 1947. Charles E. Stewart, Clerk.

AMENDMENT TO AMENDED COMPLAINT

By leave of the Court first had and obtained, plaintiff in the above entitled action amends its amended complaint heretofore filed herein by adding thereto the following paragraph:

27a. The aforesaid order of the Commissioner of July 19, 1946, made through Assistant Commissioner, the Honorable Thomas F. Murphy, is wholly invalid and void in that it is in violation of the due process of law clause of the Fifth Amendment to the Constitution of the United States.

CARTER CARBURETOR CORPORATION,
By Gilbert P. Ritter,
GILBERT P. RITTER,
*Tower Building, Washington 5, D. C.,
Its Attorney.*

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Hugh M. Morris,
HUGH M. MORRIS,
*3018 DuPont Building,
Wilmington 41, Delaware,
Of Counsel.*

Copy served 2/6/47.

W. W. COCHRAN.

Let this be filed.

F. DICKINSON LETTS, *Justice.*

In the District Court of the United States for the District of
Columbia

Civil Action No. 37782

CARTER CARBURETOR CORPORATION, PLAINTIFF

vs.

CASPER W. OOMS, COMMISSIONER OF PATENTS, DEFENDANT

Filed Dec. 17, 1946. Charles E. Stewart, Clerk.

W. W. COCHRAN, *Solicitor, United States Patent Office, Washington 25, D. C., Attorney for Defendant.*

ANSWER TO AMENDED COMPLAINT

1. Defendant denies that the order entered July 19, 1946, referred to in paragraph 1 of the complaint, was a reversal of the ruling of the Examiner of Interferences which dismissed Hunt's motion to shift the burden of proof, and he further denies that the said order was arbitrary or made without authority of law.

2. He admits the allegations of paragraph 2 of the complaint.

3. He admits that this court has jurisdiction of action, seeking the issuance of a mandatory injunction. He denies that the Court has jurisdiction of the subject matter of the present action for the reason that the matter involved is a procedural one and lies wholly within the discretion of the defendant, the Commissioner of Patents.

4, 5, 6, 7, 8, 9, 10. He admits the allegations of paragraphs 4 to 10, inclusive, of the complaint.

11. He admits that in the declaration of the interference the party Coffey was made senior party and that the burden of proof was thus placed upon Hunt. He states that the party Coffey was improperly made senior party since, prior to the filing of the Coffey application, another application had been filed jointly by Hunt and another, which application disclosed the subject matter involved in Interference No. 82,262.

12, 13, 14, 15, 16, 17, 18, 19, 20. He admits the allegations of paragraphs 12 to 20, inclusive, of the complaint.

21. He admits that Coffey filed a petition as set forth in paragraph 21 of the complaint, and that the said petition purported to show the further matters alleged in this paragraph. He denies the accuracy of the statement contained in each of the parts designated (a) to (d), inclusive, in paragraph 21 of the com-

plaint. He admits that Exhibit E attached to the complaint is a true copy of the petition filed by Coffey on August 29, 1946.

22. He admits the allegation of paragraph 22 of the complaint.

23. He denies the allegation of paragraph 23 of the complaint.

24. He admits that the Rules of Practice in the United States Patent Office are binding on the Commissioner of Patents. He denies that the Commissioner has no other supervisory authority than that specified in these rules.

25. He denies the allegations of paragraph 25 of the complaint.

26. He admits that the principal matter in issue in Interference No. 82,262 is the question of priority of invention. He denies that the order of the Commissioner fixing the burden of proof in the said interference affects or relates to the issue of priority in invention. He states that the fixing of the burden of proof is a purely procedural matter relating to the order in which the parties in the interference are to take testimony.

27. He denies the allegations of paragraph 27 of the complaint.

28. He admits that the plaintiff and Coffey were not parties to Civil Action No. 20,023, and that the judgment therein is not conclusive as to them. He denies the remaining allegations of paragraph 28 of the complaint.

29. He admits the allegation of paragraph 29 of the complaint.

30, 31, 32, 33, 34, 35, 36, 37, 38. He admits the allegations of paragraphs 30 to 38, inclusive, of the complaint.

39. He denies that the plaintiff has been or is being denied the benefit of any advantage to which he is entitled under any of the Rules of Practice in the United States Patent Office. He admits that the said rules have the force and effect of law and that it is the duty of the Commissioner of Patents to observe them and to see to it that they are enforced by the Examiners. He states that his action which is complained of in the present case was taken in order to require the Examiners to comply with the requirement of Rule 116.

40. He denies that the proposed fixing of the burden of proof in Interference Nos. 82,262, 82,554, and 82,555 set forth in paragraph 40 of the complaint would be improper or that it would do Coffey or Henning an irreparable injury or deprive them of any material right.

41. He denies the allegation of paragraph 41 of the complaint. He states that the question of the party Hunt's right to rely on the earlier joint application may be reviewed at final hearing and may be considered upon appeal to the Court of Customs and Patent Appeals, or upon a suit in equity under the provisions of Section 4915 R. S. (U. S. C., title 35, sec. 63).

W. W. COCHRAN,
Solicitor, United States Patent Office,
Attorney for Defendant.

E. L. REYNOLDS,
Of Counsel.

DECEMBER 16, 1946.

I hereby certify that a copy of this Answer was mailed today, December 16th, 1946, to the attorney for plaintiff, Mr. Gilbert P. Ritter, Tower Building, Washington 5, D. C.

W. W. COCHRAN,
Solicitor.

In the District Court of the United States for the District of
Columbia

Civil Action No. 37782

CARTER CARBURETOR CORPORATION, PLAINTIFF

v.

CASPER W. OOMS, COMMISSIONER OF PATENTS, DEFENDANT

Filed Mar. 31, 1947. Charles E. Stewart, Clerk.

INFORMAL MEMORANDUM

The Examiner of Interferences by his decision of June 5, 1945 dismissed Hunt's motion in interference 82,262, to shift the burden of proof and that he be given the benefit of the filing date of the Hunt and Olson application, Serial Number 575,025. The right to a review by the Board of Interferences Examiners at final hearing of a decision on a motion to shift the burden of proof is preserved by the last sentence of Rule 122 of the Rules of Practice in the Patent Office.

Thereafter Hunt petitioned the Commissioner to review and reverse the ruling of the Examiner of Interferences dismissing his motion to shift the burden of proof.

The Commissioner entertained Hunt's petition and on July 19, 1946, acting through Honorable Thomas F. Murphy,

Assistant Commissioner, granted same to an extent whereby he held that Hunt should be made the senior party in Interference No. 82,262. This action was taken in recognition of a decision in this court in *Bendix Aviation Corporation v. Coe*, Civil Action No. 20,023, in which the court found that Hunt was entitled to the filing date of the Hunt and Olson Application, Serial No. 575,025, namely November 14, 1931, for a constructive reduction to practice of claims 22, 27, 28, and 29 of the Hunt application in suit.

Plaintiff contends that the order of July 19, 1946 was entered by the Commissioner without jurisdiction or authority; that it is in contravention of law and violates the letter and spirit of Rule 124 of the Rules of Practice in the Patent Office.

The defendant takes the position that the order of July 19, 1946 was entered in the proper discharge of his duty in his general supervision of the office.

The court thinks the petition upon which the order rests was in fact and in substance an appeal to the Commissioner and that the order of the Commissioner thereon was in violation of law and in disregard of Rule 124 above cited.

The Examiner of Interferences clearly indicates that he was mindful of the decision in this court. His decision reveals his mental processes. An examination of his ruling is convincing that he exercised judgment and discretion in reaching his decision. Under the law and under his own rule the Commissioner is without authority to review the decision of an Examiner of Interferences on a motion to shift the burden of proof.

The duty of the Examiner of Interferences respecting the alignment of parties is judicial or quasi judicial and assuredly not ministerial in character. It requires the exercise of judgment and discretion. The record shows that the Commissioner's order of July 19, 1946 had the practical effect of shifting the burden of proof, authority for which is denied in the applicable law and by rule of the Patent Office. The petition to shift the burden of proof was not addressed to the Commissioner in view of his supervisory authority, and the action taken thereon may not be upheld on such hypothesis.

The court thinks the order of July 19, 1946 was not an exercise of supervisory power but was a review of the decision of the Examiner of Interferences. The Commissioner should set aside his order of July 19, 1946, and direct the Examiner of Interferences to proceed with his consideration of the Hunt motion to shift the burden of proof as if the Commissioner's order of July 19, 1946 had not been made.

Counsel for plaintiff will present for settlement findings of fact, conclusions of law and a judgment form consistent herewith.

F. Dickinson Letts,
F. DICKINSON LETTS,
Justice.

In The District Court of The United States
For The District of Columbia

Civil Action No. 37782

CARTER CARBURETOR CORPORATION, A CORPORATION OF THE STATE
OF DELAWARE, PLAINTIFF, *vs.* CASPER W. OOMS, COMMIS-
SIONER OF PATENTS, DEFENDANT.

Filed May 2, 1947. Charles E. Stewart, Clerk.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

This cause, Civil Action No. 37,782 having been tried on February 6, 1947, the court after due consideration, enters the following Findings of Fact and Conclusions of Law pursuant to Rule 52 of the Rules of Civil Procedure:

FINDINGS OF FACT

1. This action was brought by Carter Carburetor Corporation against Casper W. Ooms, Commissioner of Patents, for a judgment declaring the Commissioner was without jurisdiction to make his order of July 19, 1946, in Interference No. 82,262, *Hunt v. Coffey*, reversing the decision of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof; commanding the Commissioner to set aside that order and to direct the Examiner of Interferences having charge of Interference No. 82,262 and of related interferences No. 82,554 and No. 82,555 to disregard that order and to proceed therein as if said order had not been made.

2. On July 6, 1933, Irven E. Coffey duly filed in the Patent Office his application Serial No. 679,201 for a patent for his invention for a carburetor. On June 29, 1937, patent No. 2,085,351 issued thereon. Plaintiff herein is and at all times has been the owner of that patent.

3. On May 26, 1934, Scott F. Hunt, assignor to Bendix Aviation Corporation, filed his application Serial No. 727,648 for a patent for carburetors.

4. The Primary Examiner having forwarded to the Interference Division, in accordance with Rule 97 of the Rules of Practice in the United States Patent Office, a statement disclosing the applications involved in interference, arranged in the inverse chronological order of the filing of the completed applications, and having otherwise complied with said Rule, the Examiner of Interferences thereupon, on January 14, 1946, duly declared Interference No. 82,262, *Hunt v. Coffey*, between Hunt's application Serial No. 727,648 and Coffey patent No. 2,085,351 issued on application Serial No. 679,201. Upon the declaration of said interference, the Examiner of Interferences took jurisdiction thereof and the interference became a "contested case" as provided in Rule 101 of the Rules of Practice in the United States Patent Office. The burden of proof was thereupon and thereby imposed upon the party Hunt in accordance with Patent Office Rule 116.

5. Thereafter Hunt, acting under the provisions of Patent Office Rule 122 and claiming the benefit of the filing date, November 14, 1931, of the joint Hunt and Olson patent application Serial No. 575,025 assigned to Bendix Aviation Corporation, moved the Examiner of Interferences to shift the burden of proof in Interference No. 82,262 from Hunt to Coffey. Coffey (Carter) opposed that motion.

6. The Examiner of Interferences on June 5, 1946 dismissed Hunt's motion to shift the burden of proof "without prejudice to his right to urge at final hearing that he be given the benefit of the joint application referred to therein."

In his opinion with respect to that motion the Examiner of Interferences pointed out that Hunt's motion was but a repetition of his original motion to shift the burden of proof in Interference No. 78,346 of which Interference No. 82,262 was a continuation; that such motion had therein already been heard and denied by the Primary Examiner; and that the then pending motion to shift referred to favorable rulings of the United States District Court for the District of Columbia on a civil action under R. S. 4915. That case was *Bendix Aviation Corporation v. Coe*, Civil Action No. 20023, to which neither plaintiff herein, nor Coffey, nor Henning (hereinafter mentioned) was a party or privy. In that case the court stated as Conclusions of Law that the subject matter of claims 22, 27, 28 and 29 of Hunt application Serial No. 727,648 is completely disclosed in Hunt and Olson application Serial No. 575,025 and also in the Hunt application Serial No. 727,648, and that Hunt is entitled to the filing date of the Hunt and Olson application for a constructive reduction to practice of those claims.

In Interference No. 78,346, *Hunt v. Coffey*, referred to by the Examiner of Interferences, Hunt had moved to shift the burden of proof in view of the Hunt and Olson application No. 575,025. The Primary Examiner in denying that motion held that the Hunt and Olson application did not have the same disclosure as Hunt application No. 727,648 there involved and that, consequently, Hunt could not be given the benefit of the joint application. For a full description of his reasons why Hunt could not rely on the joint application the Primary Examiner referred to his concurrent decision on a like motion in Interference No. 76,519 and incorporated those reasons by references in his decision in Interference No. 78,346.

In Interference No. 76,519, *Hunt v. Fleming*, the Primary Examiner had held:

"* * * There are two differences between disclosures of the Hunt-Olson application and the sole application of Hunt. One of these differences is obvious upon inspection of the drawings. The other is apparent only on comparison of the two descriptions. In considering the first of these differences it is to be noted that the matter in Fig. 7 of Hunt 727,648 which is not shown in the joint application is matter which Hunt and Olson attempted to incorporate in the joint application by amendment. This matter consists of the relation of the various carburetor nozzles, venturis, jets and the throttle to the automatic choke device. The examiner held this to be new matter in the joint application. Thereupon Hunt filed a sole application containing this new matter as well as all of the original subject matter of the joint application."

Then, after pointing out the mechanical and functional differences between the structures of the two applications, the Primary Examiner added:

"There is another reason why Hunt cannot benefit by the filing date of the Hunt-Olson application. This is because the Hunt application is not a continuation of the Hunt-Olson application at all. The decision of *in re Roberts* 1920 C. D. 158 holds that a joint application can be continued by a sole application for the same invention if one of the joint inventors was joined by inadvertence or mistake. That is not the situation here. Hunt and Olson filed joint application 575,025 on Nov. 14, 1931. Hunt filed a sole application No. 727,648 on May 26, 1934. Olson submitted an oath in the latter stating that he was not the inventor of the subject matter of the claims in this sole application. Olson has never made oath that he did not invent the matter claimed in the Hunt-Olson application. In fact after Olson's oath was filed in Hunt 727,648 the Hunt-

Olson application was still prosecuted before the Office. The Hunt-Olson application was even passed to issue. The subject matter of the sole application is not the same as the subject matter of the joint application. It is therefore evident that Hunt is not an in re Roberts continuation. Where a joint application is a valid application, a later filed sole application cannot be given the benefit of the earlier date."

7. Upon the dismissal by the Examiner of Interferences of Hunt's motion to shift the burden of proof in Interference No. 82,262, Hunt petitioned the Commissioner of Patents to "review and reverse" the ruling of the Examiner of Interferences. Coffey (Carter) opposed that petition.

By a decision or order of July 19, 1946, the Commissioner, after referring to the decision of the Primary Examiner and the decision of this Court under R. S. 4915, in Civil Action No. 20,023, *Bendix Aviation Corporation v. Coe*, held—

(a) "* * * the Patent Office will accept the Court's decision as correct, unless it is shown not to be so.

(b) "*Prima facie*, therefore, Hunt is entitled in this proceeding, to the benefit of the filing date of the joint application and the primary examiner should have accorded him the benefit of this date in setting up this interference."

(c) "Hunt, therefore, should be made the senior party, * * *"

(d) "* * * this question should not be further considered at the interlocutory stage, * * *"

(e) "The petition is granted to the extent indicated."

Coffey (Carter) petitioned the Commissioner to reconsider and vacate his decision and to direct that the interference be proceeded with in accordance with the Rules of Practice in the Patent Office. In his petition Coffey (Carter) pointed out, *inter alia*, that Patent Office Rule 124 prohibits an appeal to the Commissioner from a motion brought under Patent Office Rule 122 to shift the burden of proof, and that the petition presented to the Commissioner by Hunt was in fact and in substance an attempted appeal from the decision of the Examiner of Interferences upon Hunt's motion to shift the burden of proof.

The Commissioner denied Coffey's petition for reconsideration, saying, in part;

"Hunt's petition was not considered as an appeal but as a petition to the supervisory authority of the Commissioner, and the action taken on the petition was based on such authority."

Coffey presented a further petition to the Commissioner to vacate and set aside his order and to dismiss the petition filed

by Hunt, pointing out therein that in making his order the Commissioner had in fact set aside the nullified Rules of Practice of the Patent Office; that Coffey was not a party or privy to Civil Action No. 20,023 and that the transcript of the proceedings of the trial in Civil Action No. 20,023 revealed that no evidence of mistake in the filing of the Hunt and Olson joint application Serial No. 575,025, or of diligence in discovering and disclosing such mistake to the Patent Office was there adduced. The Commissioner denied that petition.

8. After entry of the order of the Commissioner the Examiner of Interferences in Interference No. 82,262 realigned the parties and shifted the burden of proof from Hunt to Coffey, expressly resting his decision upon the order of the Commissioner. Thereupon Coffey presented to the Examiner of Interferences his motion to reshift the burden from Coffey to Hunt. The Examiner of Interferences held:

"In accordance with the Commissioner's decision under date of July 19, 1946, * * * consideration of Coffey's motion to shift the burden of proof is deferred to final hearing."

9. After the entry of the Commissioner's order of July 19, 1946, a new interference was declared, No. 82,555, between Hunt's application aforesaid, Serial No. 727,648, and another patent to Coffey No. 2,325,372. Coffey's application for that patent was filed March 31, 1937. Hunt's application Serial No. 727,648 was filed May 26, 1934. In setting up that interference the Primary Examiner did not refer to the Hunt and Olson joint application. Hunt filed a communication calling the attention of the Examiner of Interference to the proceedings in Interference No. 82,262 and requested that the record in Interference No. 82,555 be made to show Hunt to be entitled to the filing date of the Hunt and Olson application No. 575,025 filed November 14, 1931. Coffey opposed that application and, acting under Patent Office Rule 122, filed a motion to shift the burden of proof from Coffey to Hunt. In support thereof Coffey asserted that he was entitled to rely for constructive reduction to practice upon an earlier patent the application for which was filed July 6, 1933, of which the application for his patent in Interference No. 82,555 is a continuation in part as expressly stated in said patent No. 2,325,372. Acting upon Hunt's communication the Examiner of Interferences, expressly basing his decision upon the order of the Commissioner in Interference No. 82,262, held that Hunt was entitled to the filing date of the earlier Hunt and Olson application.

10. After the entry of the order of the Commissioner of July 19, 1946, a further new Interference No. 82,554, *Hunt v. Henning*, was declared between Hunt application aforesaid Serial

No. 727,648, filed May 26, 1934, and patent to Henning No. 2,306,251, which was granted upon a divisional application of an application filed November 17, 1931. Hunt moved to shift the burden of proof, contending that in view of the order of the Commission of July 19, 1946, in Interference No. 82,262, he (Hunt) was entitled to the benefit of the filing date of the Hunt and Olson application. Henning opposed the motion. The Examiner of Interferences, resting his decision upon the order of the Commissioner made in Interference No. 82,262, granted Hunt's motion.

11. Plaintiff is the owner of the entire right, title and interest in and to patents No. 2,325,372 and No. 2,306,251 involved in Interferences No. 82,555 and No. 82,554 respectively, and has been such sole owner of each thereof at all times since such patents issued.

12. The Commissioner asserts that Hunt's petition to him was a petition to his supervisory authority; that such was the clear intent of the petition "since the relief sought could not have been granted otherwise," and that the Commissioner's action on the petition was within his supervisory power and authority.

CONCLUSIONS OF LAW

1. In each of the several Interferences No. 82,262, No. 82,554, and No. 82,555 the Primary Examiner forwarded to the Interference Division "a statement disclosing the applications involved in interference, fully identified, arranged in the inverse chronological order of the filing of the completed applications, and also disclosing the issue or issues and the ordinals of the conflicting claims * * *" in accordance with the requirements of Rule 97 of the Rules of Practice in the United States Patent Office.

2. Upon the institution and declaration of the respective interferences each became a "contested case" and the Examiner of Interferences took jurisdiction thereof as provided and required by Patent Office Rule 101.

3. Under the express provisions of Patent Office Rule 116 the parties to the interferences were presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof rested upon the party seeking to establish a state of facts different from that disclosed by said completed applications.

4. The disposition by the Examiner of Interferences of motions to shift the burden of proof, authorized by Rule 122, is made by that Rule to depend and turn upon the "opinion"

of the Examiner of Interferences as to whether "they be in proper form." In reaching his decision, dismissing Hunt's motion to shift the burden of proof in Interference No. 82262, the Examiner of Interferences exercised judgment and discretion, and his act in so doing was judicial, or *quasi judicial*, in character.

5. The motions to shift the burden of proof involved in the aforesaid interferences were brought under the provisions of Rule 122. Patent Office Rule 124 expressly provides that "no appeal will be permitted from a decision rendered on a motion brought under the provisions of" Rule 122, and deprived the Commissioner of Patents of any and all jurisdiction to review or reverse the said decision of the Examiner of Interferences upon Hunt's motion to shift the burden of proof.

6. The Rules of the Patent Office have the force of a statute and are as binding upon the Commissioner and all officials of the Patent Office as upon applicants for patents and parties to interferences. *Westinghouse Traction Brake Co. v. Christensen*, 243 Fed. 901, 905 (C. C. A. 3); *Anderson v. Walch*, 152 Fed. (2d.) 975; *Avery v. Chase*, 101 Fed. (2d.) 205, 210; *In Re Horton*, 58 Fed. (2d.) 682; *Interference Law and Practice*, by Rivise and Caesar, Vol. 1, p. 25, § 10; Defendant's answer to Paragraph 8 of Amended Complaint.

7. The "applications involved in Interference" No. 82262 within the meaning of the Patent Office Rule 97 were and are Hunt's application Serial No. 727,648 and application Serial No. 679,201 which eventuated in Patent No. 2,085,351 to Coffey. They are the applications between which that Interference No. 82262 was declared.

8. The exercise of his jurisdiction by the Primary Examiner upon any reference to him by the Examiner of Interferences of a motion to shift the burden of proof calls into action the powers and functions exercised by a judge in the admission, rejection and evaluation of evidence and particularly so in an interference, such as No. 82262, wherein a party thereto claimed to be entitled to the benefit of the filing date of an earlier joint application filed not by himself alone but by himself and another. Such jurisdiction is truly judicial.

9. The question involved in what is termed "the burden of proof" relates primarily to priority of invention. It involves the question as to the record dates to which the parties to an interference are entitled upon the question of priority of invention. This is essentially a matter of evidence, since it is a question whether the application referred to constitutes legal evidence of invention of the subject matter in controversy at

its date. The decision upon the question of burden of proof may dispose in many cases of the question of priority of invention since the effective date given to the party made senior is often prior to the date of invention alleged by his opponent. *Raulet and Nicholson v. Adams*, 1905 C. D. 55, 114 O. G. 1827.

10. By making his challenged order of July 19, 1946 the Commissioner assumed the jurisdiction conferred upon the Examiner of Interferences by Patent Office Rule 122; reversed the decision of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof in Interference No. 82262; assumed the jurisdiction of the Primary Examiner exercisable by him on reference to him by the Examiner of Interferences of a motion to shift the burden of proof; passed upon the admissibility of the decision of this court in Civil Action No. 20023, and appraised its evidential value.

11. Hunt's petition to "review and reverse the ruling of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof" was not addressed to the Commissioner in view of his supervisory authority. The action taken thereon by the Commissioner may not be upheld on such hypothesis. His order of July 19, 1946 was not an exercise of supervisory power but was a review of the decision of the Examiner of Interferences, and in disregard and violation of Rules of Practice in the United States Patent Office Nos. 97, 101, 116, 122, and 124 which have the force and effect of a statute, and in violation of the Act of Congress of March 2, 1927 (44 Stat. 1336) as amended by the Act of Congress of August 5, 1939 (53 Stat. 1212). A petition may not be entertained by the Commissioner when it seeks to obtain indirectly a review of an examiner's judicial or *quasi judicial* decision from which no direct appeal lies by merely misnaming the action and calling it a petition. *Goss v. Scott*, 1901 C. D. 80; *Manny v. Easley v. Greenwood, Jr.*, 1889 C. D. 179, 181; *Waite v. Macy*, 246 U. S. 606, 608.

12. The executive supervision and direction which the head of a department may exercise over his subordinate in matters administrative and executive do not extend to matters in which the subordinate is directed by statute or rule having the force of statute to act judicially, or *quasi judicially*. *Butterworth v. Hoe*, 112 U. S. 50.

13. Hunt's petition was in fact and in substance an appeal to the Commissioner. The order of the Commissioner thereon was in violation of law and the Rules of the Patent Office. It was made by the Commissioner beyond and in excess of his jurisdiction and is invalid, void and without effect and must be so regarded.

14. Compliance by Government officials with departmental rules is essential to the due process of law guaranteed by the Constitution of the United States. Jurisdiction of a tribunal to make a challenged order or decree is a *sine qua non* of due process. *Ex parte Radivoeff*, 278 Fed. 227, 229; *Scott v. McNeal*, 154 U. S. 34, 46.

15. So far as is within his power so to do, the Commissioner should be required completely to nullify, and undo the effect of, his void order of July 19, 1946.

16. This Court has power and authority to grant to plaintiff in this action plain, adequate and complete relief from the invalid and void order of the Commissioner. *Garfield v. Goldsby*, 211 U. S. 249, 261; *Waite v. Macy*, 246 U. S. 606, 608-609; *Butterworth v. Hoe*, 112 U. S. 50.

17. The relief sought by plaintiff should be granted.

F. DICKINSON LETTS,
United States District Judge.

WASHINGTON, D. C. Dated: May 2, 1947.

Copy seen by

W. W. COCHRAN,
Attorney for Defendant.

In the District Court of the United States for the
District of Columbia

Civil Action No. 37782

CARTER CARBURETOR CORPORATION, A CORPORATION OF THE STATE
OF DELAWARE, PLAINTIFF

vs.

CASPER W. OOMS, COMMISSIONER OF PATENTS, DEFENDANT

Filed May 2, 1947. Charles E. Stewart, Clerk.

FINAL JUDGMENT

Now to wit, this second day of May 1947, the above entitled action having come on for final hearing, by stipulation of the parties, upon the pleadings, affidavits, and exhibits before the Court, and

It appearing, for the reasons set forth in the Findings of Fact and Conclusions of Law filed concurrently herewith, that Plaintiff herein is entitled to the relief which it seeks in and by its Amended Complaint; and

It further appearing, that Plaintiff has exhausted all remedies for relief in the Patent Office,

It is ordered, adjudged, and decreed:

1. That, Casper W. Ooms, Commissioner of Patents, was without jurisdiction or authority in law to make his decision or order of July 19, 1946, in Interference No. 82,262, *Hunt v. Coffey*.

2. That, Casper W. Ooms, Commissioner of Patents, be and he hereby is ordered and directed to vacate and set aside his order of July 19, 1946, in Interference No. 82,262, *Hunt v. Coffey*, and to dismiss the so-called petition of Scott F. Hunt, upon which said order was based; and

3. That, Casper W. Ooms, Commissioner of Patents, be and he hereby is commanded to make and enter an order within 30 days from the date hereof, directing the Examiner of Interferences having jurisdiction of Interferences No. 82,262, No. 82,554, and No. 82,555, to disregard the invalid and void order of the Commissioner entered July 19, 1946 in Interference No. 82,262.

4. That execution of this judgment be stayed pending final determination on appeal.

F. DICKINSON LETTS,
United States District Judge.

In the District Court of the United States for the
District of Columbia

. Civil No. 37782

CARTER CARBURETOR CORPORATION, PLAINTIFF

vs.

CASPER W. OOMS, COMMISSIONER OF PATENTS, DEFENDANT

Filed May 20, 1947. Charles E. Stewart, Clerk.

NOTICE OF APPEAL

Notice is hereby given this 20th day of May 1947, that defendant Casper W. Ooms, Commissioner of Patents, hereby appeals to the United States Court of Appeals for the District of Columbia from the judgment of this Court entered on the 2d day of May 1947 in favor of Carter Carburetor Corporation, Plaintiff, against said Casper W. Ooms, Commissioner of Patents, Defendant.

W. W. COCHRAN,
Attorney for Defendant.

DOCUMENT No. 1

Div. 28. Room 220. Filed Jan. 10, 1947. Charles E. Stewart, Clerk.

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

RICHMOND, VA.

EXAMINER OF INTERFERENCES:

An interference is found to exist between the following cases, and in respect to the invention therein specified, to wit:

1. Name Scott F. Hunt.

Post-office address % Chandler-Evans Company, South Meriden, Connecticut.

Title Carburetors.

Filed May 26, 1934. Ser. No. 727,648.

Attorney N. D. Parker, Jr., of McLachlen Building, Washington, D. C.

Associate Att'y A. R. McCrady of 401 N. Bendix Drive, South Bend, Indiana.

Assignee Bendix Aviation Corporation (a corp. of Del.) of South Bend, Indiana.

2. Name Irven E. Coffey.

Post-office address 7128 Natural Bridge Road, St. Louis, Missouri.

Title Carburetors.

Filed July 6, 1933. Ser. No. 679,201. Pat'd June 29, 1937. No. 2,085,351.

Attorney Donald U. Rich of c/o American Car & Foundry Co., 30 Church St., New York, N. Y.

Associate Att'y George R. Ericson of 2834-46 N. Spring Ave., St. Louis, Missouri.

Assignee Carter Carburetor Corporation of St. Louis, Missouri (a corp. of Delaware).

Count 1. In combination with an internal combustion engine, a carburetor having a choke valve, temperature responsive means yieldingly urging the valve toward closed position at low temperatures, additional means resisting opening movement of the valve, and suction operated means operative to render said additional means inoperative and to move the valve to at least partially opened position against the force of the temperature responsive means, said choke valve being moved to fully open position when the normal operating temperature

is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction.

Count 2. In combination with an internal combustion engine, a carburetor having a throttle and a pressure responsive choke valve, means operative below a predetermined temperature to yieldingly urge the valve toward closed position, additional means resisting opening movement of the valve, and means responsive to a predetermined suction posterior to the throttle for rendering said additional means inoperative and for moving the valve to at least partially opened position against the force of the temperature responsive means said choke valve being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	Coffey	Hunt
1 -----	39	28
2 -----	40	29

(Counts compared.)

H. L. SOLYOM,
Examiner, Division 28.

KJA: kw.

DOCUMENT No. 2

DEPARTMENT OF COMMERCE,
UNITED STATES PATENT OFFICE,
Washington 25, D. C., June 5, 1946.

Please find below a communication from the Examiner of Interference in this case.

CASPER W. OOMS,
Commissioner of Patents.

Interference No. 82262

HUNT v. COFFEY

Filed Jan. 10, 1947. Charles E. Stewart, Clerk.

The party Hunt on April 8, 1946 has filed a motion to shift the burden of proof, based upon a Hunt and Olson application, Serial No. 575,025 filed November 14, 1931. In a motion

to dismiss filed April 27, 1946, by the party Coffey, it is pointed out that Hunt's motion is simply a repetition of his original motion to shift the burden of proof in interference No. 78,346 of which the present interference is a continuation, and that such motion has already been heard and denied by the primary examiner. The recent motion to shift refers to allegedly favorable rulings of the District Court for the District of Columbia on an *ex parte* appeal. A similar situation was presented recently when a primary examiner rendered a decision on a motion to dissolve questioning a party's right to make the count, although the Board of Appeals had previously ruled in an *ex parte* appeal that the party could make the claim corresponding to the count. In a decision dated April 4, 1946, the Honorable First Assistant Commissioner of Patents stated:

"* * * it is my opinion that the interference should be continued, and that consideration of the question of * * * 's right to make the count should be postponed to final hearing. Accordingly, * * * 's petition is granted, and the decision of the primary examiner granting the motion of * * * to dissolve is vacated without prejudice."

Since it would appear merely time-consuming to set the motion for hearing, only to have it vacated if the primary examiner adhered to his previously stated position, it is deemed that the motion should be dismissed without prejudice to the right of Hunt to urge at final hearing that he be given the benefit of the earlier application.

In the motion to dismiss above referred to, Coffey avers (page 1 paragraph designated 3) that the Court did not adjudge Hunt to be entitled to the benefit of the joint application. In view of this conflict, each party should file a certified copy of the Court's action if he intends to maintain his position.

It is further noted that the "1941" appearing in the last paragraph of page 1 of the motion to shift appears to be an error.

In view of the above ruling on the motion to shift, no action is deemed necessary upon Coffey's contingent motion to take testimony in Section III of his motion to dismiss, and it is dismissed.

Coffey on April 27, 1946 filed a motion to dissolve and for judgment and on May 21, 1946 filed an amendment and amplification of the motion to dissolve. The motion for judgment is deferred until final hearing. If it were set for an earlier hearing and denied, such proceedings would merely cause delay; whereas if it were set for such early hearing, granted, and reversed on appeal, many complicated proceedings might

ensue as all priority questions would not have been presented (cf. *Lindmark v. De Ferranti*, 153 O. G. 1082, 1910 C. D. 355, 34 App. D. C. 445).

Ground 1 of the motion to dissolve refers to a Hunt patent granted January 30, 1934 and an Ericson patent granted June 27, 1933. Accordingly, this ground could have been presented in Interference No. 78,346 during the motion period provided as to these counts between the present parties, which period terminated December 30, 1940. Since no reason is presented to excuse the delay, the motion is dismissed as to this ground. For similar reasons the motion is dismissed as to grounds 2, 4, 5, 9, 12, 13, and 14.

Ground 1 of the motion to dissolve refers to a Hunt patent filed May 4, 1931 and an Ericson patent filed November 6, 1931. These dates are overcome by the preliminary statements of the parties. This ground of the motion is further dismissed in view of the practice stated in *Forsyth v. Richards*, 115 O. G. 1327, 1905 C. D. 115. For similar reasons the motion is further dismissed as to grounds 2, 4, 5, 9, 12, 13, and 14.

There is no ground 3 of the motion to dissolve.

Grounds 6, 7, 10, 11, and 15 of the motion to dissolve are similar to the grounds presented and considered in the former Interference No. 78,346. Since the Primary Examiner was reversed on *ex parte* appeal, similar considerations would apply to these grounds as to Hunt's motion to shift considered previously. Accordingly, they are dismissed without prejudice to the presentation of the matters raised therein at final hearing.

Ground 8 of the motion is dismissed since the correction of the alleged defects in Hunt's oath is an *ex parte* matter (*Duke-smith v. Corrington v. Turner*, 125 O. G. 348, 1906 C. D. 426).

The motion to shift by Hunt is dismissed without prejudice to his right to urge at final hearing that he be given the benefit of the joint application referred to therein.

The motion to dismiss by Coffey is granted as to sections I and II to the extent indicated; and is dismissed as to section III.

The motion for judgment by Coffey is deferred to final hearing.

The motion to dissolve by Coffey, as amplified and amended, is dismissed as to grounds 1 to 5, 8, 9, and 12 to 14; as to grounds 6, 7, 10, 11, and 15 it is dismissed without prejudice to the presentation of the matters raised therein at final hearing.

The times for taking testimony and for final hearing remain as set in the Office Action dated May 7, 1946.

A. Y. CASANOVA, Jr.,
Examiner of Interferences, Room 6088.

DOCUMENT No. 3

IN THE UNITED STATES PATENT OFFICE

Interference No. 82262

HUNT v. COFFEY

Filed Jan. 10, 1947. Charles E. Stewart, Clerk.

PETITION TO THE COMMISSIONER

Your petitioner, Scott F. Hunt, a party to the above-entitled interference, prays that the Commissioner review and reverse the ruling of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof. The ruling is contained in an Office letter dated June 5, 1946, which states in part:

The motion to shift by Hunt is dismissed without prejudice to his right to urge at final hearing that he be given the benefit of the joint application referred to therein.

The cases directly involved in the interference are:

Hunt application 727,648, filed May 26, 1934; assigned to Bendix Aviation Corporation.

Coffey patent 2,085,351, application filed July 6, 1933; assigned to Carter Carburetor Corporation.

The case upon which Hunt's motion to shift is based is:

Hunt-Olson application 575,025, filed November 14, 1931; assigned to Bendix Aviation Corporation.

Both parties have alleged in their preliminary statements dates prior to November 14, 1931, the filing date of the Hunt-Olson application.

In an interference such as this, where the acts to be proved by testimony occurred over 14 years ago, the right of the senior party to defer the taking of testimony until the other party has completed his testimony-in-chief is a material one, and denial of that right may work a serious injustice. This is especially true in the present case, where the party Coffey alleges dates much earlier than his filing date, and must prove such dates in order to antedate the filing date of the Hunt-Olson application. It is therefore of no great comfort to Hunt to be told that he may urge at final hearing that he be given the benefit of the parent filing date. It seems quite possible that if the burden of proof is shifted now Hunt will not need to take testimony at all, whereas if Hunt must take his testimony first he will necessarily incur considerable expense in running down witnesses and records in various parts of the United States, and

in arranging for testimony sessions wherever the witnesses and records are found.

Hunt's prima facie right to the benefit of the earlier filing date is perhaps as well established as in any similar case which has come before the Commissioner for review. We do not contend that the question is *res judicata* as to the party Coffey, since he was not a party to the proceeding which established Hunt's right; but conclusiveness is unnecessary in a proceeding such as this, and the prima facie case is unusually strong.

The previous proceedings, insofar as the question here in issue is concerned, were as follows: An earlier interference, No. 78,346, was declared June 4, 1940; the parties, cases (Hunt application 727,648; Coffey patent 2,085,351) and counts being identical with those of the instant interference. Hunt there, as here, moved to shift the burden of proof, on the basis of the earlier filed Hunt-Olson application Serial No. 575,025; the Primary Examiner denied the motion. Coffey moved to dissolve (1) on the ground of interference estoppel and (2) on other grounds all of which were based on the theory that Hunt was not entitled to the benefit of the earlier filing date; the Primary Examiner granted the motion. No appeal was permitted as to the Primary Examiner's decision on either motion. The counts were then finally rejected to Hunt, and he appealed to the Board of Appeals, which affirmed the Primary Examiner as to both grounds. Hunt then proceeded by way of a suit under RS 4915 in the District Court for the District of Columbia, entitled Bendix Aviation Corporation v. Coe, Civil Action No. 20,023, and on April 17, 1944, the court entered judgment in his favor as to the claims (Claims 28 and 29 of the Hunt application) forming the counts of the present interference; on or about the same date, the court issued Findings of Fact and Conclusions of Law upon which the judgment was based, holding (1) there was no estoppel and (2) Hunt was entitled to the earlier filing date. Copies of these papers, made from Hunt's attorney's file copies, are enclosed herewith for the Commissioner's convenience; but a certified copy of the Judgment will be found in the file of Hunt application 727,648, it having been presented with the amendment filed April 23, 1945, in that application; and a certified copy of the Findings and Conclusions has been ordered and will be placed in the file of the same application as soon as received.

Attention is particularly directed to paragraph No. 5 of the Conclusions of Law reading:

5. Hunt is entitled to the filing date of the Hunt and Olson application Serial No. 575,025, namely November 14, 1941, for

a constructive reduction to practice of claims 22, 27, 28 and 29 of the Hunt application in suit.

The Judgment of the court necessarily rested upon this finding, since as fully brought out in the argument of the case, if Hunt were not entitled to the earlier filing date his oath negating two years' public use, etc., only as of the earlier filing date, was invalid. The ruling on this point is therefore decision, not dicta.

Such being the facts, the question presented by this petition is, it seems to us, simply whether the Patent Office will follow the court's decision by according to Hunt the filing date to which the court held he is entitled. That the Office will follow the court in this respect would seem hardly open to question. There appears to be no reported case where the Commissioner has ever opposed or disregarded a court's judgment rendered in an action under RS 4915.

We consider now the reasons given by the Examiner of Interferences for refusing Hunt's motion to shift. For one reason, the Examiner does not have before him the Findings and Conclusions in the 4915 action, though he does have before him the Judgment, as above noted. The lack of a certified copy of the Findings and Conclusions will be supplied promptly. There was no apparent need for filing such copy prior to the present time.

The Examiner of Interferences notes an error in the last paragraph of page 1 of Hunt's motion to shift; "1941" should obviously be — 1931 —. Quite possibly the same error occurs in the court's Findings and Conclusions, from which the copy we have was made; but it is a harmless error which will deceive no one.

The Examiner of Interferences finds a precedent, in a Manuscript Decision involving "a similar situation", which he feels justifies denial of Hunt's motion. In the case referred to by the Examiner, the Board of Appeals had ruled in an ex parte appeal that a party could make a claim corresponding to the count of an interference. When the same party's right to make the same count was later raised by motion to dissolve in the course of the interference, it was held that the Primary Examiner should not have granted the motion. Presumably the basis for the decision was simply that a ruling, even an ex parte ruling, of a higher tribunal (the Board of Appeals) should, in the absence of new evidence, be binding upon an inferior tribunal (the Primary Examiner). By some reasoning not entirely clear to us, the Examiner of Interferences here construes it as authority for holding that the ex parte

ruling of the higher tribunal (the District Court for the District of Columbia) should *not* be binding upon an inferior tribunal (the Primary Examiner or the Examiner of Interferences). The cases are "similar", but their similarity should have led the Examiner of Interferences to a different conclusion.

The Examiner of Interferences anticipates that the Primary Examiner may, in the face of the court's decision, adhere to his previously stated position, that Hunt is not entitled to the earlier filing date. We think the danger of such action on the part of the Primary Examiner is slight, and in any event the question here at issue should not be decided upon the assumption that the Primary Examiner will refuse to abide by the usual legal rules of comity.

For the foregoing reasons it is submitted that the ruling of the Examiner of Interferences on Hunt's motion to dissolve should be remanded to the Examiner of Interferences with instructions to make a new ruling in accordance with the court's decision.

Copy of this petition has been mailed to counsel for the party Coffey.

Respectfully,

A. R. McCrady,
Attorney for Hunt.

arm;is.

DETROIT, MICHIGAN, 14 June 1946.

DOCUMENT No. 4

DEPARTMENT OF COMMERCE,
UNITED STATES PATENT OFFICE,
Washington 25, July 19, 1946.

In re Interference No. 82262, *Scott F. Hunt v. Irvan E. Coffey*,
Carburetors

PETITION

The party Hunt petitions from the decision of the Examiner of Interferences, refusing to set for hearing a motion to shift the burden of proof in the above-entitled interference, the motion being based on the allegation that Hunt is entitled to the benefit of the filing date of a joint application of Hunt and Olson, No. 575,025, filed November 14, 1931.

The record shows that the primary examiner held, in a former interference, that Hunt was not entitled to the benefit of the joint application, so far the claims involved in this interference are concerned; and that this holding was repeated *ex parte* by the examiner and affirmed by the Board. However, the record also shows that, as the result of an action under R. S. 4915, the United States District Court for the District of Columbia adjudged that Hunt was entitled to a patent containing these claims. This judgment necessarily involved a holding that Hunt was entitled to the date of the joint application, since, otherwise, his application here involved has no proper oath.

Coffey was not a party to the proceeding in the District Court, and its decision is not *res judicata* as to him but, in accordance with the settled practice, the Patent Office will accept the Court's decision as correct, unless it is shown not to be so. *Prima facie*, therefore, Hunt is entitled, in this proceeding, to the benefit of the filing date of the joint application, and the primary examiner should have accorded him the benefit of this date in setting up the interference. Hunt, therefore, should be made the senior party, without consideration of his motion to shift the burden of proof.

As already noted, Coffey is entitled to attack the holding that Hunt is entitled to the date of the joint application. However, because of the long pendency of this and related proceedings, and of the fact that Coffey's patent here involved was issued more than nine years ago, it is evident that no delays should be incurred which are not absolutely necessary. In view of these circumstances, and of the presumption of correctness which attaches to the holding of the District Court, this question should not be further considered at the interlocutory stage, but should be disposed of at final hearing.

The petition is granted to the extent indicated.

THOMAS F. MURPHY,
Assistant Commissioner.

CHARLES M. FUNKHOUSER (for Hunt),
McLachlen Building, Washington 1, D. C.
GEORGE R. ERICSON (for Coffey),
2834-46 North Spring Ave., St. Louis, Mo.

Div. 28. Room 220. Filed Jan. 10, 1947. Charles E. Stewart, Clerk.

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

RICHMOND, VIRGINIA

EXAMINER OF INTERFERENCES:

An interference is found to exist between the following cases, and in respect to the invention therein specified, to wit:

(1) Name, Otto Henning.

Post-office address, 7246 Burrwood, St. Louis County, Missouri.

Title, Internal Combustion Engines.

Filed November 13, 1941. Ser. No. 418,980. Pat'd December 22, 1942. No. 2,306,251.

Division of Serial No. 575,577 filed November 17, 1931.

Attorney, D. U. Rich of 30 Church Street, New York, N. Y. Associate Att'y, George R. Ericson of c/o Carter Carburetor Corp., 2840 North Spring Avenue, St. Louis, Missouri.

Assignee, Carter Carburetor Corporation, of St. Louis, Missouri, a corporation of Delaware.

(2) Name, Scott F. Hunt.

Post-office address, % Chandler Evans Co., South Meriden, Conn.

Title, Carburetors.

Filed May 26, 1934. Ser. No. 727,648.

Division or continuation of

Attorneys, Charles M. Funkhouser of McLachlen Building, Washington 1, D. C., A. R. McCrady of Maccabees Building, Detroit 2, Michigan.

Assignee, Bendix Aviation Corporation of South Bend, Indiana, a corporation of Delaware.

Count 1: In a carburetor, means forming a mixing conduit, a choke valve controlling the admission of air to said mixing conduit, said choke valve having a part which is movable toward open position by direct action of suction, suction operated means for opening said choke valve a limited distance only, said suction operated means being constructed and arranged to permit a continuance of the opening of said choke valve after the cessation of movement of said suction operated means, and

a heat responsive element connected to said choke valve to control the same in conjunction with said suction operated device.

The relation of the count of the interference to the claims of the respective parties is as follows:

Count:	Henning	Hunt
1-----	7	22

(Count compared.)

This interference is a continuation of Interference No. 82261.

H. J. ALBRECHT,
Acting Examiner.

KJA: kw.

DOCUMENT No. 12

DEPARTMENT OF COMMERCE,
UNITED STATES PATENT OFFICE,
Washington 25, D. C., Oct. 10, 1946.

Please find below a communication from the Examiner of Interference in this case.

CASPER W. OOMS,
Commissioner of Patents.

Interference No. 82554

HUNT v. HENNING

The preliminary statements of the parties are approved. The motion period expires November 12, 1946. The setting of times for the taking of testimony and for final hearing is deferred until a companion case of the series is in condition for such action.

The dates of filing and serial number of the respective applications are as follows: Scott F. Hunt filed May 26, 1934, No. 727,648; Otto Henning filed November 13, 1941, No. 418,980, patented December 22, 1942, No. 2,306,251, division of application filed November 17, 1931, No. 575,577.

W. E. WAITE,
Examiner of Interferences, Room 6605.

DOCUMENT No. 13
IN THE UNITED STATES PATENT OFFICE
Interference 82554
HUNT v. HENNING

U. S. Patent Office, Oct. 18, 1946. Docket Division.

COMMUNICATION

It is noted that in the Office letter dated October 10, 1946, in the above-entitled interference, the party Hunt is not given the benefit of the filing date of Hunt-Olson application Serial Number 575,025, filed November 14, 1931.

Inasmuch as Hunt's right to this earlier date was recently considered and established in the proceedings in Coffey v. Hunt Interference 82,262, it is presumed that failure to give him the benefit of the earlier date was inadvertent. However, if it was intentional it is requested that this paper be considered a motion to shift the burden of proof, on the same grounds as those urged in Interference 82,262.

Copy of this paper has been mailed to counsel for Henning.

Respectfully,

SCOTT F. HUNT,
By A. R. McCrady, Attorney.

DETROIT, MICHIGAN, *October 15, 1946.*

ARM:ah.

DOCUMENT No. 14

DEPARTMENT OF COMMERCE,
UNITED STATES PATENT OFFICE,
Washington 25, D. C., Nov. 20, 1946.

Please find below a communication from the Examiner of Interference in this case.

CASPER W. OOMS,
Commissioner of Patents.

Interference No. 82554

HUNT v. HENNING

The Assistant Commissioner having ruled in the companion interference referred to by the party Hunt in his communica-

tion dated October 17, 1946, that Hunt should be given the benefit of the date of Hunt-Olson application Ser. No. 575,025 with respect to claims including a claim corresponding to the issue of this interference, without consideration of a motion to shift the burden of proof, the order of the parties in this interference now becomes Henning v. Hunt.

The motion filed by the party Henning on November 12, 1946, is granted and in accordance therewith the time for bringing motions is extended to December 12, 1946.

W. E. WAITE,
Examiner of Interferences, Room 6605.

DOCUMENT No. 15

Div. 28. Room 220.

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

RICHMOND, VIRGINIA

EXAMINER OF INTERFERENCES:

An interference is found to exist between the following cases, and in respect to the invention therein specified, to wit:

1. Name, Irven E. Coffey.

Post-office address, 7128 Natural Bridge Road, St. Louis, Missouri.

Title, Carburetor.

Filed March 31, 1937. Ser. No. 134,070. Pat'd. July 27, 1943. No. 2,325,372.

Attorney, D. U. Rich of 30 Church Street, New York, New York.

Associate Att'y, George R. Ericson of c/o Carter Carburetor Corp. (Notice sent to 2840 North Spring Ave., St. Louis, Missouri).

Assignee, Carter Carburetor Corporation of St. Louis, Missouri (a corp. of Del.).

2. Name, Scott F. Hunt.

Post-office address, c/o Chandler-Evans Co., South Meriden, Conn.

Title, Carburetors.

Filed May 26, 1934. Ser. No. 727,648. Earlier date accorded, see Paper No. 15.

Attorneys, Charles M. Funkhouser of McLachlen Building, Washington 1, D. C.; A. R. McCrady of Maccabees Building, Detroit 2, Michigan.

Assignee, Bendix Aviation Corporation (a corp. of Del.) of South Bend, Indiana.

Count 1: In combination with an internal combustion engine, a carburetor having a throttle and a pressure responsive choke valve, temperature responsive means yieldingly urging the valve toward closed position and rendered inoperative at high temperatures, and means responsive to suction posterior to the throttle for moving the valve to a partially opened position against the force of the temperature responsive means, said choke valve being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction.

The relation of the count of the interference to the claims of the respective parties is as follows:

Count:

	Coffey	Hunt
1-----	18	27

(Count compared.)

This interference is a continuation of Interference No. 82,261.

H. J. ALBRECHT,
Acting Examiner.

KJA:kw.

DOCUMENT No. 16

DEPARTMENT OF COMMERCE,
UNITED STATES PATENT OFFICE,
Washington 25, D. C., Oct. 10, 1946.

Please find below a communication from the Examiner of Interference in this case.

CASPER W. OOMS,
Commissioner of Patents.

Interference No. 82555

COFFEY v. HUNT

Filed Jan. 10, 1947. Charles E. Stewart, Clerk.

The preliminary statements of the parties are approved. The motion period expires November 12, 1946. The setting of

times for the taking of testimony and for final hearing is deferred until a companion case of the series is in condition for such action.

The dates of filing and serial numbers of the respective applications are as follows: Irven E. Coffey filed March 31, 1937, No. 134,070, patented July 27, 1943, No. 2,325,372; Scott F. Hunt filed May 26, 1934, No. 727,648.

W. E. WAITE,
Examiner of Interferences, Room 6605.

DOCUMENT No. 17

IN THE UNITED STATES PATENT OFFICE

Interference No. 82555

COFFEY v. HUNT

Filed Jan. 10, 1947. Charles E. Stewart, Clerk.

COMMUNICATION

U. S. Patent Office, Oct. 18, 1946. Docket Division.

It is noted that in the Office letter dated October 10, 1946, in the above entitled interference, the party Hunt is not given the benefit of the filing date of Hunt-Olson application Serial Number 575,025, filed November 14, 1931.

Inasmuch as Hunt's right to this earlier date was recently considered and established in the proceedings in Coffey v. Hunt Interference 82,262, it is presumed that failure to give him the benefit of the earlier date was inadvertent.

It is requested that the record be made to show Hunt entitled to the filing date in question.

Copy of this paper has been mailed to counsel for Coffey.

Respectfully,

SCOTT F. HUNT.
By A. R. McGRADY,
Attorney.

DETROIT, MICHIGAN, *October 15, 1946.*
ARM:ah.

DOCUMENT No. 18

IN THE UNITED STATES PATENT OFFICE

Interference No. 82555

COFFEY v. HUNT

U. S. Patent Office, Nov. 12, 1946. Docket Division. Filed
Jan. 10, 1947. Charles E. Stewart, Clerk.

MOTION TO SHIFT THE BURDEN OF PROOF

Now comes the party Coffey and moves that the burden of proof in the above-entitled interference be shifted to the party Hunt for the following reasons:

The party Coffey is entitled to rely for constructive reduction to practice of the invention set forth in the count of this interference upon his patent No. 2,085,351, the application for which, Serial No. 679,201, was filed July 6, 1933 and of which the application for his patent No. 2,325,372 involved in this interference is a continuation in part, as expressly stated in said patent No. 2,325,372.

The disclosure in patent No. 2,085,351 of the invention defined by the count of this interference appears from the following copy of said count in which has been parenthetically inserted the reference numerals by which the structural features recited in said count are respectively identified in said patent No. 2,085,351:

"Count 1: In combination with an internal combustion engine (3 and 4 are respectively the intake manifold and exhaust manifold of an internal combustion engine), a carburetor (1) having a throttle (5) and a pressure responsive choke valve (30), temperature responsive means (54) yieldingly urging the valve (30) toward closed position and rendered inoperative at high temperature (the hook at the outer end of the thermostatic coil 54 engages the pin 58 of the lever 44 when the engine is cold and moves out of engagement with the pin 58 when the engine temperature is high), and means responsive to suction (suction pipe 53, piston chamber 47, disk-shaped piston 45, radial lever arm 44 rigidly secured to the end of the choke valve shaft 31, and curved connecting rod 46 connecting the lever 44 to the piston 45) posterior to the throttle (the suction pipe 53 communicates with the intake manifold 3 posterior to the throttle 5) for moving the valve (30) to a partially opened position against the force of the temperature responsive means

(54), said choke valve (30) being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction (this being the manner of operation of the choke valve 30 described in patent No. 2,085,351 and specifically set forth in the final clause of each of claims 39 and 40 thereof in the identical words of the count)."

It is requested that his motion be heard and determined by the primary examiner as provided in Rule 122.

It is hereby certified that, in the opinion of the attorney for Coffey, this motion is well founded in fact and in law, and is not brought for purpose of delay. A copy of this paper has this day been mailed to the attorney for Hunt.

GEORGE R. ERICSON,
Attorney for Coffey.

WASHINGTON, D. C., November 12, 1946.

IN THE UNITED STATES PATENT OFFICE
BEFORE THE EXAMINER OF INTERFERENCES

Interference No. 82554

HUNT v. HENNING

Interference No. 82555

COFFEY v. HUNT

Interference No. 82262

COFFEY v. HUNT

U. S. Patent Office, Nov. 13, 1946. Docket Division.

AFFIDAVIT

CITY OF ST. LOUIS,
State of Missouri, ss:

Irven E. Coffey being duly sworn deposes and states as follows:

That he is an engineer engaged in developing, designing, testing, and manufacturing carburetors, automatic chokes, and other devices for use in connection with internal combustion engines;

That he has had many years experience in the engineering, testing, development, and sale of such devices;

That he has read and is familiar with the automatic choke device disclosed in the Hunt and Olson application, Serial No. 575,025, filed November 14, 1931;

That he is also familiar with the carburetor and automatic choke device disclosed in the Hunt application, Serial No. 727,648, filed May 26, 1934;

That he has tested such devices and is thoroughly familiar with the actual operation thereof;

That the correct operation of said automatic choke is as described on page 7 of said application, Serial No. 727,648 as follows:

"In operation, assuming the engine is cold and being cranked, the parts are in the position shown in Figures 1, 2, and 3, the choke valve being maintained in its fully closed position, against the air pressure tending to open it, by the toggle mechanism which prevents shaft 56 from rotating. The suction developed in the manifold by cranking is insufficient to actuate piston 42, hence air enters the carburetor only through the poppet valve 22.

"When an explosion occurs in the cylinders, however, the manifold suction becomes greater and draws piston 42 downwardly against the force of spring 44, causing the end of 50 of lever 48 to move pin 71 to the right well beyond its dead center position, leaving shaft 56 free to rotate. The choke valve then opens under the influence of the differential of pressure on its opposite faces, the only retarding force acting on the choke valve being that of the thermostatic element 62, which while cold exerts a torque on shaft 56 tending to close the choke valve. This results in the choke valve being maintained in an intermediate position representing a balance between the opening force of the air stream and the closing force of the thermostat.

"This condition obtains until the exhaust manifold 60 becomes heated, whereupon the temperature of element 62 gradually rises and the element tends to straighten and exerts a decreasing torque on shaft 56, until when the motor is fully warmed up the end 63 of element 62 has moved to the dotted line position of Figure 3 so that the thermostat has no effect on the operation of the choke valve, which remains fully open as long as the engine is running."

That he has read and fully understands the patents to Coffey, Nos. 2,085,351 and 2,325,372, and Henning No. 2,306,251 and particularly claims 39 and 40 of said Coffey patent No. 2,085,351, claim 18 of said Coffey patent No. 2,325,372, and claim 7 of said Henning patent No. 2,306,251;

That none of said claims correctly describe the operation of the automatic choke disclosed in said applications Serial Nos. 575,025 and 727,648 in that the structure and operation required by the claims is inconsistent with the structure and operation set forth in the disclosure of said application and particularly that in the device disclosed in said application, the suction operated piston does not move the choke valve to open position either against the force of the temperature responsive means or in any way whatever but merely breaks the toggle to permit the opening of the choke valve by the direct action of suction;

Further, deponent sayeth not.

Irven E. Coffey.
IRVEN E. COFFEY.

Sworn to and subscribed before me this 11th day of November 1946.

GLADYS J. MURRAY,
Notary Public.

My commission expires Aug. 29, 1949.

IN THE UNITED STATES PATENT OFFICE
BEFORE THE EXAMINER OF INTERFERENCES

Interference No. 82554

HUNT v. HENNING

Interference No. 82555

COFFEY v. HUNT

Interference No. 82262

COFFEY v. HUNT

AFFIDAVIT

CITY OF ST. LOUIS,
State of Missouri, ss:

James L. Edelen being duly sworn deposes and states as follows:

That he is an engineer engaged in developing, designing, testing, and manufacturing carburetors, automatic chokes, and other devices for use in connection with internal combustion engines;

That he has had many years experience in the engineering, testing, development, and sale of such devices;

That he has read and is familiar with the automatic choke device disclosed in the Hunt and Olson application, Serial No. 575,025, filed November 14, 1931;

That he is also familiar with the carburetor and automatic choke device disclosed in the Hunt application, Serial No. 727,648, filed May 26, 1934;

That he has tested such devices and is thoroughly familiar with the actual operation thereof;

That the correct operation of said automatic choke is as described on page 7 of said application, Serial No. 727,648 as follows:

"In operation, assuming the engine is cold and being cranked, the parts are in the position shown in Figures 1, 2, and 3, the choke valve being maintained in its fully closed position, against air pressure tending to open it, by the toggle mechanism which prevents shaft 56 from rotating. The suction developed in the manifold by cranking is insufficient to actuate piston 42, hence air enters the carburetor only through the poppet valve 22.

"When an explosion occurs in the cylinders, however, the manifold suction becomes greater and draws piston 42 downwardly against the force of spring 44, causing the end 50 of lever 48 to move pin 71 to the right well beyond its dead center position, leaving shaft 56 free to rotate. The choke valve then opens under the influence of the differential of pressure on its opposite faces, the only retarding force acting on the choke valve being that of the thermostatic element 62, which while cold exerts a torque on shaft 56 tending to close the choke valve. This results in the choke valve being maintained in an intermediate position representing a balance between the opening force of the air stream and the closing force of the thermostat.

"This condition obtains until the exhaust manifold 60 becomes heated, whereupon the temperature of element 62 gradually rises and the element tends to straighten and exerts a decreasing torque on shaft 56, until when the motor is fully warmed up the end 63 of element 62 has moved to the dotted line position of Figure 3 so that the thermostat has no effect on the operation of the choke valve, which remains fully open as long as the engine is running."

That he has read and fully understands the patents to Coffey, Nos. 2,085,351 and 2,325,372, and Henning No. 2,306,251 and particularly claims 39 and 40 of said Coffey patent No. 2,085,351,

claim 18 of said Coffey patent No. 2,325,372, and claim 7 of said Henning patent No. 2,306,251;

That none of said claims correctly describe the operation of the automatic choke disclosed in said applications Serial Nos. 575,025 and 727,648 in that the structure and operation required by the claims is inconsistent with the structure and operation set forth in the disclosure of said application and particularly that in the device disclosed in said application, the suction operated piston does not move the choke valve to open position either against the force of the temperature responsive means or in any way whatever but merely breaks the toggle to permit the opening of the choke valve by the direct action of suction;

Further, deponent sayeth not.

James L. Edelen.
JAMES L. EDELEN.

Sworn to and subscribed before me this 11th day of November 1946.

GLADYS J. MURRAY,
Notary Public.

My Commission Expires Aug. 29, 1949.

DOCUMENT No. 19

DEPARTMENT OF COMMERCE,
UNITED STATES PATENT OFFICE,
Washington 25, D. C., Nov. 20, 1946.

Please find below a communication from the Examiner of Interference in this case.

CASPER W. OOMS,
Commissioner of Patents.

Interference No. 82555

COFFEY v. HUNT

Filed Jan. 10, 1947. Charles E. Stewart, Clerk.

The Assistant Commissioner having ruled in the companion interference referred to by the party Hunt in his communication dated October 17, 1946, that Hunt should be given the benefit of the date of Hunt-Olson application Ser. No. 575,025 with respect to claims including a claim corresponding to the issue of this interference, without consideration of a motion to shift the burden of proof, the record will be made to show

that Hunt is entitled to the filing date of the earlier Hunt-Olson application.

The motion filed by the party Coffey on November 12, 1946, is granted and in accordance therewith the time for bringing motions is extended to December 12, 1946.

W. E. WAITE,
Examiner of Interferences, Room 6605.

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Filed Jan. 10, 1947

In the District Court of the United States
For the District of Columbia.

Civil Action No. 37,782.

CARTER CARBURETOR CORPORATION, *Plaintiff*

v.

CASPER W. OOMS, Commissioner of Patents, *Defendant.*

Affidavit.

On Motion For Preliminary Injunction
Staying Proceedings In Patent Office.

CITY OF ST. LOUIS,

STATE OF MISSOURI, ss:

George R. Ericson, being duly sworn, says:

1. I am a director of Carter Carburetor Corporation, plaintiff in the above-named action and am an attorney at law. For the past eighteen years, I have practiced before the United States Patent Office in matters relating to the soliciting and prosecution of applications for patents and in the conduct of interference proceedings. I am the attorney of record in the Patent Office for plaintiff in interferences No. 82,262, Hunt v. Coffey, No. 82,554, Hunt v. Henning, and No. 82,555, Coffey v. Hunt, and have been actively engaged in the conduct of all proceedings therein since their institution. I was also the attorney for plaintiff in the related interferences No. 76,519, Henning v. Hunt, and No. 78,346, Hunt v. Coffey; and I have
57 acted as attorney in many other interference proceedings and am familiar with the practice in the Patent Office in such proceedings.

2. This civil action, No. 37,782, is for judgment (a) that the Commissioner of Patents was without jurisdiction or authority in law to make his decision or order of July 19,

1946 in said interference No. 82,262, Hunt v. Coffey, shifting the burden of proof in that interference from Hunt to plaintiff's assignor, Irven E. Coffey; (b) that in denying the petition of Coffey to vacate the said decision of July 19, 1946, the Commissioner acted arbitrarily and in violation of Rules 116, 122, 124, 159 and 199 of the Rules of Practice in the United States Patent Office; and (c) that the Commissioner be commanded to vacate and set aside the said decision or order and to direct the Examiner of Interferences to disregard said order and to proceed in said interferences No. 82,262, No. 82,554 and No. 82,555 in conformity with the Rules of Practice in the Patent Office as if such order had not been made or entered.

3. The same patent application of Scott F. Hunt filed May 26, 1934, Serial No. 727,648 is involved in each of said interferences No. 82,262, No. 82,554 and No. 82,555, and was also involved in the earlier declared interferences No. 76,519 and No. 78,346. The same Irven E. Coffey patent No. 2,085,351 which is involved in interference No. 82,262, was also involved in said interference No. 78,346; and the Otto F. Henning patent No. 2,306,251 involved in interference No. 82,554 is a division of the Henning application, Serial No. 575,577 which was involved in said interference No. 76,519. The Coffey patent No. 2,325,372 involved in interference No. 82,555 is a continuation in part of
 58 the application for said Coffey patent No. 2,085,351.

4. The plaintiff is the owner of the entire right, title and interest in and to the above mentioned patents and applications of Coffey and of Henning.

5. Interference No. 76,519 was declared November 30, 1938, between the application, Serial No. 575,577, of plaintiff's assignor, Henning, which was filed November 17, 1931, and the application of Hunt, Serial No. 727,648, which was filed May 26, 1934.

Interferences Nos. 76,519 and 78,346 were declared as a result of certain proceedings in interference No. 74,876,

which interference involved, inter alia, the said application No. 575,577 of Henning filed November 17, 1931, the application of Irven E. Coffey, Serial No. 134,070 which was later granted and issued as said patent No. 2,325,372, and an application of said Scott F. Hunt, Serial No. 630,274, which was filed August 24, 1932. Henning was the senior party, but later conceded that Coffey was the first inventor of the subject matter of certain claims.

6. Upon the declaration of interference No. 76,519, Hunt was made the senior party, apparently on the ground (not raised by Hunt in interference No. 74,876) that Hunt's sole application, Serial No. 727,648, was a continuation in part of the joint application of Hunt and Olson, Serial No. 575,025, filed November 14, 1931.

Plaintiff's assignee, Henning, thereupon moved to shift the burden of proof in interference No. 76,519 to the party Hunt on the ground that Hunt was not entitled to the benefit of the filing date of the said joint Hunt and Olson application, Serial No. 575,025, and that Hunt was estopped to claim any prima facie benefit of the filing date of the joint Hunt and Olson application, because he had not, during the motion period in interference No. 74,876, made any motion to obtain any such benefit thereof.

Henning also moved to dissolve interference No. 76,519 on the ground that the party Hunt had not, on the face of the record, filed a complete and allowable application for patent either on the subject matter involved or capable of supporting any claims whatever. Henning's motions to shift and to dissolve were dismissed by the Examiner of Interferences on the ground of estoppel against Henning for failure to raise them during the original motion period in interference No. 74,876. Upon Henning's request for reconsideration and a showing by him that no such estoppel existed, the motion to dissolve was set for hearing by the Examiner of Interferences. Upon petition to the Commissioner by Henning, the motion to shift the burden of proof was also set for hearing.

Henning's motion to shift the burden of proof to Hunt on the ground that Hunt could not rely on the Hunt and Olson application, Serial No. 575,025, for its date was granted by the Primary Examiner in his decision dated June 12, 1941, in interference No. 76,519. He stated that this part of his decision was not appealable.

In the same decision, the Primary Examiner held that Henning's motion "to dissolve on the ground that the Hunt application is not supported by a valid oath and hence will not support any claims is granted". The Primary Examiner also granted Henning's motion to dissolve on the ground that Hunt's assignee, Bendix Aviation Corporation, was estopped. These decisions were appealed to, and were affirmed by the Board of Appeals on October 30, 1941, and also January 29, 1942, upon reconsideration.

60 There were no further proceedings in interference No. 76,519 until January 14, 1946, when it was resumed under the new interference number 82,261.

7. After the Board of Appeals had affirmed the decision dissolving interference No. 76,519, and, to wit, upon May 22, 1942 Henning learned of a decision which was rendered in interference No. 74,553, Coffey v. Stanton, awarding Coffey a date of reduction to practice "at least as early as the beginning of 1931". The structure reduced to practice by Coffey included the subject matter of count 3 of interference No. 76,519, and since Henning knew that he could not establish a date prior to January 1, 1931, for invention of count 3, Henning conceded that Coffey was the inventor of that subject matter, and the count was allowed to Coffey as claim 18 of his patent No. 2,325,372 which is now involved in interference No. 82,555.

8. The claims which formed counts 1 and 2 of interference No. 76,519 were patented to Henning as claims 7 and 17 of his patent No. 2,306,251 which is now involved in interference No. 82,554.

9. After the termination of interference No. 76,519, Hunt's claims corresponding to the subject matter thereof were rejected ex parte. Hunt appealed from the rejection, but withdrew his appeal as to claim 25, and, therefore, had no further right to contest priority as to this claim.

10. When attention was called to the facts set forth in paragraphs 7, 8 and 9, supra, it became evident that interference No. 76,519, redeclared as interference No. 82,261, could not proceed between Hunt's application No. 727,648 and Henning's application No. 575,577, Hunt having lost the right to contest count 2, Henning having lost the right to contest count 3, and Henning having transferred count 1 to a divisional application and received a patent thereon. Interference No. 82,261 was thereupon dissolved and interference No. 82,554 was declared between Henning's patent No. 2,306,251 and Hunt's application, Serial No. 727,648, upon a count identical with count 1 of interference No. 76,519.

11. Interference No. 82,555 was declared between claim 18 of Coffey's patent No. 2,325,372 and claim 27 of Hunt's application, Serial No. 727,648, upon a count identical with count 3 of Interference No. 76,519, and with said claims.

12. Interference No. 78,346 was declared June 4, 1940, between Hunt's application, Serial No. 727,648, filed May 26, 1934, and plaintiff's patent No. 2,085,351, which was issued as a result of an application of Irven E. Coffey, Serial No. 679,201, filed July 6, 1933. Coffey was duly made the senior party in accordance with Rule 116 when the interference was declared.

13. The party Hunt moved to shift the burden of proof in interference No. 78,346 on the ground that he was entitled to the benefit of the filing date of the joint Hunt and Olson application, Serial No. 575,025. This motion was denied by the Primary Examiner.

14. Coffey moved to dissolve as to Hunt on various grounds, including some which were cited by the Primary Examiner as follows:

- "1. That Hunt is estopped in view of certain previous interferences.
2. That Hunt cannot make the claims.
3. That Hunt's application is defective.
4. That the counts are not patentable to Hunt because of publication more than two years prior to filing."

The motions numbered 1, 2, and 3 were granted by the Primary Examiner. There were no further proceedings in interference No. 78,346 until January 14, 1946, when the interference was resumed under the new interference number 82,262.

15. The claims which are the counts of Interference No. 82,262 are identically the same claims that were the counts of interference No. 78,346. The claim which is the sole count of interference No. 82,554 is identical with the claim which was count 1 of interference No. 76,519. The claim which is the sole count of interference No. 82,555 is identical with the claim which was count 3 of interference No. 76,519.

16. After the dissolution of said interferences No. 76,519 and No. 78,346, the Primary Examiner, on March 27, 1942, finally rejected to Hunt the claims contained in said Hunt application Serial No. 727,648 respectively corresponding to the counts of those interferences, and further prosecution of said Hunt application, Serial No. 727,648 in the Patent Office proceeded ex parte. On appeal by Hunt this final rejection was affirmed by the Board of Appeals on December 11, 1942. Thereafter, on June 11, 1943, Bendix Aviation Corporation, the owner of said Hunt application, acting under section 4915 R. S. (U.S.C., title 35, sec. 63) brought suit against the Commissioner of Patents in the United States District Court for the District of Columbia,

Civil Action No. 20,023, Bendix Aviation Corporation v. Conway P. Coe, Commissioner of Patents, demanding that the Commissioner be directed to allow the rejected claims of said Hunt application; and on April 17, 1944, judgment was entered in said civil action adjudging Bendix Aviation Corporation to be entitled to the allowance in the said Hunt application of the claims finally rejected by the Patent Office corresponding to the counts of interferences No. 76,519 and No. 78,346; and authorizing the Commissioner of Patents to issue to Hunt a patent including said claims upon the filing by Hunt in the Patent Office of a copy of the judgment and "otherwise complying with the requirements of law".

63 17. Neither Carter Carburetor Corporation, the plaintiff herein, nor the said Coffey, nor the said Henning, was a party or privy to the aforesaid Civil Action No. 20,023, wherein Bendix Aviation Corporation was plaintiff and the Commissioner of Patents was defendant.

18. Subsequent to the entry of the judgment in said Civil Action No. 20,023, the Examiner of Interferences, on January 14, 1946, again declared the said interference No. 78,346 under the new number 82,262, between the said Hunt application Serial No. 727,648 and the said Coffey patent No. 2,085,351. The claims in issue in said interference No. 82,262 are identically the same as those which were the counts of said dissolved interference No. 78,346.

19. The Examiner of Interferences upon declaring said interference No. 82,262 on January 14, 1946, made Hunt, whose application, Serial No. 727,648, was filed on May 26, 1934, the junior party and made Coffey, whose application for patent No. 2,085,351 was earlier filed on July 6, 1933, the senior party therein, in conformity with the requirement of Rule 116 of the Rules of Practice in the Patent Office placing the burden of proof upon the party last to file a completed application.

20. On the same day on which interference No. 82,262 was declared, namely on January 14, 1946, the Examiner of Interferences also again declared interference No. 76,519 under the new interference number 82,261, involving the said Hunt application, Serial No. 727,648 and application, Serial No. 575,577 of the said Henning. The counts of interference No. 82,261 were identical with the counts of said interference No. 76,519 which had been theretofore dissolved. Later, on August 20, 1946, two new interferences were substituted for interference No. 82,261. One of said substituted interferences, No. 82,554, Hunt v. Henning, 64 is between the said Hunt application, Serial No. 727,648, and the said Henning patent No. 2,306,251 and the issue thereof is the claim which was count 1 of interference No. 82,261. The other substituted interference, No. 82,555, is between the same Hunt application and said Coffey patent No. 2,325,372 and the issue thereof is count 2 of said interference No. 82,261. In accordance with the provisions of Rule 116 of the Rules of Practice in the Patent Office, Henning became the senior party in said interference No. 82,554, Henning v. Hunt.

In spite of the fact that the subject matter of the count of interference No. 82,555 is clearly disclosed in Coffey's earlier filed patent No. 2,085,351, the application for which was filed July 6, 1933, Coffey was made the junior party in said interference No. 82,555, Coffey v. Hunt, and left to his rights under Rule 122 to file a motion to obtain the benefit of the filing date of the parent application. Such motion was duly filed on November 12, 1946, but has not yet been set for hearing.

21. In the interval between the declaration of interference No. 82,261 and its replacement by said interferences No. 82,554 and No. 82,555, the party Hunt, acting under the provisions of Rule 122 of the Rules of Practice in the Patent Office, moved the Examiner of Interferences to shift the burden of proof from Hunt to Coffey in said interfer-

ence No. 82,262. Coffey opposed that motion and on June 5, 1946 it was dismissed by the Examiner of Interferences without prejudice to Hunt's right to urge at final hearing before the Board of Interference Examiners that he be given the benefit of the filing date of the said joint application of Hunt & Olson, Serial No. 575,025.

Notwithstanding that Rule 124 of said Rules of Practice expressly provides that no appeal will be permitted from a decision rendered on a motion brought under the provisions of Rule 122, the party Hunt on or about June 65 14, 1946 filed in said interference No. 82,262 a paper entitled "Petition to the Commissioner" praying "that the Commissioner review and reverse the ruling of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof". On July 19, 1946 the Commissioner of Patents, acting through Thomas F. Murphy, Assistant Commissioner, granted the said petition of Hunt "to the extent indicated", whereby it was held that Hunt should be made the senior party in said interference No. 82,262 and that the judgment of the United States District Court for the District of Columbia in said Civil Action No. 20,023, Bendix Aviation Corporation v. Coe, was *prima-facie* evidence entitling the party Hunt to the benefit of the filing date of the joint patent application of Hunt & Olson, filed November 14, 1931, Serial No. 575,025.

22. On August 1, 1946 Coffey petitioned the Commissioner of Patents to reconsider and vacate the said decision or order of July 19, 1946 made in interference No. 82,262 and to direct that interference No. 82,262 be proceeded with in accordance with the Rules of Practice of the Patent Office. The said petition so filed by Coffey showed to the Commissioner that he lacked jurisdiction or authority to make the said order of July 19, 1946, in that (a) the purported petition of the party Hunt was in character and effect nothing more than an appeal from the said decision of the Examiner of Interferences dismissing Hunt's motion

to shift the burden of proof; (b) by Rule 124 of the Rules of Practice of the Patent Office no appeal is permitted from a decision by the Examiner of Interferences on a motion to shift the burden of proof; (c) the Rules of Practice in the United States Patent Office being made under statutory authority have the force and effect of law and are binding upon the Commissioner of Patents and all officials and employees of the Patent Office as well as upon applicants for patents and parties to interferences; and 66 (d) the judgment in said Civil Action No. 20,023, Bendix Aviation Corporation v. Coe, is not competent or admissible evidence as affecting, in any way, the rights of Carter Carburetor Corporation, plaintiff herein, or of said Coffey, neither of whom was a party or privy to said civil action.

23. Thereafter, on August 14, 1946, the Commissioner of Patents, again acting through said Thomas F. Murphy, Assistant Commissioner, denied Coffey's said petition of August 1, 1946, and held that the Commissioner of Patents had power, under his supervisory authority, to review and reverse the said decision of August 8, 1946 of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof in said interference No. 82,262, stating that:

"Hunt's petition was not considered as an appeal but as a petition to the supervisory authority of the Commissioner, and the action taken on the petition (presented by Hunt on June 14, 1946) was based on such authority."

24. Following the denial by the Commissioner of Patents of Coffey's said petition of August 1, 1946, the said Coffey, on August 29, 1946, presented to the Commissioner a further petition to vacate and set aside the said order of the Commissioner of July 19, 1946 and to dismiss the said petition filed by Hunt on or about June 14, 1946. This further petition of Coffey showed, among other things, that the Commissioner of Patents lacked any authority to make the

said order of July 19, 1946 in interference No. 82,262, in that (a) the Commissioner is without power or authority to make any determinations, either of fact or of law, in any case where another and different procedure is definitely fixed by the Rules of Practice in the United States Patent Office; (b) in making said order of July 19, 1946 the
67 Commissioner had in effect abrogated and nullified Rules 116, 124 and the last sentence of Rule 159 of the said Rules of Practice; and (c) the transcript of proceedings at the trial of said Civil Action No. 20,023 reveals that no evidence of mistake in the filing of the said Hunt & Olson joint application, Serial No. 575,025, or of diligence in discovering and disclosing said mistake to the Patent Office, was there adduced.

On November 13, 1946, the Commissioner of Patents denied Coffey's said second petition of August 29, 1946.

25. The Examiner of Interferences, acting in submission to and in conformity with the said decision of July 19, 1946 of the Commissioner, on July 29, 1946 entered an order in interference No. 82,262 shifting the burden of proof therein from Hunt to Coffey and setting times for the taking of testimony therein.

26. Thereafter, the said Hunt filed in each of said interferences No. 82,554, Hunt v. Henning, and No. 82,555, Coffey v. Hunt, a "Communication" dated October 17, 1946 requesting that he be given the benefit of the filing date of the Hunt & Olson application Serial No. 575,025 in each of said interferences No. 82,554 and No. 82,555, in view of the said order of July 19, 1946 made by the Commissioner in interference No. 82,262. Acting upon said communications of Hunt, the Examiner of Interferences, on November 20, 1946, entered respective orders in interferences No. 82,554 and No. 82,555, awarding said Hunt the benefit of the filing date of said Hunt and Olson application, Serial No. 575,025.

27. Unless proceedings in the Patent Office in said interferences No. 82,262, No. 82,554 and No. 82,555 are suspended

pending determination of said Civil Action No. 37,782, Carter Carburetor Corporation v. Ooms, the plaintiff therein will be required to proceed with said interferences as though said Civil Action No. 37,782, to test the legality of the Commissioner's said order of July 19, 1946 placing the burden of proof on Coffey, had not been brought, with the result that plaintiff, Carter Carburetor Corporation, will be irreparably damaged even though the final decree of this court is in its favor. If Carter Carburetor Corporation is forced now to proceed with the taking of testimony in said interferences, it will be compelled to conform to the said decision or order of the Commissioner, the validity of which is challenged, as though it were correct and within the power of the Commissioner to make; and thereby in consequence of the burden placed upon plaintiff by the said order, necessitating the expenditure by plaintiff of considerable sums of money in locating records and witnesses in various parts of the United States and in taking testimony at such places, which might otherwise not be required.

Rule 116 of the Rules of Practice in the Patent Office is not a mere rule of procedure. It is a statement of the cardinal rule of law applied in interference contests that the party first to file a completed application for patent is presumed to be the prior inventor until his adversary overcomes that presumption by competent evidence in the interference establishing a different state of facts. It is the obligation of the party last to file an application for patent to establish as a part of his case, all the facts necessary to overcome the presumption that the party first to file an application for patent for the invention in controversy is the prior inventor.

While the Commissioner of Patents in his said decision of July 19, 1946 expressly noted that the judgment in Bendix Aviation Corporation v. Coe, Civil Action No. 20,023, was not considered *res judicata*, he held, nevertheless, that it was competent and admissible evidence to establish

prima-facie that Hunt was entitled to the benefit of the filing date of the joint application of Hunt & Olson, Serial No.

575,025, stating in his decision that "the Patent Office
69 will accept the Court's decision (in Bendix Aviation Corporation v. Coe, Civil Action No. 20,023) as correct, unless it is shown not to be so." For plaintiff to overthrow the said decision in Civil Action No. 20,023 and establish that Hunt is not entitled to the benefit of the filing date of the said joint application of Hunt & Olson, plaintiff will be required to establish by evidence the negatives that Hunt is not the sole inventor of the invention disclosed in said Hunt & Olson application, that the joinder as inventors of said Hunt and said Olson in their joint application for patent, Serial No. 575,025, was not a mistake, that the said joint application was not filed in good faith, and that reasonable diligence was not exercised to correct any mistake in the filing of said application, Serial No. 575,025 as a joint application of said Hunt and said Olson (In re Roberts, 49 App. D. C. 250; 263 F. R. 648) after its discovery. The matters determinative of whether or not Hunt is entitled to the benefit of the filing date of Hunt & Olson application, Serial No. 575,025 are facts peculiarly within the knowledge of said Hunt & said Olson. No evidence concerning those facts was adduced in said Civil Action No. 20,023. The said joint application, Serial No. 575,025 was filed November 14, 1931, more than fifteen years ago and for plaintiff now to gather evidence of the facts concerning the inventorship of the invention disclosed in said joint application would require extended and difficult inquiries and investigations and would place an undue hardship upon plaintiff. The right of plaintiff to be free of the burden of proof is a material one and, if plaintiff should be compelled to proceed with the taking of testimony in said interferences No. 82,262, No. 82,554 and No. 82,555 pending determination of Carter Carburetor Corporation v. Ooms, Civil Action No. 37,782, plaintiff would suffer serious injustice and injury.

70 28. Certified copies of the following documents referred to in this affidavit are annexed hereto and made a part hereof and are numbered consecutively from 1 to 24:

Re interference No. 82,262, Hunt v. Coffey:

- No. 1. Declaration of interference
- No. 2. Decision of Examiner of Interferences of June 5, 1946
- No. 3. Hunt's petition of June 14, 1946 to the Commissioner of Patents
- No. 4. Decision of Assistant Commissioner Murphy of July 19, 1946 on Hunt's petition to the Commissioner
- No. 5. Coffey's petition of August 1, 1946 to the Commissioner
- No. 6. Commissioner's decision of August 14, 1946 denying Coffey's petition of August 1, 1946
- No. 7. Coffey's motion of August 26, 1946 to shift the burden of proof
- No. 8. Examiner of Interferences' decision of August 30, 1946 on Coffey's motion to shift the burden of proof
- No. 9. Coffey's petition of August 29, 1946 to the Commissioner
- No. 10. Letter of November 14, 1946 of the Chief Clerk in the Patent Office announcing denial by the Commissioner of Coffey's Petition of August 29, 1946

Re interference No. 82,554, Hunt v. Henning:

- No. 11. Declaration of interference
- No. 12. Examiner of Interferences' letter of October 10, 1946 setting motion period and giving respective filing dates of parties
- No. 13. Hunt's "Communication" to the Patent Office
- No. 14. Letter of Examiner of Interferences of November 20, 1946

Re interference No. 82,555, Coffey v. Hunt:

- No. 15. Declaration of interference
- No. 16. Examiner of Interferences' letter of October 10, 1946 setting motion period and giving respective filing dates of parties

- No. 17. Hunt's "Communication" to the Patent Office
- No. 18. Coffey's motion to shift the burden of proof
- No. 19. Letter of Examiner of Interferences of November 20, 1946

71 Re interference No. 76,519, Hunt v. Henning:

- No. 20. Declaration of interference
- No. 21. Decision of June 12, 1941 of the Primary Examiner denying Hunt's motion to shift the burden of proof
- No. 22. Decision of October 30, 1941 of the Board of Appeals affirming the decision of June 12, 1941 of the Primary Examiner

Re interference No. 78,346, Hunt v. Coffey:

- No. 23. Declaration of interference
- No. 24. Decision of June 12, 1941 of the Primary Examiner denying Hunt's motion to shift the burden of proof

And further deponent sayeth not.

GEORGE R. ERICSON

Subscribed and sworn to before me this 7th day of January 1947.

GLADYS J. MURRAY

(Seal)

Notary Public

My Commission Expires Aug. 29, 1949

Document No. 5

Mail Division
Aug 1 1946
U. S. Patent Office

U. S. Patent Office
Aug 2 1946
Docket Division

IN THE UNITED STATES PATENT OFFICE
Before the Commissioner of Patents

Interference No. 82,262

SCOTT F. HUNT

v.

IRVEN E. COFFEY

Petition to the Commissioner.

To Reconsider And Vacate Decision of Commissioner And
To Direct That The Interference Be Proceeded With
91 In Accordance With The Rules of Practice In the Patent Office And For Other Purposes.

To the Hon. Commissioner of Patents:

Your petitioner, Irven E. Coffey, is advised that the decision of the Assistant Commissioner of Patents of July 19, 1946 in the above-entitled interference upon the petition of the party Hunt is erroneous and unjust and should be vacated, in that it is not within the power of the Commissioner of Patents to adjudge, as in his said decision he has done, that the party Hunt "should be made the senior party, without consideration of his motion to shift the burden of proof"; and in that the judgment of the District Court of the United States in Civil Action No. 20,023, Bendix Aviation Corporation v. Coe, brought under Section 4915 R. S. to which the patentee Coffey was neither a party nor privy, constitutes no lawful basis for the said decision.

Your petitioner shows:

I

This interference, No. 82,262, is a proceeding instituted, for the purpose of determining the question of priority of invention between Scott F. Hunt, who on May 26,
92 1934 filed application for patent Serial No. 727,648, and Irven E. Coffey, who on July 6, 1933 filed appli-

cation for patent upon which patent No. 2,085,351 was granted on July 29, 1939, both claiming the same invention.

II

The Primary Examiner having complied in all respects with the provisions of Rule 97 of the Rules of Practice in the Patent Office, the said interference No. 82,262 was declared on January 14, 1946 as provided in Rule 102 of the said Rules then in force and, upon the institution and declaration of the interference, the Examiner of Interferences took jurisdiction thereof and the interference became a *contested case* under the provisions of Rule 101 of the said Rules of Practice, said Rules 101 and 102 being as follows:

“101. Upon the institution and declaration of the interference, as provided in rule 102, the examiner of interferences will take jurisdiction of the same, which will then become a contested case.

“102. When the notices of interference are in proper form, the examiner of interferences shall add thereto a designation of the time within which the preliminary statements required by rule 110 must be filed, and shall, pro forma, institute and declare the interference by forwarding the notices to the several parties to the proceeding.”

III

In and by the said declaration, the party Coffey whose application for his said patent involved in this interference was, as aforesaid, filed in the Patent Office prior to the filing therein of the said Hunt application, was made the senior party and the party Hunt the junior party in said interference, and the burden of proof rested upon the party Hunt to establish a different state of facts, all in accordance with the provisions of Rule 116 of the said Rules of Practice, which is as follows:

93 “116. The parties to an interference will be presumed to have made their inventions in the chrono-

logical order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

“The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-matter solely on the ground that such claim was not added to the interference by amendment under rule 109.”

IV

Subsequent to the institution and declaration of said interference on January 14, 1946, the junior party Hunt brought a motion in accordance with the provisions of Rule 122 of said Rules of Practice to shift the burden of proof placed upon him by said Rule 116, the said Rule 122 being in the following words and figures:

“122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claims, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact *and also motions to shift the burden of proof*, should contain a full statement of the grounds relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. *Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner*, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be

given for the delay, it will not be considered and *the parties will be so notified.*

- 94 “At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. *The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.*” (Emphasis added)

V

By the provisions of Rule 122, the jurisdiction and duty to hear and determine a motion to shift the burden of proof to establish a state of facts different from that presumed to exist as fixed by said Rule 116 is vested in the Primary Examiner, and the Examiner of Interferences can consider a motion to shift the burden of proof only to the extent of determining whether, in his opinion, it is in proper form, or if it be not brought within the proper time and no satisfactory reason given for the delay. The said Rule 122 fixing the respective duties and powers of the Examiner of Interferences and of the Primary Examiner is in the following words:

“ * * * Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be *heard and determined by the primary examiner*, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.”

VI

Under the provisions of Rule 122 of said Rules of Practice, it is the duty of the Examiner of Interferences either to transmit a motion to shift the burden of proof to the Primary Examiner for hearing and determination, or to

notify the parties to the interference that it will not be considered; but the Examiner of Interferences did neither of the things required by said Rule to be done by him and instead of refusing consideration of the motion did
 95 himself consider said motion and on June 5, 1946 ruled that

“The motion to shift by Hunt is dismissed without prejudice to his right to urge at final hearing that he be given the benefit of the joint application referred to therein” (namely the said joint application of Hunt & Olson, Serial No. 575,025)

VII

Rule 124 of the Rules of Practice in the Patent Office expressly provides that no appeal may be taken to the Commissioner from a decision rendered on a motion brought under the provisions of Rule 122 to shift the burden of proof in an interference, said Rule 124 being as follows:

“124. *No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.*

“Appeals may be taken directly to the Commissioner from decisions *on such other motions* as, in his judgment, should be appealable.” (Emphasis added)

The Rule is valid and prohibits an appeal to the Commissioner of Patents from a motion brought under Rule 122 to shift the burden of proof; United States *ex rel.* Lowry v. Allen, 203 U. S. 476, 51 L. ed. 281.

VIII

Following the said decision of the Examiner of Interferences on his motion to shift the burden of proof, Hunt on June 15, 1946 filed a paper in the interference which, although entitled “Petition to the Commissioner”, was in fact and in substance an attempted appeal from the said decision of the Examiner of Interferences on the motion to

shift the burden of proof, as is apparent from the first sentence of said "Petition" which reads

96 "Your petitioner, Scott F. Hunt, a party to the above entitled interference, prays that the Commissioner review and reverse the ruling of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof."

and as is also apparent from the last paragraph of said "Petition", which reads as follows:

"For the foregoing reasons, it is submitted that the ruling of the Examiner of Interferences on Hunt's motion to dissolve should be remanded to the Examiner of Interferences with instructions to make a new ruling in accordance with the court's decision."

The "court's decision" referred to by Hunt in the immediately preceding quotation from his "Petition" is a judgment of the United States District Court for the District of Columbia in Bendix Aviation Corporation v. Coe, Civil Action No. 20,023, brought by Hunt's assignee under Section 4915 R. S. to reverse a decision of the Board of Appeals rendered in the ex parte prosecution of said Hunt application in the Patent Office, to which Civil Action Coffey was neither a party nor privy.

IX.

Concurrently with the filing of his pretended "Petition" to the Commissioner, the party Hunt filed before the Examiner of Interferences a paper entitled "Request for Reconsideration", asking reconsideration of the decision of June 5, 1946 of the Examiner of Interferences on Hunt's motion to shift the burden of proof in this interference.

X.

The Examiner of Interferences, acting upon Hunt's request for reconsideration of said decision of June 5, 1946

on said motion to shift the burden of proof, reconsidered his decision and on July 10, 1946 held that the action taken by him on June 5, 1946 was "deemed proper and is adhered to". In his said decision of July 10, 1946 the Examiner of Interferences seemingly indicated that, in his opinion, Hunt's motion to shift the burden of proof was defective, saying (decision, page 1):

"The motion to shift filed April 8, 1946 made no attempt to apply the counts to the earlier application (of Hunt and Olson, Serial No. 575,025) and referred to no showing to establish that Hunt as sole inventor is entitled to rely upon the joint application, but relied entirely upon an uncertified copy of certain conclusions of law in a Civil Action."

XI.

Notwithstanding the provisions of the several Rules of Practice hereinbefore referred to, and particularly Rules 101, 116, 122 and 124, your petitioner avers that the Commissioner, without authority or jurisdiction to do so and in violation of said rules, did erroneously entertain and decide the alleged "Petition" of Hunt, ruling in a decision dated July 19, 1946 that Hunt "should be made the senior party, without consideration of his motion to shift the burden of proof".

XII.

Your petitioner shows that the Rules of Practice in the United States Patent Office, being made in pursuance of authority delegated by Congress (Section 483 R. S., U. S. C., title 35, sec. 6), have the force of law if they are not inconsistent with the provisions of the statutes relating to the patent system and that such rules as long as they remain unrepealed are binding upon the Commissioner and all officials of the Patent Office as well as upon applicants for patents.

98 United States v. Eaton, 144 U. S. 677, 36 L. ed. 591;
 Caba v. United States, 152 U. S. 211, 38 L. ed. 415;

United States ex rel. Steinmetz v. Allen, 192 U. S. 543, 48 L. ed. 555; United States v. Moody, 164 F. 269, 275; Westinghouse Traction Brake Co. v. Christensen, 243 F. 901, 905; Fish v. Dyson, 4 F. 2d 175; Avery v. Chase, 101 F. 2d 205, 212; United States ex rel. Koechlin v. Marble, Commissioner, 1882 C. D. 442; United States ex rel. Steinmetz v. Allen, 1903 C. D. 578, 585 (App. D. C.); Mell v. Midgley, 1908 C. D. 512, 31 App. D. C. 534; Broadwell v. Long, 1911 C. D. 300, 36 App. D. C. 418.

XIII.

Your petitioner avers that the said decision of the Commissioner of July 19, 1946 has been made arbitrarily and without due warrant of law and in violation of the Rules of Practice in the Patent Office, and particularly Rules 116, 122 and 124, and that it is the duty of the Commissioner to vacate and set it aside and to direct the Examiner of Interferences to act upon Hunt's motion to shift the burden of proof in accordance with the provisions of said Rule 122, either notifying the parties to this interference that said motion will not be considered or transmitting it to the Primary Examiner for hearing and determination by him.

XIV.

Your petitioner avers that the party Hunt filed no complete application for patent for the invention in issue in this interference prior to the filing on May 26, 1934 of his application for patent Serial No. 727,648, even if said application Serial No. 727,648 is in fact a complete application for patent; and your petitioner avers that the joint application of Hunt and Olson, Serial No. 575,025, filed November 14, 1931, is not and never was a complete
 99 application of the party Hunt for letters patent, but, on the contrary, from the time of its filing, continuously until it was forfeited for the non-payment of the final fee required to be paid after its allowance, the said application Serial No. 575,025 was the joint application of Hunt and Olson.

XV.

Your petitioner shows that the said joint application of Hunt & Olson was never amended to convert it into a sole application of the party Hunt and that it contains no oath of the party Hunt that he believes himself to be the inventor of the improvement for which the said Joint application solicited a patent and your petitioner, therefore, avers that the said joint application of Hunt & Olson is not and never was a completed application of the party Hunt so as to entitle him under the provisions of Rule 116 of the Rules of Practice in the Patent Office to be presumed to have made the invention in issue in this interference on the date the joint application of Hunt & Olson was filed or on any other date prior to the filing of the Hunt sole application Serial No. 727,648, filed May 26, 1934; and your petitioner further shows that, after the filing of the said sole application of Hunt No. 727,648, the said joint application of Hunt & Olson was continued to be prosecuted as a joint application and the allowance of claims was solicited and obtained therein, the official notice of allowance being dated June 26, 1935; and your petitioner avers that the continued prosecution of the joint application of Hunt & Olson after the sole application of Hunt Serial No. 727,648 was filed is inconsistent with any claim by the party Hunt that the said joint application of Hunt & Olson was for an invention which was the sole application of Hunt.

100

XVI.

And your petitioner further avers that the decision of the Commissioner of Patents of July 19, 1946 is erroneous and should also be vacated and set aside for the further reason that it is unsupported by any evidence which is admissible in this interference which, as provided by Rule 101 of said Rules of Practice, became an inter partes contested case upon the declaration of this interference.

XVII.

Your petitioner avers that the matter in issue in this interference is the question of priority of invention and that the said erroneous decision of the Commissioner shifting the burden of proof and making Hunt the senior party in this interference affects the issue of priority of invention, in that by reason thereof, if no testimony were taken by either party to the interference, judgment of priority of invention would be given in favor of the party Hunt upon the ground that he was first to constructively reduce the invention to practice.

XVIII.

Your petitioner avers that the established rules of evidence should be applied in contested cases in the Patent Office, to the end that a just and right decision may be rendered; and your petitioner directs attention to Rule 159 of the Rules of Practice in the Patent Office which specifically provides that established rules of evidence "will be applied strictly in all practice before the office" (the Patent Office).

101

XIX.

Your petitioner avers that the decision of the Commissioner of July 19, 1946, in respect to the holding that Hunt is entitled to the status of senior party in this interference, is, as the decision itself states, based upon a judgment in Civil Action No. 20,023, Bendix Aviation Corporation v. Coe, brought in the United States District Court for the District of Columbia.

XX.

Your petitioner avers that, whether right or wrong and however binding upon the Commissioner of Patents in the ex parte prosecution of the Hunt application Serial No. 727,648 they may be, the said judgment and findings of fact and conclusions of law are not binding in this interference either upon the Commissioner or upon the party Coffey and

are not competent evidence in this interference, in that they are not *res judicata* with respect to the party Coffey for the reason that he was neither a party nor privy to said Civil Action No. 20,023, Bendix Aviation Corporation v. Coe, wherein said judgment was entered, and in that said judgment does not require the Commissioner to act otherwise than by "complying with the requirements of law"; and your petitioner avers that it is an established rule of evidence, completely settled and long at rest that a former judgment can only be evidence where it is between the same parties or privies.

Taber v. Perrot et al, 2 Gall. 565, Fed. Case No. 13721; Hurst v. McNeil, Fed. Case No. 6936; Baring v. Fanning, Fed. Case No. 982; Hale et al. v. Finch, 104 U. S. 261, 26 L. ed. 732; Litchfield v. Crane, 123 U. S. 549, 31 L. ed. 199.

102

XXI

Your petitioner avers that the question of shifting the burden of proof relates to a matter of admissible evidence (Fennell v. Brown v. Borsch, 1905 C. D. 117), for if, as provided in said Rule 116 a party is required to establish that not he but another party should bear the burden of proof, evidence that is admissible must be adduced in the interference to warrant granting a motion to shift and, unless the right to shift the burden of proof is clear, the motion should be denied (Jackson v. Patten, 1910 C. D. 2).

XXII

The Commissioner, while acknowledging in his decision that "Coffey was not a party to the proceeding in the District Court, (Bendix Aviation Corporation v. Coe, Civil Action No. 20,023) and its decision is not *res judicata* as to him", nevertheless, in violation of the established rule of evidence before mentioned, erroneously accepted said judgment as competent evidence in this interference, declaring that "the Patent Office will accept the Court's decision as correct, unless it is shown not to be so", and thereupon hold-

ing that "*Prima facie*, therefore, Hunt is entitled, in this proceeding, to the benefit of the filing date of the joint application" (of Hunt & Olson, Serial No. 575,025); and your petitioner avers that the decision of the Commissioner, by violating said established rule of evidence, has unjustly and unlawfully placed upon the party Coffey the onus of proving that the said court's decision is not correct, notwithstanding that Coffey was not a party to said Civil Action, nor notified of its pendency, nor had any opportunity or right to control any proceeding therein, nor to introduce evidence, nor to cross examine witnesses, nor to appeal from the judgment therein; and the party Coffey is without any knowledge as to the testimony or other evidence upon which said judgment was based and avers that the papers in said Civil Action on file in the United States District Court for the District of Columbia do not include any transcript or other document disclosing the evidence adduced in said action.

Wherefore, the party Coffey requests:

1. That the decision of the Commissioner of Patents of July 19, 1946 in this interference be vacated and set aside by the Commissioner.
2. That the Commissioner of Patents direct the Examiner of Interferences to act upon Hunt's said motion to shift the burden of proof as required by Rule 122 of the Rules of Practice in the Patent Office, either refusing to consider said motion or transmitting it to the Primary Examiner for hearing and determination as provided in said Rule.
3. That all proceedings in this interference be stayed pending decision upon this petition.

This request for reconsideration is believed to be well founded in law and in fact and is not made for delay. A copy hereof has been mailed this day to counsel for Hunt.

Very respectfully,

G. R. ERICSON,
Counsel for Coffey.

Washington, D. C.
August 1, 1946.

Document No. 6.

104

Copy Mailed
Aug 1 1946
Commissioner's Office

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

August 14, 1946.

In re Interference No. 82,262
Coffey v. Hunt,
Carburetors.

Petition.

The party Coffey petitions for reconsideration of the decision rendered July 19, 1946, on a petition by Hunt, in which decision it was held that Hunt should be made the senior party on the basis of a joint application of Hunt and Olson, No. 575,025, filed November 14, 1931.

Hunt's petition was not considered as an appeal but as a petition to the supervisory authority of the Commissioner, and the action taken on the petition was based on such authority.

Rule 116 of the Rules of Practice of the Patent Office provides that:

"The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts."

In view of the express holdings of the United States District Court for the District of Columbia in Civil Action No. 20,023, Bendix Aviation Corporation v. Coe, it must be held that prima facie application No. 575,025 completely discloses the subject matter of the said interference and that Hunt is entitled to the benefit of the filing date thereof.

This date is prior to the filing of any application by Coffey disclosing the invention here in issue. Rule 116 therefore requires that Hunt be made the senior party.

The decision of July 19, 1946 has been carefully considered in the light of Coffey's petition for reconsideration, but no reason is found for modifying the action previously taken, and the petition, so far as it seeks any change in the said decision, is denied.

THOMAS F. MURPHY,
Assistant Commissioner.

George R. Ericson (for Coffey)
2834-46 N. Spring Avenue,
St. Louis, Mo.

Charles M. Funkhouser (for Hunt)
McLachlen Building,
Washington, D. C.

Document No. 7.

105

Mail Division
Aug 26 1946
U. S. Patent Office
U. S. Patent Office
Aug 28 1946
Docket Division

Pencil note: W/Note

In accordance with the Comm's decision under date of July 19, 1946, (see lines 2 to 6 inclusive, p. 2) continuation of C's motion to shift the burden of proof is deferred to fnl hrng.

IN THE UNITED STATES PATENT OFFICE
Before the Examiner of Interferences

Interference No. 82,262

COFFEY

v.

HUNT

Motion to Shift the Burden of Proof.

Now comes the party Coffey and moves that the burden of proof be shifted to the party Hunt for the following reason:

The party Hunt is not entitled to rely on the joint application of Hunt & Olson Serial No. 575,025, filed November 14, 1931, on the basis of which he has been made the senior party in accordance with the decision of the Assistant Commissioner of Patents of July 19, 1946 (petition for reconsideration denied August 14, 1946) for the reasons that:

1. There is no competent evidence justifying the placing of the burden of proof upon the party Coffey whose application involved in this interference was filed before that of his adversary Hunt.

Rule 116 of the Rules of Practice of the Patent Office reads in part as follows:

"116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts."

The joint application of Hunt & Olson Serial No. 575,025 is not a completed application of the party Hunt. It remained a joint application and was prosecuted as such from the time it was filed, November 14, 1931, continuously until it was forfeited for the non-payment of the final fee 106 after its allowance on June 26, 1935, more than a year subsequent to the filing of the Hunt application involved in this interference.

The Hunt & Olson application does not clearly disclose the invention defined by the counts of the interference. The determination as to whether it is a completed application of the party Hunt or whether it clearly discloses the subject-matter of the counts must turn upon an issue of fact or upon a mixed question of law and fact. This can be determined only after a full hearing thereon.

The motion to shift the burden of proof heretofore brought by the party Hunt was made under Rule 122. As to motions brought under this Rule, Rule 124 of the Rules of Practice is as follows:

"124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

"Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable."

The petition of the party Hunt to the Commissioner was in character and effect an appeal, since the petition did not seek to have the Commissioner lay down any new general

rule or principle applicable to all cases. On the contrary, it was nothing more than an appeal to the Commissioner to have him adjudge and determine that in this particular case the joint application of Hunt & Olson was in fact, as well as in law, a *completed* application of the party Hunt and that it clearly disclosed the subject-matter of the counts in issue.

The Hunt & Olson joint application Serial No. 107 575,025 is not a completed application of the party Hunt. The Hunt & Olson joint application, as pointed out above, was not converted into a sole application of Hunt.

Under the Rules of the Patent Office which have the force and effect of statute and of law, the Commissioner was without power or authority to make such determinations either of fact or of law in a particular case where the procedure governing the formation of the interference is fixed by Rules of the Patent Office promulgated by the Commissioner and approved by the Secretary of Commerce.

The judgment of the United States District Court for the District of Columbia in Civil Action No. 20,023, Bendix Aviation Corp. v. Coe, forms no proper basis for relieving the party Hunt of the burden of proof which, under Rule 116, rests upon him by reason of the fact that his application for patent was filed subsequently to that of the party Coffey. Nor do the affidavits of Olson, filed in the Hunt application Serial No. 727,648, form a proper basis for relieving Hunt of the burden of proof in this interference.

Shifting of the burden of proof is to be determined only upon admissible evidence warranting the granting of a motion to shift; Fennell v. Brown v. Borsch, 1905 C. D. 117. The party first to file an allowable application has no burden of proof until his adversary shall have introduced competent evidence showing his own independent conception of the invention in issue prior to that date; Pope v. McKenzie, 1912 C.D. 450, 38 App. D. C. 111. Shifting the burden of proof affects the issue of priority of invention for, if
108 no testimony is taken by either party to this interference, judgment of priority of invention will be

given in favor of the party Hunt; and, since the issue of priority of invention is affected by the determination of a motion to shift the burden of proof, the placing of the burden of proof should not depart from that fixed by Rule 116 except upon competent evidence.

The judgment, findings of fact and conclusions of law in said Civil Action No. 20,023 are not evidence which is competent and admissible in this interference, in that, since Coffey was neither a party nor privy to that Civil Action, a judgment entered therein is not *res judicata* with respect to him. It has long been completely settled that a former judgment can only be evidence where it is between the same parties or privies; *Taber v. Perrot et al*, 2 Gall. 565, Fed. Case No. 13721; *Hurst v. McNeil*, Fed. Case No. 6936; *Baring v. Fanning*, Fed. Case No. 982; *Hale et al v. Finch*, 104 U. S. 261, 26 L. Ed. 732; *Litchfield v. Crane*, 123 U. S. 549, 31 L. ed. 199.

Nor are the affidavits of Olson, filed in the application of Hunt, Serial No. 727,648, competent and admissible evidence in this interference because they fail to satisfy the requirement of cross-examination, or an opportunity therefor, which is the essential feature of the rule against Hearsay, for, though under oath, the statements in said affidavits were made *ex parte*, without notice to the party Coffey to afford him the opportunity of cross-examination. Moreover, the said affidavits do not set forth facts but state only the conclusions and opinions of the affiant.

2. The said Hunt & Olson application does not disclose the invention defined by the counts of the interference, in that it does not disclose "suction operated means operative to render said additional means inoperative and to
109 move the valve to at least partially opened position against the force of the temperature responsive means", as specified by count 1; and does not disclose "means responsive to a predetermined suction posterior to the throttle for rendering said additional means inoperative and for moving the valve to at least partially opened

position against the force of the temperature responsive means", as specified in count 2.

In the Hunt & Olson application, the piston 42, spring 44, link 46 and lever 48 (see Fig. 2) are the "suction operated means" of count 1, and they are also the "means responsive to a predetermined suction posterior to the throttle" of claim 2. The toggle device 70, 71, 72 is the "additional means" recited in each of said counts. While the said piston, spring, link and lever of the Hunt & Olson application constitute "suction operated means operative to render said additional means inoperative", as called for by count 1, and constitute "means responsive to a predetermined suction posterior to the throttle for rendering said additional means inoperative", as called for by count 2, they do not operate "to move" (count 1) or "for moving" (count 2) "the valve (the choke valve) to at least partially opened position against the force of the temperature responsive means", as required by the counts.

Due to suction which acts constantly on the choke valve 18 of the Hunt & Olson application during cranking of the engine and when the engine fires and is running under its own power, upward pull is continuously exerted by the choke valve upon the link 26 through which the choke is connected to the "additional means" or toggle device 70, 71, 72. As the unlocking movement of the toggle 110 links proceeds, the link 26 is continuously pulled upwardly by the choke valve in response to the suction acting upon it and, to the extent that the unlocking movement of the toggle permits the link 26 to be drawn upwardly by the choke valve, the choke valve necessarily opens in response to the suction acting upon it.

3. It is not free from doubt that the party Hunt is entitled to the benefit of the filing date of the Hunt & Olson application, Serial No. 575,025, and, therefore, under the provisions of Rule 116, the burden of proof in the interference should be upon the party Hunt, who was the last to file a completed application.

This principle is enunciated in *Munro v. Alexander*, 1903 C. D. 334, *Arnold v. Vaughen & Cabot, et al.*, 1904 C. D. 78, and *Jackson v. Patten*, 1910 C. D. 2, and is believed to be applicable to this case.

Without regard to whether the judgment in the said Civil Action is competent evidence in this interference, and whether the holding of the Court in that case is right or wrong, the fact remains that, in the prior interference No. 78,346, involving the same Coffey patent, the same Hunt application and the same counts, the primary examiner has held that the said joint application of Hunt & Olson does not disclose the subject-matter of the counts in respect to the particulars above mentioned. In addition to the decision of the primary examiner in the prior interference, the Board of Appeals likewise ruled *ex parte* in the Hunt application here in interference that the joint application of Hunt & Olson does not support the subject-matter of claims identical with the counts of this interference.

111 This motion to shift the burden of proof is brought under the provisions of Rule 122 to preserve the rights of the party Coffey and has been brought promptly after the decision of the Assistant Commissioner of Patents of August 14, 1946 denying Coffey's petition to the Commissioner to vacate the decision of the Assistant Commissioner of Patents of July 19, 1946. This motion is believed to be well founded in law and in fact and is not made for delay. A copy hereof has been mailed this day to counsel for Hunt.

Very respectfully,

GEORGE R. ERICSON,
Counsel for Coffey.

Washington, D. C.,
August 26, 1946.

112 MCL

Paper No. 47

Document No. 8.

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON, D. C.

U. S. Patent Office
Aug 30 1946
Mailed

Please find below a communication from the Examiner
of Interference in this case.

CASPER W. OOMS,
Commissioner of Patents.

Interference No. 82,262

COFFEY

v.

HUNT.

The motion to shift, filed August 26, 1946, by the party
Coffey is noted.

In accordance with the Commissioner's decision under
date of July 19, 1946, (see lines 2 to 6, inclusive, page 2)
consideration of Coffey's motion to shift the burden of
proof is deferred to final hearing.

W. E. WAITE,
Examiner of Interferences,
Room 6605

113

Document No. 9.

U. S. Patent Office
Aug 29 1946
Docket Division

IN THE UNITED STATES PATENT OFFICE
Before the Commissioner of Patents
Interference No. 82,262

COFFEY**v.****HUNT.**

**Petition of Coffey to the Commissioner to Vacate His Order
of July 19, 1946, in re Interference No. 82,262.**

Your petitioner, Irven E. Coffey, respectfully represents:

1. That on or about the 14th day of June 1946, the party Scott F. Hunt presented to the Commissioner his petition to review and reverse the ruling of the Examiner of Interferences by dismissing Hunt's motion to shift the burden of proof in the above-entitled interference No. 82,262.

2. Thereafter, on the 19th day of July, 1946, the Commissioner, acting through Hon. Thomas F. Murphy, Assistant Commissioner, granted the aforesaid petition of the said party Scott F. Hunt "to the extent indicated".

3. On August 1, 1946 the party Coffey presented to the Commissioner a petition to reconsider and vacate the decision of the Commissioner and to direct that the interference be proceeded with in accordance with the Rules of Practice and for other purposes.

4. Thereafter, on August 14, 1946, the Commissioner, acting through the said Hon. Thomas F. Murphy, Assistant Commissioner, made an order directing that the aforesaid petition of the said party Coffey "so far as it seeks any change in the said decision is denied".

Petition Denied. Casper W. Ooms, Comm'r. Nov. 13
'46.

114 5. The ground upon which the Commissioner's order of July 19, 1946, aforesaid, was based was that by reason of the judgment of the United States District Court for the District of Columbia in Bendix Aviation Corporation v. Coe, Civil Action No. 20,023, Hunt was entitled to the benefit of the filing date of a joint application of Hunt & Olson, Serial No. 575,025, filed November 14, 1931.

6. Irven E. Coffey, a party to the aforesaid interference No. 82,282, was not a party or privy to the aforesaid Civil Action No. 20,023 wherein Bendix Aviation Corporation was plaintiff and the Hon. Conway P. Coe was defendant.

7. The law is abundantly settled that a judgment or record in a former action is not admissible in evidence as affecting, in any way, the rights of any person not a party or privy thereto.

8. Rule 116 of the Patent Office established by the Commissioner of Patents and approved by the Secretary of Commerce provides:

"116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts."

By virtue of the aforesaid provisions of Patent Office Rule 116 which, under the decisions, has the force and effect of a statute, it is essential and mandatory for a party to an interference to obtain the status of a senior party that his patent application upon which he bases his claim to seniority in the interference is a "completed" application and that such application "clearly" discloses his invention.

115 9. The law is likewise well settled that, before one who has filed an application for patent can become entitled to the benefit of a prior joint patent application filed by himself and another, he must establish that the

joint application was made by mistake and that the party filing the application sole must establish factually that, after discovery of the mistake with respect to the joint application, he was diligent in correcting that mistake; In re Roberts, 1920 C. D. 158.

10. The joint application of Hunt & Olson, Serial No. 575,025, was not a completed application of the party Hunt. It remained a joint application and was prosecuted as such from the time it was filed, November 14, 1931, continuously until it was forfeited for the non-payment of the final fee after its allowance on June 26, 1935, more than a year subsequent to the filing of the Hunt application Serial No. 727,648 involved in this interference No. 82,262.

The Hunt & Olson application does not "clearly" disclose the invention defined by the counts of the interference.

The determination as to whether the joint application of Hunt & Olson, Serial No. 575,025, is a "completed" application of the party Hunt and whether it "clearly" discloses the subject-matter of the counts in interference No. 82,262 must turn upon issues of fact or upon mixed questions of law and fact which can be determined only after the introduction of evidence with respect to those issues upon a full hearing thereon.

11. Whether the joint application of Hunt & Olson, Serial No. 575,025, was the result of a mistake on the part of said applicants and, if it was a mistake on their part, when such mistake was discovered whether after the discovery of the mistake, if any, diligence was exercised in correcting or attempting to correct it are all likewise questions of fact which can be determined only after testimony has been taken and considered with respect to each and all of those issues.

12. No evidence has been adduced in interference No. 82,262 that the joint application of Hunt & Olson, Serial No. 575,025, was the result of a mistake on the part of the

said applicants Hunt & Olson, nor was any evidence adduced so far as the petitioner Coffey is aware before the Commissioner tending to establish or evince that the Hunt & Olson application was the result of any mistake whatsoever. On the contrary, the record, as hereinbefore pointed out, makes clear that the said Hunt & Olson application was prosecuted for more than a year, to allowance, after the Hunt application sole was filed.

Nor has any competent evidence been introduced in interference No. 82,262 to evince or establish that the joint application of Hunt & Olson was either a "completed" application or that it "clearly" discloses the invention of the counts in interference No. 82,262.

13. Irven E. Coffey was neither a party nor privy in or to the action of Bendix Aviation Corporation v. Coe, Civil Action No. 20,023, nor to the judgment entered therein. In the trial in that action, as appears from the transcript of the testimony and proceedings, no evidence whatsoever, so far as your petitioner Irven E. Coffey has been able to discover, was adduced that the Hunt & Olson joint application Serial No. 575,025 was the result of a mistake.

Notwithstanding diligent efforts of your petitioner Irven E. Coffey, he was unable to obtain or inspect a copy of the transcript of the evidence and proceedings in said Civil Action No. 20,023 until Monday the 26th day of
117 August 1946. A copy of the said transcript certified by Paul J. Robertson, reporter, is filed herewith and made part hereof.

Had any evidence of a mistake been adduced in said action, it would have been necessary and essential to show by competent evidence that, after the mistake was discovered, diligence was employed in rectifying such mistake; In re Roberts, 1920 C. D. 158. No such evidence was adduced.

14. Interference No. 78,346 between Scott F. Hunt and Irven E. Coffey involved the same application and the same

patent and the same counts as are involved in the pending interference No. 82,262. Coffey was made the senior party in that interference. Hunt moved therein to shift the burden of proof basing his motion upon the joint application of Hunt & Olson, Serial No. 575,025. The Examiner of Interferences denied the motion expressly basing his denial upon the reasons stated by him in interference No. 76,519 wherein he held:

“There is another reason why Hunt cannot benefit by the filing date of the Hunt-Olson application. This is because the Hunt application is not a continuation of the Hunt-Olson application at all. The decision of *in re Roberts* 1920 C. D. 158 holds that a joint application can be continued by a sole application for the same invention if one of the joint inventors was joined by inadvertence or mistake. That is not the situation here. Hunt and Olson filed joint application 575,025 on Nov. 14, 1931. Hunt filed a sole application No. 727,648 on May 26, 1934. Olson submitted an oath in the latter stating that he was not the inventor of the subject matter of the claims in this sole application. Olson has never made oath that he did not invent the matter claimed in the Hunt-Olson application. In fact after Olson's oath was filed in Hunt 727,648 the Hunt-Olson application was still prosecuted before the Office. The Hunt-Olson application was even passed to issue. The subject matter of the sole application is not the same as the subject matter of the joint application. It is therefore evident that Hunt is not an *in re Roberts* continuation. Where a joint application is a valid application, a later filed sole application cannot be given the benefit of the earlier date. In 118 *American Casting Machine Co. v. Pittsburgh Coal Washer Co.* 1917 C. D. 248; 237 Fed. 590 it was held that a patent was invalid on the ground that a sole application is not entitled to rely on a joint application where a British application was filed more than the then statutory period of seven months prior to a later sole application in the United States. The sole applicant was held barred by the issuance of the British patent on an application filed more than seven months before the sole U. S. application was filed. If

the sole inventor could have been given the benefit of the earlier joint application, the British patent would not have invalidated the patent of the sole inventor. The filing date of the joint application was not a mistake. Since this application was valid and was prosecuted to allowance after the sole application was filed the latter could not obtain any benefit from the joint case even though the joint case was later abandoned. These facts are like the facts in Hunt and Hunt-Olson. The latter was valid and was prosecuted after Hunt was filed and Hunt-Olson was afterward abandoned."

15. The aforesaid statements of the Primary Examiner in interference No. 76,519 involved the findings of fact and the application thereto of the principles of law enunciated in *In re Roberts*, 1920 C. D. 158.

In the pending interference No. 82,262 and in the showing before the Commissioner upon the petition of Scott F. Hunt, filed as aforesaid on or about the 14th day of June 1946, no facts were adduced to meet the requirements or the principles enunciated in *In re Roberts*, 1920 C. D. 158.

The transcript of record in Civil Action No. 20,023 in the United States District Court for the District of Columbia, *Bendix Aviation Corporation v. Coe*, is equally barren so far as your petitioner is able to discover of any evidence of fact to establish that Hunt is under the doctrine of *In re Roberts*, 1920 C. D. 158 or in fact entitled as against Coffey to the benefit of the filing date of the joint application of Hunt & Olson, Serial No. 575,025. Hunt's application Serial No. 727,648 was filed May 26, 1934. The joint application of Hunt & Olson, Serial No. 575,025, became forfeited on December 26, 1935 for the non-payment of the final fee after its allowance on June 26, 1935.

Obviously, it is believed, no statement made by counsel for Bendix Aviation Corporation, assignee of Hunt, during the trial of said Civil Action No. 20,023, if any such statement was made, can have any force or effect whatsoever

against your petitioner Irven E. Coffey. It is believed to be equally obvious that no admission, if any, made by counsel for the Commissioner during the trial of said Civil Action can be effective to any extent or in any degree against your petitioner herein.

16. Your petitioner confidently urges and respectfully submits that, by reason of the foregoing facts, the judgment in said Civil Action No. 20,023 is utterly without any force, effect or cogency upon Hunt's motion in the pending interference No. 82,262 to shift the burden of proof and that these grounds alone are sufficient to establish that, if Hunt's petition to the Commissioner filed on or about June 14, 1946 had shown that the conditions required by the doctrine established in *In re Roberts*, 1920 C. D. 158, had not been met and established in the trial of the aforesaid Civil Action No. 20,023 the Commissioner would not have made his order of July 19, 1946 granting the prayer of Hunt's said petition but would have dismissed the petition.

17. A further ground upon which your petitioner confidently urges and respectfully submits that the aforesaid order of the Commissioner made on July 19, 1946 should be vacated and set aside is that Rule 124 of the Rules of Practice provides:

"124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

"Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable.

120 The petition of the party Hunt to the Commissioner was in character and effect an appeal, in that it did not seek to have the Commissioner lay down any new general rule or principle applicable to all cases. On the contrary Hunt's petition was nothing more than an appeal to the Commissioner to have him adjudge and determine

the facts and the law with respect to the pending particular matter.

It is confidently urged and respectfully submitted that, under the Rules of the Patent Office which have the force and effect of statute and of law, the Commissioner was without power or authority to make such determinations either of fact or of law in any case where the procedure governing the formation of the interference is definitely fixed by Rules of the Patent Office, established by the Commissioner and approved by the Secretary of Commerce, that are general and applicable to all cases including the pending interference No. 82,262.

Wherefore your petitioner respectfully prays that the order of the Commissioner of July 19, 1946 be vacated and set aside and the petition of Scott F. Hunt filed on or about the 26th day of June 1946 be dismissed.

This petition is believed to be well founded in law and in fact and is not made for delay. A copy hereof has been mailed this day to counsel for Hunt.

Very respectfully,

GEORGE R. ERICSON,
Counsel for Coffey.

Washington, D. C.

August 29, 1946.

121
AK

Document No. 10.

Letter No. 50

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

November 14, 1946

**Petition of Coffey to the Commissioner to Vacate His Order
of July 19, 1946.**

In re Interference of

SCOTT F. HUNT

v.

IRVEN E. COFFEY

Interference No. 82,262.

Pencil Note:

In view of Commr's dec. of July 19, 1946 (Paper #34)
proceedings are resumed and times reset as follows:

Dear Sir:

The decision of the Commissioner on the above petition
is as follows:

PETITION DENIED.

CASPER W. OOMS,
Commissioner.

(Call up with other 2 cases)

WEW.

A 11/29

November 13, 1946.

Very respectfully,

J. A. BREARLEY,
Chief Clerk,
per R.

SCOTT F. HUNT,
c/o Charles M. Funkhouser,
McLachlen Bldg.,
Washington 1, D. C.
IRVEN E. COFFEY,
c/o George R. Ericson,
2834-46 North Spring Ave.,
St. Louis, Mo.

144

Document No. 20.

Nov 22 1938

Div. 28 Room 462

Letter No. —

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

EXAMINER OF INTERFERENCES:

An interference is found to exist between the following cases, and in respect to the invention therein specified, to-wit:

CASES

1. Name Scott F. Hunt
Post-office address 401 North Bendix Drive, South Bend, Indiana
Title Carburetors
Filed May 26, 1934 Ser. No. 727,648 Pat'd No.
- (2) Continuation in part of the Hunt-Olson application No. 575,025 filed November 14, 1931.
Attorneys N. D. PARKER, JR., of McLachlen Bldg., Washington, D. C., and A. R. McCrady, of 401 N. Bendix Drive, South Bend, Indiana.
Assignee The Bendix Aviation Corporation, of South Bend Ind., a corporation of Delaware.
2. Name Otto Henning
Post-office address 4967 Rosalie Avenue, St. Louis, Mo.
Title Internal Combustion Engines
Filed Nov. 17, 1931 Ser. No. 575,577 Pat'd No.
- (1) Division or continuation of
Attorney DONALD U. RICH, c/o American Car & Foundry Co., New York, N. Y. (30 Church St.)
Associate Att'y GEORGE R. ERICSON, of 2838 N. Spring Ave., St. Louis, Mo.

Assignee Carter Carburetor Corporation, of St. Louis,
Missouri, a corporation of Delaware, 2834-46 North
Spring Ave.

3. Name

Post-office address

Title Ct. 3 added
(see paper 6)

Filed Ser. No. Pat'd No.

Division or continuation of

Intf. No. 76,519

Intf. Declared Nov 30 1938

Statements due Jan 3 1939

Attorney of

Associate Att'y of

Assignee of

INVENTION

Count 1—In a carburetor, means forming a mixing conduit, a choke valve controlling the admission of air
145 to said mixing conduit, said choke valve having a part which is movable toward open position by direct action of suction, suction operated means for opening said choke valve a limited distance only, said suction operated means being constructed and arranged to permit a continuance of the opening of said choke valve after the cessation of movement of said suction operated means, and a heat responsive element connected to said choke valve to control the same in conjunction with said suction operated device.

Count 2—In a carburetor for internal combustion engines, an air passage, a throttle valve and a choke valve in said passage, said choke valve comprising a plurality of portions, one of said portions being suction operated, a shaft rigidly fixed to another of said portions, a piston connected to said shaft, a cylinder for said piston communicating with said air passage posterior to said throttle,

and a heat responsive device constructed and arranged to act in opposition to the opening of the choke valve when the temperature is low.

The relation of the counts of the interference to the claims of the respective parties is as follows:

	Count	Hunt	Henning
Prop. Ct. 2	1	22	5
“ “ 5			
“ “ 7	2	25	18
	3	27	28

(Counts Compared)

Respectfully,

H. G. SOLYOM,
Examiner, Division 28.

Ct. 3 added

(see paper 6)

GPS:bs

3

27

28

Document No. 21.

146

Mailed Jun 12 1941

Div. 28, Room 4628

Paper No. 28

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

Please find below a communication from the Examiner
in this case.

CONWAY P. COE,
Commissioner of Patents

Copy sent attorney in each case.

Interference No. 76,519.

HUNT
v.
HENNING

Examiner's Decision on Motions.

This case comes up for consideration of three motions by
the party Henning. The motions are as follows:

- I. Motion to shift the burden of proof to Hunt filed
Nov. 30, 1940.
- II. Motion to dissolve as to Hunt filed Nov. 30, 1940.
- III. Motion to dissolve as to Hunt filed Dec. 30, 1940.

THE STRUCTURES INVOLVED IN THIS INTERFERENCE.

The Henning Structure: The party Henning shows two
species, the first being in Figs. 1 to 6 and the second in
Fig. 7. The first species has a choke valve 9 which is held
in closed position when cold by thermostat 43 so that a rich
mixture is supplied for starting. As soon as the engine
fires, portion 12 of choke 9 will open against the resistance
of spring 13. At the same time suction will be supplied to

a cylinder 52 and draw piston 53 downward to open the choke 9 as a whole. As the engine heats up, the thermostat will continue to increase the opening of the choke valve. The second species need not be considered in this interference.

The Hunt Structure: Hunt shows three species. Figs. 1 and 2 show a device in which a choke valve 18 is controlled by thermostat 62 and by a suction operated toggle. The toggle mechanism 70, 71, 72 locks the choke in closed position for starting. When the engine fires suction increases to the point where piston 42 is drawn downward and 147 actuates member 50 which in turn breaks the toggle.

The toggle being broken, the choke will open due to the choke shaft being off-center and the difference in pressure on the opposite sides of the choke valve will cause it to open. The species of Figs. 4 and 5 are similar in operation to the species of Fig. 1.

DECISION ON MOTION I.

This motion raises the question of Hunt's right to the benefit of the filing date of the Hunt and Olson application No. 575,025 of Nov. 14, 1931: There are two differences between disclosures of the Hunt-Olson application and the sole application of Hunt. One of these differences is obvious upon inspection of the drawings. The other is apparent only on comparison of the two descriptions. In considering the first of these differences it is to be noted that the matter in Fig. 7 of Hunt 727,648 which is not shown in the joint application is matter which Hunt and Olson attempted to incorporate in the joint application by amendment. This matter consists of the relation of the various carburetor nozzles, venturis, jets and the throttle to the automatic choke device. The examiner held this to be new matter in the joint application. Thereupon Hunt filed a sole application containing this new matter as well as all of the original subject matter of the joint application. The other above mentioned difference between the two applica-

tions lies in the disclosure of the joint application that the choke valve opens solely due to the flow of air acting on the unbalanced choke valve whereas the sole application of Hunt states that not only this force acts on the valve but also the piston 42 operates to actually open the choke valve.

The Hunt-Olson application describes the operation as follows: "The suction developed in the manifold by
148 cranking is insufficient to actuate piston 42, hence air enters the carburetor only through the poppet valve 22.

"When an explosion occurs in the cylinders, however, the manifold suction becomes greater and draws piston 42 downwardly against the force of spring 44, causing the end 50 of lever 48 to move pin 71 to the right well beyond its dead center position, leaving shaft 56 free to rotate. The choke valve then opens under the influence of the differential of pressure on its opposite faces, the only retarding force acting on the choke valve being that of the thermostatic element 62, which while cold exerts a torque on shaft 56 tending to close the choke valve. This results in the choke valve being maintained in an intermediate position representing a balance between the opening force of the air stream and the closing force of the thermostat."

Thus it appears that since the shaft 56 is "*free to rotate*" and the choke valve "*opens under the influence of differential pressure on its opposite faces* and the valve is maintained on a position determined by *the opening force of the air stream* that the choke valve is opened solely by the air flow and thermostat. The piston 42 does not open the valve. It only actuates something which permits air flow to open it. It is to be noted that whenever piston 42 is actuated there is at the same time a differential pressure applied to the choke valve and it would always be this differential pressure which opens the choke. If piston 42 were intended to open the choke as well as to break the toggle the specification would not state that the valve is maintained

in a position representing a "balance between the opening force of the air stream and the closing force of the thermostat". The statement would have included the piston *in addition* to the thermostat.

Thus, it is apparent that the counts, which call for
149 means responsive to suction posterior to the throttle to open the choke or for suction operated means to open the choke and arranged to permit continuance of this opening are not readable on Hunt-Olson 575,025. It is, therefore, evident that Hunt is not entitled to the benefit of the filing date of the joint Hunt-Olson application.

There is another reason why Hunt cannot benefit by the filing date of the Hunt-Olson application. This is because the Hunt application is not a continuation of the Hunt-Olson application at all. The decision of *in re Roberts* 1920 C. D. 158 holds that a joint application can be continued by a sole application for the same invention if one of the joint inventors was joined by inadvertence or mistake. That is not the situation here. Hunt and Olson filed joint application 575,025 on Nov. 14, 1931. Hunt filed a sole application No. 727,648 on May 26, 1934. Olson submitted an oath in the latter stating that he was not the inventor of the subject matter of the claims in this sole application. Olson has never made oath that he did not invent the matter claimed in the Hunt-Olson application. In fact after Olson's oath was filed in Hunt 727,648 the Hunt-Olson application was still prosecuted before the Office. The Hunt-Olson application was even passed to issue. The subject matter of the sole application is not the same as the subject matter of the joint application. It is therefore evident that Hunt is not an *in re Roberts* continuation. Where a joint application is a valid application, a later filed sole application cannot be given the benefit of the earlier date. In *American Casting Machine Co. v. Pittsburgh Coal Washer Co.*, 1917 C. D. 248; 237 Fed. 590, it was held that a patent was invalid on the ground that a sole application is not entitled to rely on a joint applica-

tion where a British application was filed more than the
then statutory period of seven months prior to a
150 later sole application in the United States. The sole
applicant was held barred by the issuance of the
British patent on an application filed more than seven
months before the sole U. S. application was filed. If the
sole inventor could have been given the benefit of the earlier
joint application, the British patent would not have invali-
dated the patent of the sole inventor. The filing date of the
joint application was not a mistake. Since this application
was valid and was prosecuted to allowance after the sole
application was filed the latter could not obtain any benefit
from the joint case even though the joint case was later
abandoned. These facts are like the facts in Hunt and
Hunt-Olson. The latter was valid and was prosecuted after
Hunt was filed and Hunt-Olson was afterward abandoned.
It is evident that the motion to shift must be granted.

DECISION ON MOTION II.

This is a motion by Henning to dissolve as to Hunt on
the ground that Hunt has not an application which will
support any claim to the subject matter of this interference.
The subject matter of Hunt is different from that of Hunt-
Olson as has already been explained. The oath in Hunt's
application avers that the invention was not in public use
or sale for more than two years prior to Nov. 14, 1931 the
date of filing of Hunt and Olson 575,025. Since the subject
matter of Hunt is not the same as in Hunt-Olson the date
of the latter is not available to Hunt. Consequently, Hunt,
who filed on May 26, 1934, has failed to make an oath to
use and sale less than two years before filing, has not made
a proper oath. Since the oath is lacking in these essential
averments the application lacks any basis for the allow-
ance of any claims. An interference can exist only where
151 the parties each have an application in which the
claims are properly allowable. Hunt lacks this basic
requirement.

Furthermore, all of the claims originally in Hunt were lost by Hunt in previous interferences and if the present counts are to the *same* subject matter, Hunt is estopped. See *Spatafora v. Zaiger v. Young*, 1934 C. D. 271. If the counts are to *different* subject matter Hunt cannot rely on Hunt and Olson 575,025 for his date because Hunt's disclaimer oath covers only the original claims of Hunt. The motion to dissolve as to Hunt must therefore be granted.

DECISION ON MOTION III.

This is a motion by Henning to dissolve as to Hunt on the ground of estoppel by reason of failure to bring proper motions under Rule 109 in previous interferences.

Rule 109 provides that "any party to an interference may bring a motion to put in interference any claims already in his application or patent which should be made the basis of interference between himself and any of the other parties. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to include an application or patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties." While this statement is in the permissive form it has long been established that the rule is mandatory where applicable. In *re Austin*, 1930 C. D. 505.

The estoppel which arises out of permitting an interference to terminate without acting in accordance with the above cited portion of Rule 109 is designed to compel a party having other applications to bring them into the interference, to avoid piecemeal prosecution of interferences and to avoid consecutive interferences between the same parties on any matter disclosed in the cases in the original interference. The convenience of the Patent Office
152 and the public interest in preventing unnecessary extension of the monopoly require that all questions between the contestants be determined in the original interference as far as possible. Whether estoppel will lie de-

pend on the disclosures rather than on the claims in the applications. *Blackford v. Wilder*, 1907 C. D. 491, 501.

Estoppel by failure to act under Rule 109 applies against the common assignee of applications of different inventors to the same extent that it applies if the applications belong to the same inventor. *In re Austin*, 1930 C. D. 505. Bendix Aviation Corporation is the common assignee of several applications that have been in previous interferences with the Stanton application 600,038. The present counts obviously read on and would dominate Stanton. The following interferences involving Stanton also involved an application owned by Bendix: No. 68,187, No. 68,188, No. 71,471 and No. 68,702. Bendix allowed these interferences to terminate without bringing any motion under Rule 109 to request an interference between the present Hunt application No. 727,648 and Stanton. As to Stanton, the Bendix Corporation is therefore clearly estopped.

Hunt (Bendix) argues that any estoppel arising out of the previous interferences must accrue solely to the benefit of Stanton or Bendix and that since Henning was not a party to those interferences he cannot benefit from such estoppel. However, it is believed that it is not a question of who shall benefit. The question is whether Hunt can contest an interference on matter which he could have brought forward by motion in previous interferences in which Hunt was not the winner.

153 In view of Rule 116 the senior party is not obliged to bring forward other claims or other applications by a motion under Rule 109. Rule 116 provides that the parties will be presumed to have made their inventions in the order of filing their applications and that dissolution will not disturb this presumption and that a senior party will not lose any claim on the ground that it was not added by motion under Rule 109. Rule 116 gives to a senior party the same rights to an interference terminated by dissolution that an award of priority gives to the winner of an interference.

In *Spatafora v. Zaiger v. Young*, 1934 C. D. 271, it was held that Spatafora was estopped by virtue of a previous interference with Zaiger. In the earlier interference a final judgment that Zaiger was the first inventor was rendered. In the three party interference it was held that Spatafora was estopped in spite of an attempt by Zaiger to waive the estoppel. The Board of Appeals stated that "The presence of the third party Young in this second interference does not prevent the application of the rule of Spatafora as between Zaiger and Spatafora." The estoppel against Spatafora lay in the fact that he had failed to bring forward his secretly pending application in the two party interference.

In the present situation Bendix corresponds to Spatafora, Stanton corresponds to Zaiger and Henning. It is true that in the *Spatafora v. Zaiger* interference Zaiger was awarded priority whereas in interferences 68,187; 68,188; 68,702 and 71,471 there was no such award. However, the important thing is not the manner in which these prior interferences terminated with respect to Bendix, but that Bendix allowed them to terminate without asking for interferences with other parties having subject matter in common with Bendix applications. These prior inter-

154 ferences ended by dissolution or in the case of No. 68,702 by judgment that Hunt (Bendix) was not the first inventor. The termination as to Bendix, whether by dissolution or award of priority to an opponent, raises an estoppel if Bendix had failed to file motions under Rule 109 bringing forward the present Hunt application Ser. No. 727,648. The motion to dissolve on the ground of estoppel must accordingly be granted.

The party Hunt has argued in his brief that estoppel by reason of previous interferences applies to Henning. This is a question which Hunt has no right to raise because he failed to make any motion. However, if this ground existed against Henning the examiner would dissolve as to Henning on his own motion. Hunt alleges that the assignee of Henning failed to bring Henning into interferences No.

71,033 and 71,035 by motion under Rule 109. This is the same question raised by motion of Hunt in Interference No. 74,876. This motion was denied there. See Examiner's Decision on Motion (paper No. 38) in Interference No. 74,876 pages 22 to 24. It is to be noted that Henning's assignee *won* Interferences 71,033 and 71,035. The rule that the winner is not estopped and that an award of priority is determinative of all questions that were or could have been decided is settled and has long been followed. See *Blackford v. Wilder*, 1907 C. D. 491, and in re *Wasserfallen*, 1924 C. D. 326. The estoppel by judgment arising out of Interferences 71,033 and 71,035 applies not to Henning as alleged by Hunt but solely to Hunt himself and his assignee, Bendix Aviation Corporation.

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SUMMARY.

Henning's Motion I to shift the burden of proof as to Hunt on the ground that Hunt cannot rely on the Hunt and Olson application Ser. No. 575,025 for its date is granted. This decision is not appealable.

Henning's Motion II to dissolve as to Hunt on the ground that the Hunt application is not supported by a valid oath and hence will not support any claims is granted. Hunt and his assignee have the right to appeal this decision.

Henning's Motion III to dissolve as to Hunt on the ground that the assignee, Bendix Aviation Corporation is estopped is granted. Hunt and his assignee have the right to appeal this decision.

The limit of appeal is set to expire *twenty-one days* from the date of this decision.

H. G. SOLYOM,
Examiner, Div. 28.

KJA/jmo

156

Document No. 22.

Paper No. 33.

U. S. Patent Office

Board of Appeals

Oct 30 1941

Mailed

Appeal No. 39,925

GD

Hearing:

September 26, 1941

IN THE UNITED STATES PATENT OFFICE

Before the Board of Appeals

HENNING V. HUNT

Patent Interference No. 76,519 between an application of Otto Henning, Serial No. 575,577, filed November 17, 1931; and an application of Scott F. Hunt, Serial No. 727,648, filed May 26, 1934, a continuation-in-part of application Serial No. 575,025, filed November 14, 1931. Carburetor.

Mr. Donald U. Rich and Mr. George R. Ericson for Henning.

Mr. N. D. Parker, Jr. and Mr. A. R. McCrady for Hunt.

This is an appeal by the party Hunt from the decision of the Primary Examiner granting two motions to dissolve the interference filed by the party Henning.

The issue of the Interference is expressed in the counts. Count 1 reads as follows:

1. In a carburetor, means forming a mixing conduit, a choke valve controlling the admission of air to said mixing conduit, said choke valve having a part which is movable toward open position by direct action of suction, suction operated means for opening said choke valve a limited distance only, said suction operated means being constructed and arranged to permit a continuance of the opening of said choke valve after the cessation of movement of said suction operated means, and a heat responsive element connected to said choke valve to control the same in conjunction with said suction operated device.

157 The present interference is between an application of Hunt, Serial No. 727,648, filed May 26, 1934, assigned to the Bendix Aviation Corporation, and an application of Henning, Serial No. 575,577, filed November 17, 1931, assigned to the Carter Carburetor Corporation.

The party Henning filed one motion to dissolve on the ground that Hunt was estopped because of the proceedings in Interference 68,187, 68,188, and 71,471. To this list the Examiner added Intf. 68,702 and granted this motion and the appeal is from this decision of the Examiner.

The prior interferences referred to involved an application of Stanton, Serial No. 600,038, filed January 20, 1933, assigned to the Bendix Co. The party Henning alleges that the Bendix Co., the common assignee of the Stanton application and the present Hunt application failed to move under Rule 109 in said interferences to set up any interference on the subject matter of the present counts between Stanton and Hunt. Henning therefore urges that Hunt is estopped to prosecute the present interference. Neither Henning nor his assignee were involved in these prior interference but he urges that he can take advantage of Hunt's estoppel against Stanton to eliminate Hunt from the present interference. Hunt states the question involved here and the facts pertaining to it as follows in his brief on page 12.

“Neither Henning nor his assignee was party to any of the interferences from which the estoppel against

Hunt is said to have arisen. The situation therefore raises a legal question, new to us, which may be stated thus: Can estoppel, arising out of a given interference, be taken advantage of by a stranger to that interference? The question may be applied to the present state of facts thus:

In a *Chandler v. Stanton, etc.* interference, Bendix Aviation Corporation, the common assignee of the Chandler application and of Hunt application 727,648, fails to bring forward its Hunt application for interference with the Stanton application as to the present counts, which (it is said) read on the disclosure of said Stanton application. Does Bendix' failure to do so estop it and its assignor Hunt from later contesting priority as to the same subject matter with Henning, a stranger to that interference?"

The decision relied upon by the party Henning is *Spatafora v. Zaiger and Yound*, 1934 C. D. 271.

It is our view that the examiner's position in holding estoppel is sound. The party Hunt by the failure of his assignee to take proper action in the prior interference is at the present time not entitled to obtain the claims to the subject matter of the issue here. Hence, the counts are not patentable to Hunt and he should not be permitted to contest an interference involving counts to this subject matter.

The party Hunt urges that the counts will not read on the Stanton application, Serial No. 600,038, and therefore there can be no estoppel. There seems to have been no contention made before the Examiner as to the non-readability of the counts of the Stanton application. No discussion appears in the Henning brief on this point as it was not pressed. We have carefully considered it and we think that when the counts are given their broadest meaning they will read on and dominate the Stanton application.

The party Hunt urges that there is an estoppel against the party Henning that arises out of the proceedings in Interferences Nos. 71,033 and 71,035. The Examiner held

that there is no estoppel against Henning on this ground and the point is not before us for decision. No ruling will be made on it.

The party Henning also filed another motion to dissolve on the ground that the party Hunt has not, on the face of the record, filed a complete allowable application for patent on the subject matter involved. The reasons Henning assigns is that there is no positive allegation made in Hunt's application oath that the invention covered by the counts was not in public use or sale in the United States more than two years prior to the filing of his application. Hunt's oath merely states that he does not know and does not believe that the invention was "patented or described in any printed publication in any country before his invention or discovery thereof, or more than two years prior to November 14, 1931, the date of filing of his parent application No. 575,025 of which the present application is a division, or in public use or sale in the United States for more than two years prior to the filing of said parent application."

It is contended by the party Henning that these allegations are insufficient because the invention covered by the counts is not disclosed in the parent application and
160 therefore Hunt cannot refer to its filing date to satisfy the allegation requirement as to public use or sale. The question therefore primarily is whether the prior parent application discloses the invention of the counts.

Count 1 contains the following limitation:

"suction operated means for opening said choke valve a limited distance only".

Count 2 contains the limitation:

"choke valve comprising a plurality of portions, one of said portions being suction operated, a shaft rigidly fixed to another of said portions, a piston connected to said shaft, a cylinder for said piston communicating with said air passage posterior to said throttle"

Count 3 contains the limitation:

“and means responsive to suction posterior to the throttle for moving the valve to a partially opened position against the force of the temperature responsive means, ...”

We have carefully considered the alleged parent application 575,025, but there is no disclosure in it that suction operated piston 42 will partially open the choke valve 18. The only disclosure given is that the piston operates lever 74 to break the toggle 70, 72 and release the valve so it may be moved by the suction in the manifold or by the thermostat.

Since there is no disclosure of the invention of the counts in the application 575,025, the allegations in the oath referring to its filing date as to public use or sale are insufficient. The party Hunt therefore has no complete and allowable application upon which a patent can be granted. The interference should be dissolved for that reason.

The decision of the examiner granting Henning's motions to dissolve is affirmed.

BOARD OF APPEALS

EUGENE LANDERS,
Examiner-in-Chief.
F. P. EDINBURG,
Examiner-in-Chief.
C. H. SHAFFER,
Examiner-in-Chief.

October 30, 1941.

MR. GEORGE R. ERICSON,
2838 North Spring Avenue,
St. Louis, Missouri.

MR. N. D. PARKER, JR.,
McLachlen Building,
Washington, D. C.

163

Document No. 23.

Div. 28 Room 4628

Letter No. —

May 22 1940

LL

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

EXAMINER OF INTERFERENCES:

An interference is found to exist between the following cases, and in respect to the invention therein specified, to-wit:

CASES.

1. Name Scott F. Hunt

Post-office address 401 North Bendix Drive, South Bend, Indiana.

Title Carburetors

Filed May 26, 1934 Ser. No. 727,648 Pat'd No.

Division or continuation of

Attorney N. D. PARKER, JR., of McLachlen Bldg., Washington, D. C., and Associate Att'y A. R. McCrady, of 401 N. Bendix Drive, South Bend, Ind.

Assignee Bendix Aviation Corporation of South Bend, Ind.

2. Name Irven E. Coffey

Post-office address 7128 Natural Bridge Road, St. Louis, Missouri

Title Carburetors

Filed July 6, 1933 Ser. No. 679,201 Pat'd June 29, 1937 No. 2,085,351

Division or continuation of

Attorney DONALD U. RICH c/o American Car & Foundry Co. of 30 Church St., New York, N. Y.

Associate Att'y GEORGE R. ERICSON of 2834-46 N. Spring Ave., St. Louis, Mo.

Assignee Carter Carburetor Corporation of St. Louis,
Mo.

3. Name

Post-office address

Title

78346

Filed

Ser. No.

Pat'd

No.

Division or continuation of

Attorney

of Intf. Number

Associate Att'y

of Intf. Declared Jun 4 1940

Assignee

of Statements Due Jul 8 1940

INVENTION

164 Count 1. In combination with an internal combustion engine, a carburetor having a choke valve, temperature responsive means yieldingly urging the valve toward closed position at low temperatures, additional means resisting opening movement of the valve, and suction operated means operative to render said additional means inoperative and to move the valve to at least partially opened position against the force of the temperature responsive means, said choke valve being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction.

Count 2. In combination with an internal combustion engine, a carburetor having a throttle and a pressure responsive choke valve, means operative below a predetermined temperature to yieldingly urge the valve toward closed position, additional means resisting opening movement of the valve, and means responsive to a predetermined suction posterior to the throttle for rendering said additional means inoperative and for moving the valve to at least partially opened position against the force of the temperature responsive means, said choke valve being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such

fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction.

The relation of the counts of the interference to the claims of the respective parties is as follows:

Count	Coffey	Hunt
1	39	28
2	40	29

(Counts compared)

H. G. SOLYOM,
Examiner, Div. 28.

GPS/jmo

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Document No. 24.

Div. 28 Room 4628

Paper No. 16

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

Please find below a communication from the Examiner
in this case.

CONWAY P. COE,
Commissioner of Patents.

Copy sent attorney in each case.

Interference No. 78,346

HUNT
v.
COFFEY

Mailed Jun 12 1941

Examiner's Decision on Motions.

This case comes up for consideration of three motions
as follows:

- I. Motion to shift the burden of proof filed by Hunt Dec.
30, 1940.
- II. Motion to dissolve filed by Coffey Nov. 30, 1940.
- III. Motion to dissolve filed by Coffey Dec. 30, 1940.

THE STRUCTURES INVOLVED IN THIS INTERFERENCE

The Hunt Structure: This device is explained in a con-
current decision in Interference 76,519.

The Coffey Structure: The Coffey patent shows an auto-
matic choke valve 30 controlled by thermostat 54 to open
the choke as temperature increases. Piston 45 operating
in arcuate passageway 47 opens the choke when the engine
begins to fire. A magnet 59 is provided which tends to
hold the choke closed. The force of the piston 45 and the

magnet 59 during cranking are such that a fluttering action of the choke results. When firing occurs, the suction is strong enough to break armature 61 completely away from magnet 59. A diaphragm 14 and spring 19 are provided which hold the throttle open during cranking. When firing commences, diaphragm 14 permits throttle 5 to close. When choke 30 is closed, lugs 14 and 41 are in contact and prevent complete closing of the throttle. Manually opening the throttle lifts link 26 and moves lug 41 out of the way of lug 40.

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DECISION ON MOTION I

The party Hunt has moved to shift the burden of proof in view of the Hunt and Olson application Ser. No. 575,025. The Hunt and Olson application does not have the same disclosure as the present Hunt application Ser. No. 727,648. Hunt, therefore, cannot be given the benefit of the date of the Hunt and Olson application. This motion must therefore be denied. A full discussion of the reasons why Hunt cannot rely on the Hunt-Olson application and why the burden of proof must be on Hunt is found in a concurrent decision on motions in interference 76,519 and such reasons are hereby incorporated in the present decision. See "Decision on Motion I" in interference 76,519.

DECISION ON MOTION II

Coffey has moved to dissolve as to Hunt on the ground of estoppel. The alleged estoppel is said to arise out of the fact that in interference 74,876 Hunt copied the present counts from Henning whereas they had actually been requested to be cancelled by Henning and were taken out in the Coffey patent. Coffey alleges that these facts were brought to Hunt's attention and that he failed to move under Rule 109 for interference with Coffey. Attention is called to the fact that Coffey's motion is obviously in error in stating that "these counts had been cancelled from the Hunt application". In this quoted portion "Hunt" should be *Henning* and has been so considered by the parties and

the examiner. It is not seen that Hunt is estopped by any failure to ask specifically for interference with Coffey. Hunt actually did make the claims. Coffey states that in interference 74,876 the examiner states in his decision of Oct. 15, 1938 that Hunt had erroneously asked for interference with Henning and that these claims had been issued in the Coffey patent. The examiner should have set up the interference immediately between Hunt and the Coffey patent. Hunt was under no duty to point out the examiner's duty to him. Hunt had made the claims and the record showed who was the proper party to contest an interference with Hunt on these claims. Coffey knew just as well as Hunt that each had these claims and that an interference was necessary. There is no more estoppel against Hunt for not asking for interference with Coffey than there is against Coffey for not asking for interference with Hunt. The motion to dissolve is denied.

DECISION ON MOTION III

Coffey has moved to dissolve as to Hunt on four grounds as follows:

1. That Hunt is estopped in view of certain previous interferences.
2. That Hunt cannot make the claims.
3. That Hunt's application is defective.
4. That the counts are not patentable to Hunt because of publication more than two years prior to filing.

1. Coffey alleges that Hunt is estopped in view of proceedings in interferences 68,187, 68,188 and 71,471. Coffey's brief mentions a further interference No. 68,702. Since Hunt has not objected, all will be considered. In these previous interferences Stanton 600,038 was senior to Hunt's assignee, Bendix Aviation Corporation and the assignee failed to move under Rule 109 for interference with Stanton on the present subject matter. The present counts obviously read on and would cominate Stanton. Bendix is

therefore now estopped to contest this matter with Stanton or anyone else. For full discussion of this point reference is made to concurrent decisions on motions in interferences 74,876 and 76,519. The motion to dissolve must therefore be granted on this ground.

2. Coffey alleges that Hunt cannot make the counts since the Hunt structure will not support these counts. Both counts call for "additional means resisting opening movement of the valve and suction operated means (a) to render said additional means inoperative and (b) to move the valve to at least partially open position". If Hunt's toggle 168 members 70, 71, 72 are rendered inoperative, his piston 42 could not open the choke valve. Thus, clause (a) does not read on Hunt. Clause (b) requires the valve to be actually moved toward open position. This is not satisfied by a structure which merely unlocks the valve which is all that Hunt's specification calls for. The specific action further states that pin 71 moves "to the right well beyond its dead center position, leaving shaft 56 free to rotate". If cam 50 rotates shaft 56 it cannot be said that it *leaves* the shaft free to rotate. The specification also states that the choke valve open due to difference in pressure on its opposite faces. This is inconsistent with any contention that the opening is caused by piston 42. If piston 42 opens the choke against the force of the thermostat there cannot be any "force between the opening force of the air stream and the closing force of the thermostat" as stated in Hunt's description. For a full discussion of reasons why Hunt's operation is different from that required by the counts reference is made to the "Decision on Motion I" in a concurrent decision on motions in interference 76,519. The motion to dissolve must therefore be granted on this ground.

3. Coffey alleges that Hunt's application is not capable of being allowed as a patent. This point is discussed fully in the concurrent decision mentioned above. See "Decision

on Motion II'' of the concurrent decision. The motion of Coffey to dissolve is accordingly granted on this ground.

4. Coffey has alleged that Hunt published his invention in the Automotive Industries of Jan. 20, 1932, which was more than two years before Hunt filed. Since Hunt cannot benefit by the date of the Hunt and Olson application, for reasons pointed out in the decision in interference 76,519, this ground would be good if the publication occurred as alleged. However, Coffey has failed to make out a
169 case since there is no Automotive Industries for the date given. The motion of Coffey to dissolve is accordingly denied on this ground.

CONCLUSION

- I. Hunt's motion to shift the burden of proof is denied.
- II. Coffey's motion of Nov. 30, 1940 to dissolve as to Hunt is denied.
- III. Coffey's motion of Dec. 30, 1940 to dissolve as to Hunt is granted as to grounds 1, 2 and 3 and denied as to ground 4.

H. G. SOLYOM,
Examiner, Div. 28.

KJA/jmo

*United States Court of Appeals
for the District of Columbia*

FILED AUG 21 1947

Joseph W. Stewart
CLERK

BRIEF FOR APPELLANT

United States Court of Appeals

DISTRICT OF COLUMBIA

CLARENCE C. KINGSLAND ^{APPEAL No. 9574}

CASPER W. OOMS, COMMISSIONER OF PATENTS, APPELLANT

v.

CARTER CARBURETOR CORPORATION, APPELLEE

APPEAL FROM THE JUDGMENT OF THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE COMMISSIONER OF PATENTS

W. W. COCHRAN,
*Solicitor, United States Patent Office,
Attorney for Appellant.*

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Of Counsel.

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United States Court of Appeals

DISTRICT OF COLUMBIA

APPEAL No. 9574

CASPER W. OOMS, COMMISSIONER OF PATENTS, APPELLANT

v.

CARTER CARBURETOR CORPORATION, APPELLEE

*APPEAL FROM THE JUDGMENT OF THE DISTRICT COURT OF THE
UNITED STATES FOR THE DISTRICT OF COLUMBIA*

BRIEF FOR THE COMMISSIONER OF PATENTS

JURISDICTIONAL STATEMENT

This case involves an appeal from the judgment of the United States District Court for the District of Columbia (25)¹ directing the defendant, Commissioner of Patents, to vacate a decision rendered by him on a petition in an interference proceeding and to instruct the examiner of interferences to proceed as if such decision had not been rendered. The action below was instituted by a complaint (1) seeking relief in the nature of a mandatory injunction, on the ground that the Commissioner of Patents was without jurisdiction to entertain the petition.

STATEMENT OF THE CASE

The appellee is the owner of the patent to Coffey, No. 2,085,351, granted June 29, 1937, on an application filed July 6, 1933. This patent is now involved in interference No. 82,262 with an application of Hunt No. 727,648, filed May 26, 1934. Hunt was also one of the joint applicants in an earlier application No.

¹ The numbers in parentheses refer to pages of the appendix

575,025, filed by him and Olson on November 14, 1931. In Civil Action No. 20,023, brought under R. S. 4915, U. S. C., title 35, sec. 63, which action involved the later Hunt application No. 727,648, the United States District Court for the District of Columbia held as conclusions of law (see present finding of fact No. 6) that the Hunt and Olson application completely disclosed the subject matter of claims 22, 27, 28, and 29, and that Hunt was entitled to the filing date of the joint application for a constructive reduction to practice of the subject matter of those claims. The claims in question include all the claims involved in interferences Nos. 82,262, 82,554, and 82,555. This holding, as stated in the decision of the Commissioner of Patents (35) was necessary to support the conclusion reached by the Court in Civil Action No. 20,023, that Hunt was entitled to a patent.

It will be noted that the Coffey application was filed before Hunt application No. 727,648, but after the joint Hunt and Olson application No. 575,025, to the filing date of which the Court had found the sole Hunt application to be entitled. The effect of the Court's decision in Civil Action No. 20,023 is that as between Hunt and Coffey, Hunt was the first to file in the Patent Office an application disclosing the subject matter in question.

When interference No. 82,262 was declared, the primary examiner, either overlooking or ignoring the decision of the Court in Civil Action No. 20,023, failed to give Hunt the benefit of the earlier joint filing date. Hunt therefore was erroneously made the junior party. Hunt moved to shift the burden of proof, relying on the earlier joint application and the holding of the Court with respect thereto. The examiner of interferences refused to set this motion for hearing before the primary examiner, for determination on its merits, and Hunt petitioned from this ruling to the Commissioner.

Hunt's petition was considered by an Assistant Commissioner, who found that the primary examiner had improperly disregarded the decision of the Court in Civil Action No. 20,023. The Assistant Commissioner therefore held (35) that Hunt "should be made the senior party, without consideration of his

motion to shift the burden of proof." It is this ruling which the lower court has now directed the Commissioner to vacate.

Interferences Nos. 82,554 and 82,555 involve the same general issue as does No. 82,262. In the former cases, however, the examiner of interferences acted after the decision of the Assistant Commissioner in No. 82,262, and, on the basis of that decision, he made Hunt the senior party. Each of interferences Nos. 82,554 and 82,555 involves a patent having an effective filing date between that of the Hunt and Olson joint application and that of the Hunt sole application.

STATUTES INVOLVED

Sec. 476 R. S. (U. S. C., title 35, sec. 2).—There shall be in the Patent Office a Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners in chief, who shall be appointed by the President; by and with the advice and consent of the Senate. The first assistant commissioner and the assistant commissioners shall perform such duties pertaining to the office of commissioner as may be assigned to them, respectively, from time to time by the Commissioner of Patents. All other officers, clerks, and employees authorized by law for the office shall be appointed by the Secretary of Commerce upon the nomination of the Commissioner of Patents, in accordance with existing law.

Sec. 481 R. S. (U. S. C., title 35, sec. 6).—The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

Sec. 483 R. S. (U. S. C., title 35, sec. 6).—The Commissioner of Patents, subject to the approval of the Secretary of Commerce, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Sec. 4904 R. S. (U. S. C., title 35, sec. 52).—Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or

with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.

PATENT OFFICE RULES INVOLVED

Rule 116.—The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject matter of his application shall not be deprived of any claim to such subject matter solely on the ground that such claim was not added to the interference by amendment under rule 109.

Rule 122.—Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the grounds relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time speci-

fied and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.

Rule 124.—No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable.

Rule 135.—Upon the filing of the appeal the same shall be submitted to the primary examiner, who, if he find it to be regular in form, and to relate to an appealable action, shall within ten days from the filing thereof furnish the boards of appeals with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto, giving a concise explanation of the invention claimed and of the subject matter of the references so far as pertinent to the appealed claims. The examiner shall at the time of making such statement furnish a copy of the same to the appellant. If the primary examiner shall decide that the appeal is not regular in form or does not relate to an appealable action, a petition from such decision may be taken directly to the Commissioner, as provided in rule 142.

Rule 153.—In contested cases reasonable notice of all motions, and copies of motion papers and affidavits, must be served as provided in rule 154 (b). Proof of such service must be made before the motion will be entertained by the office. A statement of the attorney or agent attached to or appearing on the original papers when filed clearly stating the time and manner in which service was made will be accepted as *prima facie* proof of service. Motions will not be set for hearing unless certified to by the applicant or an attorney or agent of record that the motion is not interposed for purpose of delay

and that it is believed to be well founded in law and fact. Motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending. In original hearings on motions the moving parties shall have the right to make the opening and closing arguments. In contested cases the practice on points to which the rules are not applicable shall conform as nearly as possible to that of the United States courts in equity proceedings.

Rule 199.—All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

STATEMENT OF POINTS

1. The Trial Court erred in holding that the Commissioner assumed jurisdiction conferred on either the primary examiner or the examiner of interferences.

2. The Court erred in holding that Hunt's petition seeking a review by the Commissioner of the ruling of the examiner of interferences dismissing Hunt's motion to shift the burden of proof was not addressed to the supervisory authority of the Commissioner.

3. The Court erred in holding that the Commissioner's order of July 9, 1946, was not in exercise of supervisory authority.

4. The Court erred in holding that the said order of the Commissioner was in violation of any rule or statute.

5. The Court erred in holding that the supervisory authority of the Commissioner does not extend to any matter in which one of his subordinates is directed by rule or statute to act judicially or quasi judicially.

6. The Court erred in holding that Hunt's petition was in fact and substance an appeal to the Commissioner.

7. The Court erred in holding that the Commissioner reversed the decision of the examiner of interferences dismissing Hunt's motion to shift the burden of proof in interference No. 82,262.

8. The Court erred in holding that the Commissioner was without authority to take the action set forth in his order of July 19, 1946.

9. The Court erred in holding that the said order was invalid.

10. The Court erred in holding that the plaintiff was entitled to any relief whatever.

SUMMARY OF ARGUMENT

It is the position of the appellant that the Commissioner of Patents, who is charged by statute (R. S. 481) with performing or superintending "all duties respecting the granting and issuing of patents directed by law" has both the right and the duty to direct any subordinate official of the Patent Office to perform his duties in accordance with the law; and that if the Commissioner finds that such an official has failed to perform a ministerial duty, he may properly direct that it be performed.

In the present case, since the Court had held Hunt to be entitled to a date prior to that of Coffey, and since such decision, at least in the absence of new evidence, was binding on the Patent Office, it was the ministerial duty of the primary examiner and the examiner of interferences to make Hunt the senior party in the interferences here involved. Obviously, there must be some method of securing the performance of this duty. If, as has been held in the present case, this cannot be done by the Commissioner, then it must be done by the courts on application for mandatory injunction. It is not believed to have been the intention of Congress to intrust the supervision of minor officials of the Patent Office to the courts, in the first instance rather than to the head of the office.

The provision of Patent Office Rule 124 that there shall be no appeal from a decision rendered on a motion to shift the burden of proof has no bearing in this case, first because there has been no decision rendered on Hunt's motion to shift the burden of proof, but merely a refusal to consider the motion on its merits and secondly because the Commissioner has not entertained an appeal, but has exercised his supervisory authority, which is conferred by statute and is independent of any right of appeal.

ARGUMENT

The primary examiner and examiner of interferences in setting up and declaring the interferences here involved, failed to perform a ministerial duty

The present controversy arises from the fixing of the burden of proof in interference proceedings. This burden is determined by Patent Office Rule 116 which provides that:

The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing the same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

In Civil Action No. 20,023, as above noted, the United States District Court for the District of Columbia held, as conclusions of law, that the subject matter of all the claims which are involved in the interferences here in controversy (claims 22, 27, 28, and 29 of the Hunt application) is completely disclosed in the Hunt and Olson joint application, filed November 14, 1931, and that Hunt is entitled to the said joint filing date for constructive reduction to practice of that subject matter. Since the joint application was filed prior to any of the applications owned by the appellee and involved in the interferences hereunder consideration it is evident, in view of Patent Office Rule 116, that the Patent Office tribunals, if they accepted the conclusions of the Court, were bound to make Hunt the senior party in each of these interferences.

It is thought to be too clear to require argument that the Patent Office is bound to accept the conclusions of the courts in actions under R. S. 4915, at least in the absence of evidence which was not before the courts. If this were not the case, an action under that statute would be an idle ceremony. A holding to this effect is found in *Hoover v. Coe*, 325 U. S. 79, in which the Court said, with reference to equity actions under R. S. 4915 and appeals to the United States Court of Customs and Patent Appeals, that Congress "has made the effect of adjudication in equity the same as that of decision on appeal." The effect of decision on appeal (R. S. 4914, U. S. C., title 35, sec.

62) is that it "shall be entered of record in the Patent Office and shall govern the further proceedings in the case."

It follows that the holding of the Court in Civil Action No. 20,023 that Hunt was entitled to a date earlier than that of Coffey, made it mandatory, under Patent Office Rule 116, that Hunt should be made the senior party in the interferences. The primary examiner and examiner of interferences had no discretion and, regardless of their personal opinions, it was their ministerial duty to make Hunt the senior party. The only real issue here, therefore, is whether the Commissioner of Patents had authority to require the performance of this duty or whether the only remedy was by petition to the United States District Court for the District of Columbia for a mandatory injunction. These are the only possible remedies, since no appeal is provided from the action of the examiner of interferences in setting or refusing to set a motion to shift the burden of proof, or from the decision of the primary examiner on such a motion.

NATURE AND SCOPE OF SUPERVISORY AUTHORITY

The supervisory authority of the Commissioner is derived directly from the statutes. R. S. 481 (U. S. C., title 35, sec. 6) provides that "The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law." The conduct of interference proceedings in the Patent Office is a duty of this character (R. S. 4904, U. S. C., title 35, sec. 52), and it is therefore the clear meaning of these statutes that the Commissioner shall superintend all duties performed in interferences, except those which he performs himself. To interpret these statutes otherwise is to disregard their express language.

The Trial Court was apparently of the opinion that certain Patent Office rules limit the supervisory authority of the Commissioner so that he cannot act in certain situations. This overlooks the provision of R. S. 483 (U. S. C., title 35, sec. 6) that the rule-making authority of the Commissioner shall be limited to the establishing of regulations "not inconsistent with law." Since the statutes specifically direct that the Com-

missioner "shall superintend or perform all duties respecting the granting and issuing of patents directed by law," it is clear that any rule which expressly undertook to remove certain of these duties entirely from performance or superintendence by the Commissioner would be inconsistent with law and therefore invalid. It is equally clear that rules which do not *expressly* undertake to do this cannot properly be *construed* as limiting the supervisory authority, since such construction would make them invalid.

It is accordingly submitted that the holding of the Trial Court to the effect that there are certain duties to be performed in interference which cannot be supervised by the Commissioner is in direct conflict with the express provisions of the statutes; and that if the rules relied on by the Court in support of its holdings were properly construed by the Court, then they are invalid and without effect. However, as will now be pointed out, it is thought that the rules, if properly interpreted, have no such limiting effect as was found by the Court.

SUPERVISORY AUTHORITY EXTENDS TO QUASI JUDICIAL ACTS

The Trial Court based its decision largely on the proposition stated in its twelfth conclusion of law (24), namely, that if a subordinate is directed by statute or rule to act judicially or quasi judicially, the head of his department can have no supervision over such acts. This proposition, if construed to apply to the Commissioner of Patents, is contrary to the statutes, the rules of the Patent Office, the decisions of this Court and the United States District Court for the District of Columbia, and the uniform practice of the Patent Office for more than fifty years.

The statutory basis for the supervisory authority of the Commissioner has already been discussed. The statutes make no distinction whatever in this respect between duties which are judicial or quasi judicial, and those which are not. As a matter of fact, by far the greater part of the work of the patent and trade-mark examiners, and the examiners of interferences is quasi judicial in nature. To hold that the Commissioner is without authority to supervise this work would restrict his authority to a relatively minor part of the duties of his Office.

Patent Office Rule 124, relating to interferences, provides that "appeals may be taken directly to the Commissioner from decisions on such other motions, as, in his judgment, should be appealable." Rule 135, relating to ex parte appeals, provides that "If the primary examiner shall decide that the appeal is not regular in form or does not relate to an appealable action, a petition from such decision may be taken directly to the Commissioner as provided in Rule 142." These rules clearly provide for supervision by the Commissioner of quasi judicial rulings of subordinates on matters which are expressly assigned to them by rules. If the Trial Court's twelfth conclusion of law is correct and applies to the Commissioner, these rules are invalid.

This Court and the United States District Court for the District of Columbia have repeatedly upheld the right of the Commissioner to review, in the exercise of his supervisory authority, quasi judicial rulings of lower Patent Office tribunals. Thus in *Wigton v. Coe*, 62 App. D. C. 367, 68 F. (2d) 414, the examiner of interferences who, at that time was charged under R. S. 4904 with the duty of determining priority in interference proceedings, had entered an award of priority adverse to Wigton. Upon motion by Wigton, the examiner of interferences vacated his decision and prepared to consider the case further. Thereupon, as stated in the Court's decision, "The Commissioner exercised jurisdiction and reversed the decision of the examiner of interferences. On May 9, 1932, the examiner of interferences reinstated the decision against Wigton." This was clearly an action by the Commissioner on a matter in which the examiner of interferences had acted quasi judicially under the statute, and the Commissioner's decision had the effect of instructing the examiner of interference as to the decision on priority. This was done despite the fact that the statutes did not allow an *appeal* to the Commissioner from an award of priority. Both this Court and the Court below found that the Commissioner had acted within his supervisory authority. It seems evident that everything which could be said in support of the Trial Court's decision in the present case could also have been said on behalf of Wigton; and that the

decision here on appeal is in principle squarely in conflict with that in the Wigton case.

In *U. S. ex rel. Searl v. Robertson*, 57 App. D. C. 179, 18 F. (2d) 829, Searl moved for leave to take additional testimony. This motion, in accordance with Rule 153 was determinable by the examiner of interferences, and such determination was clearly of a quasi judicial nature. Nevertheless, as this Court stated, "The Commissioner, in the exercise of his discretion, directed the lower tribunals to admit this testimony," and his right to do so was upheld by this Court and by the Court below.

In *U. S. ex rel. Johnson v. Ewing*, 1918 C. D. 93, the Supreme Court of the District of Columbia sustained the Commissioner's action in setting aside awards of priority by the examiner of interferences and examiners in chief, and directing that an interference be dissolved.

In *Geophysical Development Corp. et al. v. Coe*, 78 U. S. App. D. C. 39, 136 F. (2d) 275, this Court and the lower court sustained a ruling in which the Commissioner determined the question of setting a motion to dissolve for hearing, although the setting of such motions is assigned by Rule 122 to the examiner of interferences.

In *U. S. ex rel. Dwiggins v. Ewing*, 43 App. D. C. 204, this Court and the lower court, upheld an action of the Commissioner which vacated an award of priority by the examiner of interferences, directed that any attempted appeal from the award should be dismissed and directed the examiner to reject the claims. In this case the Commissioner exercised authority over quasi judicial matters committed by rule to both the primary examiner and the examiner of interferences.

In *Moore et al. v. U. S. ex rel. Chott*, 40 App. D. C. 591, the right of the Commissioner to direct a rejection of claims which had been allowed by the examiners in chief was upheld. The allowance of the claims was, of course, a quasi judicial action by the examiners in chief.

In *Podelsak et al. v. McInnerney*, 26 App. D. C. 399, this court held that a decision by the primary examiner that a party has a right to make a claim which, of course, is a quasi judicial ruling and ancillary to priority "is final unless for good cause

shown the Commissioner, under his supervisory powers, takes jurisdiction to review the question."

In *U. S. ex rel. American Gas-Accumulator Co. v. Coe*, 66 App. D. C. 21, 84 F. (2d) 398, this Court said:

The Commissioner of Patents, in considering an application for a patent, is vested with authority to determine whether or not an interference shall be instituted *and to pass upon the proceedings in interferences.* [Italics added.]

and in *Svenson v. Coe*, 69 App. D. C. 359, 101 F. (2d) 684, it was said, with respect to the Commissioner of Patents:

This court has repeatedly refused to regulate his conduct of interference proceedings.

The settled practice of the Commissioner in reviewing, on petition, the quasi judicial rulings of lower tribunals in matters which are assigned to them by rule or statute is indicated by the foregoing decisions and by the following Commissioner's decisions: *Townsend v. Corey*, 1905 C. D. 548; *ex parte Knudsen*, 1895 C. D. 29; *ex parte Pledger*, 1910 C. D. 124; *Raulet et al. v. Adams*, 1905 C. D. 55; *ex parte Cady*, 1916 C. D. 57; *ex parte Hackett et al.*, 1921 C. D. 63; *ex parte Mattlet*, 1926 C. D. 62.

This practice is well stated in Patent Office Practice, by Archie McCrady, Second Edition published in 1946 by Pacot Publications, Madison, Wisconsin, as follows:

(Page 247): As has already been indicated at sec. 126, applicants have the right to petition the Commissioner concerning any matters upon which they seek relief, except cases wherein the rules provide a remedy by appeal or otherwise.

(Page (250): In directing the quasi judicial activities of the Office the Commissioner exercises what is called "supervisory authority." This authority may be invoked by petition or may be exercised of the Commissioner's own motion.

The fact that a practice has been continued by the Patent Office, without successful challenge, over a long period of time,

affords persuasive evidence that it is correct (*Geophysical Development Corp. v. Coe, supra*; *Allen v. U. S. ex rel Lowry*, 26 App. D. C. 8).

The case of *Butterworth v. U. S. ex rel. Hoe*, 112 U. S. 50, which was relied on by the Trial Court in support of its twelfth conclusion of law relates to the right of the Secretary of the Interior to review a decision of the Commissioner of Patents. This case is not in point as to the supervisory authority of the Commissioner. The statute involved in the Hoe case merely stated that the Commissioner was to act under the direction of the Secretary and did not charge the latter with superintending all duties of the Commissioner. Further, the Court in its decision relied heavily on the fact that the statutes provide for review of the Commissioner's actions by the courts. No such provision is made by statute for court review of decisions by the primary examiner or examiner of interferences on interlocutory or formal matters such as the fixing of the burden of proof in interferences.

In view of the foregoing it is submitted to be clear that the decision of the Trial Court cannot be sustained on the basis of any such broad proposition as is set forth in its twelfth conclusion of law. It remains to be considered whether there is any special reason which deprives the Commissioner of supervisory authority in the present case.

**THIS CASE DOES NOT INVOLVE A DECISION ON A
MOTION UNDER RULE 122**

In conclusions of law Nos. 11 and 13 the Trial Court apparently holds that the Commissioner in the present case has entertained an appeal from a decision on a motion under Rule 122, and that this is in violation of Rule 124. It is submitted, however, that no decision on a motion under Rule 122, within the meaning of Rule 124 has been rendered here. Rule 122 provides that motions to shift the burden of proof "if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner." It seems clear from this language that it is the determination by the primary examiner which is to be regarded as the decision

on the motion, and not the preliminary formal ruling by the examiner of interferences. This interpretation is also supported by the last sentence of Rule 122, which provides that "The matter raised on a motion to shift may be reviewed at final hearing." Obviously, the ruling of the examiner of interferences as to the form of the motion could not be reviewed at final hearing, after the motion had been decided by the primary examiner. The reference to the "matter raised" on the motion, therefore, relates to merits rather than form, and the same is thought to be true of the "decision rendered" on such a motion, referred to in Rule 124. In fact, it is evidently because the matter may be reviewed at final hearing that an interlocutory appeal is excluded. Clearly, therefore, Rule 124 has no application to the formal ruling of the examiner of interferences which, if it cannot be reviewed at the interlocutory stage, is not reviewable.

A close analogy to the present situation is provided by Rule 135, relating to appeals from the primary examiner to the Board of Appeals. This rule provides that if the primary examiner finds the appeal "to be regular in form" he shall answer it, but if he decides that the appeal is not regular in form a petition may be taken to the Commissioner. The distinction between merits and form, and the fact that the latter question is reviewable on petition rather than appeal are thus clearly indicated. By analogy, the formal ruling of the examiner of interferences on a motion to shift the burden of proof should also be petitionable.

It should also be noted that the Commissioner did not modify the action of the examiner of interferences so far as the setting for hearing of the motion to shift the burden of proof was concerned, but agreed with him that this motion should not be set for hearing. What the Commissioner did modify was the fixing of the burden of proof, but this had not been affected by the action taken by the examiner of interferences on the motion. Under these circumstances, it seems evident that the Commissioner has not entertained an appeal from any decision by anyone on a motion to shift the burden of proof, and that Rule 124 is therefore inapplicable.

PETITIONS AND APPEALS DISTINGUISHED

The Trial Court, in its conclusions of law, appears to overlook the fact that there is a clear distinction between appellate jurisdiction and supervisory authority. The supervisory authority of the Commissioner is similar to that of the courts in issuing mandatory injunctions; it should be exercised only in clear cases, but it extends to all activities connected with the issuance of patents, and includes the right to insure the performance by any subordinate of any clear or ministerial duty.

The distinction between appellate jurisdiction and supervisory action is well stated in *Goss v. Scott*, 1901 C. D. 80, which is the first case relied on by the Trial Court in support of its eleventh conclusion of law. This decision, after pointing out that merely calling an appeal a petition gives it no different status, continues as follows:

Instances may arise and have arisen in the prosecution of cases (*Bender v. Hoffmann*, C. D. 1898, 262, 85 O. G. 1737) which make it incumbent upon the Commissioner on his own motion to exercise his authority as the head of the Patent Office and to review the decision of the lower tribunals whenever he thinks equity and good practice require it. As stated by Mr. Commissioner Duell in *Bender v. Hoffmann*, supra, Rule 124 "does not prevent the Commissioner from considering any reason for dissolving the (an) interference which might be brought to his attention or which he himself discovers." The authority of the Commissioner of Patents to exercise his discretionary power at such a time is well established (*Bender v. Hoffmann*, supra; *Hull v. Commissioner of Patents*, 7 O. G. 559; *Drawbaugh v. Commissioner of Patents*, C. D. 1896, 527, 77 O. G. 313).

It will thus be seen that the first decision relied on by the Trial Court in support of its conclusion that the lack of a right of appeal precludes the exercise of supervisory authority, actually stands for the exact opposite of this proposition. Further, this decision clearly indicates that Rule 124, which is the very rule mainly relied on by the Trial Court, does not prevent the Com-

missioner from exercising supervisory authority over matters involved in motions under Rule 122 (motions to dissolve).

The second case cited by the Trial Court, *Manny v. Easley et al.*, 1889 C. D. 179, merely held that the Commissioner would not entertain a petition which was, in effect, an appeal. The case clearly does not hold that the Commissioner, under his supervisory authority, could not have granted the relief sought by the petition if he had felt that the petitioner was clearly entitled to it.

The third and last case relied on by the Trial Court in support of its eleventh conclusion of law is *Waite v. Macy*, 246 U. S. 606. This is not a patent case and has no bearing on the authority of the Commissioner of Patents.

The fact that the Commissioner's supervisory authority is in no way dependent on his right to entertain appeals has been clearly recognized by this Court. This exact issue was raised in *Wigton v. Coe*, 62 App. D. C. 367, *supra*, in which the appellant contended that the Act of March 2, 1927, which abolished the statutory appeal to the Commissioner in ex parte and interference cases, also deprived him of his supervisory authority. The Court, however, held that since the 1927 Act, "contained no provision depriving the Commissioner of the supervisory authority theretofore exercised by him" it was the duty of the Commissioner to decide whether the other provisions of the act inferentially affected such authority, and that his decision that they did not affect it would not be disturbed by the Court.

The Trial Court, as indicated by its tenth conclusion of law, appears to have been influenced by the argument that if the examiner of interferences had set Hunt's motion to shift the burden of proof in interference No. 82,262 for hearing and if the primary examiner had denied it, then the Commissioner's action would have had the same result that might have been attained by an appeal. It is submitted that the case should be decided on the facts as they are, rather than as they might have been. However, the fact that supervisory action may produce the same result as the entertaining of an appeal where no appeal is provided for is not a bar to supervisory action. This is clear from many of the decisions of this Court which

have already been cited. Thus in *Wigton v. Coe*, the Commissioner directed the entry of an award of priority by the examiner of interferences although he had no appellate jurisdiction over such awards. In *U. S. ex rel. Dwiggins v. Ewing*, the Commissioner directed a rejection of claims which the primary examiner, in the exercise of his discretion under the rules and statutes, had allowed. The Commissioner took this action despite the fact that no appeal was provided for from a decision holding claims allowable. In *Moore et al. v. U. S. ex rel. Chott*, the Commissioner directed a rejection of claims allowed by the examiners in chief in their quasi judicial capacity, although no appeal to the Commissioner from an allowance of claims by the examiners in chief was provided for. All these actions of the Commissioner were sustained by this Court. Similarly, in *Podelsak et al. v. McInnerney*, 26 App. D. C. 399, *supra*, this Court stated that "In an ex parte case the decision of the Primary Examiner that a party has a right to make a claim is final unless for good cause shown the Commissioner, under his supervisory powers, takes jurisdiction to review the question." This statement clearly recognizes the right of the Commissioner to act in his supervisory capacity where no appeal is provided, even though the effect of such action is equivalent to that of entertaining an appeal.

**THE COMMISSIONER MAY EXERCISE HIS SUPERVISORY
AUTHORITY ON HIS OWN INITIATIVE**

Irrespective of any petition or of any technicalities in procedure, the Commissioner may act under his supervisory authority to correct any clear mistake on the part of any of his subordinates which he may discover himself or which may be called to his attention. Statements to this effect from McCrady's Patent Office Practice and from *Goss v. Scott*, 1901 C. D. 80, have already been quoted. Similarly, in *Moore v. U. S. ex rel. Chott*, 40 App. D. C. 591, *supra*, the Commissioner evidently acted on his own initiative in setting aside the decision of the examiners in chief, and his action was upheld by this Court. A further decision by the Commissioner of Patents on this point, which also involves the very rules under consideration here (122 and 124) is *Bender v. Hoffman*, 1898 C. D.

262. The following quotation from that decision is in point here:

Considering now that part of Rule 124 quoted above ["from a decision of the Primary Examiner affirming the patentability of the claim or the applicant's right to make the same no appeal can be taken"] I construe this merely to prevent an appeal being taken to the Examiners in Chief by a party to the interference when the Primary Examiner has favorably passed upon the patentability of his opponent's claim or the right to make the claim, and it does not prevent the Commissioner from considering any reason for dissolving the interference which might be brought to his attention or which he himself discovers.

This broad right of the Commissioner to act on his own initiative is also clearly stated in the following decisions of this Court:

(From *Sobey v. Holsclaw*, 28 App. D. C. 65):

The Primary Examiners, who are given statutory authority to decide questions of patentability are under the supervision of the Commissioner and it would seem to be not only his right but his duty to correct any manifest error committed by any of the Primary Examiners relative to the patentability of a supposed invention, or of the right of an applicant to claim it whenever such error was called to his attention.

(From *Drawbaugh v. Seymour*, *Commissioner of Patents*, 9 App. D. C. 219):

It is the duty of the Commissioner of Patents, representing the public, and also the private rights of the inventor involved in the pending application, as well as all other inventors having the sanction of the Patent Office, to see that entire justice be done to all concerned. The law has provided certain official agencies to aid and advance the work of the Patent Office, such as the Primary Examiners, the Examiners of Interferences, and the Examiners in Chief; but they are all subordinate and subject to official direction of the Com-

missioner of Patents, except in the free exercise of their judgments in the matters submitted for their examination and determination. The Commissioner is the head of the Bureau, and he is responsible for the general issue of that Bureau. If, therefore, there may be any substantial, reasonable ground, within the knowledge or cognizance of the Commissioner, why the patent should not issue, whether the specific objection be raised and acted upon by the Examiners or not, it is his duty to refuse the patent.

In the present case, the Commissioner, as he expressly stated in his decision of August 14, 1946, acted under his supervisory authority, to correct an obvious error of his subordinates. While the situation was brought to his attention by a petition, he did not grant the relief sought by the petition, which was to direct that Hunt's motion to shift the burden of proof be set for hearing, nor did he reverse the action of the examiner of interferences, who had held that the motion should not be set for hearing. The fundamental question presented, therefore, is simply whether, when the Commissioner, by whatever means, has discovered what he considers a plain failure of a subordinate to comply with the Rules or statutes, he may act to insure compliance. For the reasons given, it is submitted, both on principle and authority, that it is the right of the Commissioner to act in such a situation and that, if he failed to do so, he would be derelict in his statutory duty to "superintend or perform all duties respecting the granting and issuing of patents directed by law."

PRINCIPLES GOVERNING MANDATORY RELIEF

It is evident that the action taken by the Commissioner in the present case required him to interpret the statutes and rules in order to determine the nature and scope of his supervisory power. The following statement by this Court in *Hammond v. Hull*, 76 U. S. App. D. C. 301, 131 F. (2d) 23, is therefore directly in point:

When the performance of official duty requires an interpretation of the law which governs that perform-

ance, the interpretation placed by the officer upon the law will not be interfered with, certainly, unless it is clearly wrong and the official action arbitrary and capricious.

In *Wigton v. Coe, supra*, this Court applied the above principle to the exact matter here in issue; namely, the interpretation by the Commissioner of the nature and scope of his supervisory authority. In that case the Court said:

When, therefore, that authority was invoked the Commissioner was called upon to decide whether the act of 1927 deprived him of his supervisory authority. As was said in *Riverside Oil Company v. Hitchcock*, 190 U. S. 316, 324, "whether he decided right or wrong is not the question. Having jurisdiction to decide at all he had necessarily jurisdiction, and it was his duty to decide as he thought the law was, and the courts have no power whatever under those circumstances, to review his determination by mandamus or injunction. The writ of mandamus can never be used as a substitute for a writ of error."

These pronouncements have particular force here since the Trial Court's decision rests largely on the interpretation of Patent Office Rules which were promulgated by the Commissioner and which the Commissioner should, therefore, be peculiarly qualified to interpret.

In the present case, the Trial Court, in support of its holding that the Commissioner had acted beyond the scope of his supervisory authority, found it necessary to include twelve findings of fact and seventeen conclusions of law, occupying a total of thirteen typewritten pages, together with an extensive citation of authorities. This, it is thought affords a clear indication of the argumentative nature of the Court's position, and of the fact that the situation presents no clear abuse of authority by the Commissioner, but merely a difference in interpretation of the applicable statutes and rules. If the Com-

missioner acted arbitrarily or capriciously it should not have required so extensive a statement to point out wherein he so acted. If he did not so act then his decision should not be set aside merely because the Trial Court, in the first instance, would not have interpreted the rules and statutes as the Commissioner did. Moreover, for the reasons given above, it is thought to be clear both on principle and authority that the interpretation of the Commissioner, rather than that of the Trial Court is the correct one.

MOTION TO SHIFT IS AN INTERLOCUTORY MATTER

A motion to shift the burden of proof is a purely interlocutory matter and determines nothing finally except the order in which the parties shall take their testimony in the Patent Office. The other questions raised by such a motion may be reviewed at final hearing (Rule 122), and may be considered by the courts on appeal from the award of priority or in an action under R. S. 4915 (U. S. C., title 35, sec. 63). Since these matters may thus be reviewed in a manner regularly provided there seems to be no necessity for intervention by the courts in order to consider them sooner. As was said by this Court in *Hammond v. Hull, supra*.

Courts have no general supervisory powers over the executive branches or over their officers which may be invoked by writ of mandamus. Interference of the courts with the performance of the ordinary duties of the executive departments of the government would be productive of nothing but mischief.

If the Commissioner's decision in these cases is allowed to stand, the appellee can sustain no material damage. The question as to Hunt's right to the earlier date may be considered at final hearing and on appeal. The only thing finally determined by the Commissioner's decision would be the order of taking testimony. The appellee cannot be materially injured by being required to take testimony first. If Coffey is the first inventor he can prove it without waiting to see what testimony Hunt can produce. The matter is a minor one of Patent Office pro-

cedure and not of such a nature as to warrant interference by the courts.

INTERFERENCES NOS 82,554 AND 82,555

If the foregoing reasoning is correct, it is evident that the decision appealed from should be reversed in its entirety, and the following statement need not be considered. There is, however, a further ground for reversal of the decision as to interferences Nos. 82,554 and 82,555. In these interferences the Commissioner has taken no action whatever, and his authority was not invoked by either party. The examiner of interferences, upon consideration of the Commissioner's action in interference No. 82,262, held that Hunt should be made the senior party in interferences Nos. 82,554 and 82,555 and refused to set for hearing, in the latter case, a motion by Coffey to shift the burden of proof. This was clearly a quasi-judicial action since it involved interpretation of the Commissioner's decision in one case and application of it to the facts in another case. Nevertheless the Trial Court, by its judgment herein, instructs the Commissioner to direct the examiner of interferences to vacate this quasi-judicial decision and to proceed in a specified manner. In other words, in interferences Nos. 82,554 and 82,555 the Commissioner is directed by the Trial Court to take the very kind of action which, in interference No. 82,262, the Court holds that the Commissioner has no jurisdiction to take. It is not clear how these two rulings can be reconciled and it is submitted that, even if the decision below as to interference No. 82,262 could be held to be sound, the decision as to the other two interferences could not be sustained.

CONCLUSION

It is respectfully submitted that the situation presented in this case is one of normal exercise of the Commissioner's supervisory authority in a proper manner and in order to obtain a fixing of the burden of proof in the manner plainly required by the statutes and by the Patent Office Rules, and that the decision below, if affirmed, will require the Patent Office to proceed with the interferences in violation of the decision of

the United States District Court for the District of Columbia
in Civil Action No. 20,023.

Respectfully submitted.

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AUGUST, 1947.

BRIEF FOR APPELLEE

IN THE

United States Court of Appeals

DISTRICT OF COLUMBIA.

*United States Court of Appeals
for the District of Columbia*

—
No. 9574
—

FILED SEP 19 1947

Joseph W. Stewart

CLERK

LAWRENCE C. KINGSLAND, COMMISSIONER OF
PATENTS, *Appellant*,

v.

CARTER CARBURETOR CORPORATION, *Appellee*.

—
Appeal from the Judgment of the District Court of the
United States for the District of Columbia.
—

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IN THE
United States Court of Appeals

DISTRICT OF COLUMBIA.

Appeal No. 9574.

LAWRENCE C. KINGSLAND, COMMISSIONER OF
PATENTS, *Appellant*,

v.

CARTER CARBURETOR CORPORATION, *Appellee*.

Appeal from the Judgment of the District Court of the
United States for the District of Columbia.

BRIEF FOR CARTER CARBURETOR CORPORATION.

COUNTER-STATEMENT OF THE CASE.

Interferences Nos. 82,262, *Hunt v. Coffey*, 82,554, *Hunt v. Henning* and 82,555, *Coffey v. Hunt*, here involved, are the outgrowth of earlier Interferences Nos. 76,519, *Hunt v. Henning*, and 78,346, *Hunt v. Coffey*, which were dissolved. The applications involved in the pending interferences are the same as those involved in the earlier ones.

In Interferences Nos. 76,519 (A-94), and 78,346 (A-111), Hunt's application there involved was Ser. No. 727,648 filed May 26, 1934; Henning's application was Ser. No. 575,577; and Coffey's application was Ser. No. 679,201, filed July 6, 1933, patented June 29, 1937 as No. 2,085,351.

In Interferences Nos. 76,519 and 78,346 motions made to shift the burden of proof and motions to dissolve presented the question whether Hunt was entitled to the benefit of the filing date of a Hunt and Olson joint application Ser. No. 575,025 filed November 14, 1931. The Primary Examiner decided he was not. (A-97 and A-114) The interferences were dissolved and the claims finally rejected to Hunt. Hunt appealed *ex parte* to the Board of Appeals which upheld that rejection. Hunt's assignee, Bendix Aviation Corporation, then brought suit under R. S. 4915 against Coe, Commissioner of Patents, Civil Action No. 20,023, in the United States District Court for the District of Columbia. Judge Letts held Hunt entitled to the benefit of the joint Hunt and Olson application, and that the subject matter of the claims involved was disclosed in the joint application. *Neither Coffey, nor Henning, nor Carter Carburetor Corporation, their assignee, was a party or privy to that action or judgment.*

679,201
Interference No. 82,262, *Hunt v. Coffey*, was thereafter declared between Hunt's application Ser. No. 727,648 filed May 26, 1934 and Coffey's Ser. No. ~~674,201~~ 679,201, filed July 6, 1933, patented June 29, 1937 as No. 2,085,351 (A-27). Under Patent Office Rule 116 the burden of proof rested upon Hunt. Acting under Rule 122 Hunt presented to the Examiner of Interferences a motion to shift that burden upon the ground that he was entitled to the benefit of the Hunt and Olson application No. 575,025 filed November 14, 1931 and of allegedly favorable rulings in the R. S. 4915 action. (A-29)

The Examiner of Interferences filed his opinion referring to the prior decision of the Primary Examiner upon that issue in Interference No. 78,346, *Hunt v. Coffey*, of which

Interference No. 82,262 is a continuation. The Primary Examiner had there said: (A-115)

"The Party Hunt has moved to shift the burden of proof in view of the Hunt and Olson application Ser. No. 575,025. *The Hunt and Olson application does not have the same disclosure as the present Hunt application Ser. No. 727,648.** Hunt, therefore cannot be given the benefit of the date of the Hunt and Olson application. This motion must therefore be denied. A full discussion of the reasons why Hunt cannot rely on the Hunt-Olson application and why the burden of proof must be on Hunt is found in a concurrent decision on motions in interference 76,519 and such reasons are hereby incorporated in the present decision. See 'Decision on Motion I' in interference 76,519."

In his decision in Interference 76,519 *Hunt v. Henning* the Primary Examiner had ruled (A-98),

"This motion raises the question of Hunt's right to the benefit of the filing date of the Hunt and Olson application No. 575,025 of Nov. 14, 1931: *There are two differences between disclosures of the Hunt-Olson application and the sole application of Hunt. One of these differences is obvious upon inspection of the drawings. The other is apparent only on comparison of the two descriptions. In considering the first of these differences it is to be noted that the matter in Fig. 7 of Hunt 727,648 which is not shown in the joint application is matter which Hunt and Olson attempted to incorporate in the joint application by amendment. This matter consists of the relation of the various carburetor nozzles, venturis, jets and the throttle to the automatic choke device. The examiner held this to be new matter in the joint application. Thereupon Hunt filed a sole application containing this new matter as well as all of the original subject matter of the joint application.*"

He continued (A-100),

"*There is another reason why Hunt cannot benefit by the filing date of the Hunt-Olson application. This is*

* Emphasis throughout this brief is counsel's unless otherwise noted.

because the *Hunt* application is not a continuation of the *Hunt-Olson* application at all. The decision of *in re Roberts* 1920 C. D. 158 holds that a joint application can be continued by a sole application for the same invention if one of the joint inventors was joined by inadvertence or mistake. *That is not the situation here.* Hunt and Olson filed joint application 575,025 on Nov. 14, 1931. Hunt filed a sole application No. 727,648 on May 26, 1934. Olson submitted an oath in the latter stating that he was not the inventor of the subject matter of the claims in this sole application. Olson has never made oath that he did not invent the matter claimed in the *Hunt-Olson* application. *In fact after Olson's oath was filed in Hunt 727,648 the Hunt-Olson application was still prosecuted before the Office. Hunt-Olson application was even passed to issue. The subject matter of the sole application is not the same as the subject matter of the joint application. It is therefore evident that Hunt is not an in re Roberts continuation. Where a joint application is a valid application, a later filed sole application cannot be given the benefit of the earlier date.*"

Continuing, in his "opinion" (Rule 122) in No. 82,262, the Examiner of Interferences stated that the motion to shift, there pending, "refers to allegedly favorable rulings of the District Court for the District of Columbia on an *ex parte* appeal" (A-29).

The decision of the Examiner of Interferences was (A-30):

"The motion to shift by Hunt is dismissed without prejudice to his right to urge at final hearing that he be given the benefit of the joint application referred to therein."

Upon Hunt's motion for reconsideration the Examiner of Interferences, adhering to his original decision, pointed out particulars in which the motion to shift was defective, and stated that (A-70):

"The motion to shift filed April 8, 1946 made no attempt to apply the counts to the earlier application (of

Hunt and Olson, Serial No. 575,025) and referred to no showing to establish that Hunt as sole inventor is entitled to rely upon the joint application, but relied entirely upon an uncertified copy of certain conclusions of law in a Civil Action."

Hunt presented to the Commissioner of Patents a petition "to review and reverse the ruling of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof" (A-31).

Coffey (Carter) opposed Hunt's petition.

On July 19, 1946, the Commissioner of Patents, acting through the Honorable Thomas F. Murphy, entered upon Hunt's petition an order which, after referring to the decision in the District Court (Civil Action No. 20,023), provided (A-35);—

*"Coffey was not a party to the proceeding in the District Court, and its decision is not res judicata as to him but, in accordance with the settled practice, the Patent Office will accept the Court's decision as correct, unless it is shown not to be so. Prima facie, therefore, Hunt is entitled, in this proceeding, to the benefit of the filing date of the joint application, and the primary examiner should have accorded him the benefit of this date in setting up the interference. Hunt therefore, should be made the senior party, without consideration of his motion to shift the burden of proof. * * * this question should not be further considered at the interlocutory stage, but should be disposed of at final hearing. The petition is granted to the extent indicated."*

Coffey twice petitioned the Commissioner of Patents to vacate that order (A-64 and 85). The Commissioner dismissed each of Coffey's petitions (A-76 and 93). In his first petition Coffey had pointed out that because of the statutes of March 2, 1927 and August 5, 1939¹ and Rule 124 the Commissioner had no appellate jurisdiction in the mat-

¹ The statutes of March 2, 1927 and August 5, 1939 are set out at large in an Appendix at the end of this brief.

A-76 ter. In his order denying Coffey's (Carter's) first petition to vacate his order of July 19, 1946 the Commissioner stated (~~A-104~~):

Hunt's petition was not considered as an appeal but as a petition to the supervisory authority of the Commissioner, and the action taken on the petition was based on such authority."

A-78 Coffey, likewise, on or about August 26, 1946 moved the Examiner of Interferences in Interference No. 82,262 to shift the burden of proof from Coffey, upon whom, pursuant to the order of the Commissioner, the burden of proof had been imposed, back to the party Hunt (~~A-105~~).

A-84 Thereon the Examiner of Interferences said (~~A-112~~):

"In accordance with the Commissioner's decision under date of July 19, 1946, (see lines 2 to 6, inclusive, page 2) consideration of Coffey's motion to shift the burden of proof is deferred to final hearing."

Thereupon, on November 29, 1946 Carter Carburetor Corporation (Coffey's assignee), having exhausted all remedies for relief in the Patent Office, filed in the District Court of the United States for the District of Columbia, a complaint (A-1) against Casper W. Ooms, Commissioner of Patents, as defendant, wherein plaintiff prayed (A-10) for judgment—

(1) that the Commissioner was without jurisdiction to make his order of July 19, 1946.

(2) that in denying Coffey's petition to vacate the Commissioner's order of July 19, 1946 the Commissioner acted capriciously and arbitrarily, and in violation of Patent Office Rules 116, 122, 124, 159 and 199.

(3) commanding the Commisisoner to vacate his said order and to dismiss Hunt's petition to him,

(4) commanding the Commissioner to order the Examiner of Interferences having charge of Interference 82,262

and two companion Interferences Nos. 82,554 and 82,555² to disregard the purported order of the Commissioner and to proceed in said three interferences as if said order had not been made, and

(5) for general relief.

The hearing upon Carter's motion for a preliminary injunction was converted by stipulation into a final hearing. The un rebutted affidavit of Mr. Ericson filed on behalf of plaintiff, Carter, averred (A-60 and 61):

"While the Commissioner of Patents in his said decision of July 19, 1946 expressly noted that the judgment in Bendix Aviation Corporation v. Coe, Civil Action No. 20,023, was not considered *res judicata*, he held, nevertheless, that it was competent and admissible evidence to establish *prima-facie* that Hunt was entitled to the benefit of the filing date of the joint application of Hunt & Olson, Serial No. 575,025, stating in his decision that 'the Patent Office will accept the Court's decision (in Bendix Aviation Corporation v. Coe, Civil Action No. 20,023) as correct, unless it is shown not to be so.' For plaintiff to overthrow the said decision in Civil Action No. 20,023 and establish that Hunt is not entitled to the benefit of the filing date of the said joint application of Hunt & Olson, *plaintiff will be required to establish by evidence the negatives* that Hunt is not the sole inventor of the invention disclosed in said Hunt & Olson application, that the joint order as inventors of said Hunt and said Olson in their joint application for patent, Serial No. 575,025, was not a mistake, that the said joint application was not filed in good faith, and that reasonable diligence was not exercised to correct any mistake in the filing of said application, Serial No. 575,025 as a joint application of said Hunt and said Olson (In re Roberts, 49 App. D. C. 250; 263 F. R. 648) after its discovery. The *matters determinative of whether or not Hunt is en-*

² Interference 82,554 was between Hunt and Henning, while Interference 82,555 was between Coffey and Hunt. After the decision of the Commissioner in Interference 82,262 on July 19, 1946 that ruling of the Commissioner was applied by the Examiner of Interferences in those Interferences 82,554 and 82,555 and Hunt became the senior part in each.

*titled to the benefit of the filing date of Hunt & Olson application, Serial No. 575,025 are facts peculiarly within the knowledge of said Hunt & said Olson. No evidence concerning those facts was adduced in said Civil Action No. 20,023. * * **

After making his findings of fact and conclusions of law (A-17), Judge Letts (who had sat also in Civil Action 20,023) decreed (A-26):

"1. That, Casper W. Ooms, Commissioner of Patents, was without jurisdiction or authority in law to make his decision or order of July 19, 1946, in Interference No. 82,262, Hunt v. Coffey.

"2. That, Casper W. Ooms, Commissioner of Patents, be and he hereby is ordered and directed to vacate and set aside his order of July 19, 1946, in Interference No. 82,262, Hunt v. Coffey, and to dismiss the so-called petition of Scott F. Hunt, upon which said order was based; and

"3. That, Casper W. Ooms, Commisisoner of Patents, be and he hereby is commanded to make and enter an order within 30 days from the date hereof, directing the Examiner of Interferences having jurisdiction of Interferences No. 82,262, No. 82,554, and No. 82,555, to disregard the invalid and void order of the Commissioner entered July 19, 1946 in Interference No. 82,262."

The Court thus adjudged that the Commissioner was without jurisdiction to make his order of July 19, 1946 and that he should restore the *status quo ante*.

It is from that decree that the Commissioner appealed.

STATUTES AND RULES INVOLVED.

The statutes and rules involved will be found in an Appendix to this brief.

SUMMARY OF ARGUMENT.

The Commissioner's order of July 19, 1946 states:

"Coffey was not a party to the proceeding in the District Court (Civil Action 20,023) and its decision is *not res judicata* as to him, *but* in accordance with the settled practice *the Patent Office will accept the court's decision as correct* unless it is shown not to be so."

That ruling amounts to an enforcement by the Commissioner of his will upon all the Patent Office tribunals, including the primary examiner, the interference examiners, and the board of interference examiners in the interferences here involved.

That order was in violation of the settled law that a judgment is not admissible in evidence against one not a party or privy thereto.¹ It was a direct violation of the long-established rule that a judgment in an R. S. 4915 action of A against B is not admissible in evidence in an interference between A and C.² It was in utter disregard of the last sentence of Rule 159,³ which has the force of statute and is binding upon the Commissioner as well as upon applicants.⁴ In his answer to Paragraph 24 (A-14) of the amended complaint, the Commissioner expressly so concedes, saying:

"He admits that the Rules of Practice in the United States Patent Office are binding on the Commissioner of Patents."

The Commissioner's order of July 19, 1946 gave evidential value, *a judicial function*, to the judgment in Civil Ac-

¹ *Taber v. Perrot*, Fed. Case 13,721; *Hurst v. McNeil*, Fed. Case 6,936.

² *Potter v. Dixon*, Fed. Case 11,325.

³ "This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office."

⁴ *Westinghouse Traction Brake Co. v. Christensen*, 243 Fed. 901, 905 (CCA 3); *Anderson v. Walch*, 152 F. (2d) 975 (CCPA); *In re Horton*, 58 F. (2d) 682 (CCPA); *Avery v. Chase*, 101 F. (2d) 205, 212 (CCPA).

tion No. 20,023. It gave sufficient evidential value to that judgment to outweigh, *as against Coffey (Carter)*, the express provisions of Rule 116. This it did, notwithstanding, as appears by Mr. Ericson's unquestioned affidavit (A-61) that in obtaining that judgment in Civil Action 20,023 Hunt (Bendix) did not meet the requirements fixed by this Court in *In re Roberts*, 49 App. D. C. 250, 263 Fed. 648, as applicable in such cases.

The question involved upon a motion to shift the burden of proof relates directly and primarily to the issue of priority of invention.

The Commissioner's order thus heavily weighted *against Coffey (Carter)* and in favor of Hunt (Bendix), the issue of priority of invention.

By the Acts of March 2, 1927 and August 5, 1939, the Congress had expressly withdrawn from the Commissioner his former power and jurisdiction "to determine the question of priority of invention." Rule 124 (established October 5, 1939, the date the Act of August 5, 1939 went into effect), provides in plain, clear, unambiguous, broad and comprehensive terms, that "No appeal will be permitted from a decision rendered on a motion brought under the provisions of Rules 109 and 122", the latter of which authorizes motions to shift.

The Commissioner's order of July 19, 1946 continues:

"Prima facie, therefore, Hunt is entitled *in this proceeding*, to the benefit of the filing date of the joint application, and the Primary Examiner should have accorded him the benefit of this date in setting up the interference. Hunt, therefore, should be made the senior party without consideration of his motion to shift the burden of proof."

Interference No. 82,262 was between Hunt's Application Ser. No. 727,648 and Coffey's Application Ser. No. 679,201. The Hunt-Olson joint application, ultimately abandoned for failure to pay the final fee, was prosecuted to allowance as

a valid joint application after Hunt's sole application had been filed. The joint application was not involved in that interference. That interference was declared after the abandonment of the joint application. After its abandonment, that joint application could not then have been involved in that or any other interference. R. S. 4904, U. S. C. Title 35, § 52 authorizes interferences only between *pending* applications or a *pending* application and an unexpired patent.

The Primary Examiner could not have given to Hunt the benefit of the joint application in setting up an interference between Hunt and Coffey at the time Interference No. 82,262 was declared. The Primary Examiner was not at liberty to act upon the decision of the District Court in Civil Action No. 20,023, in that Coffey (Carter) was neither a party nor privy thereto. That decision was *inter alios*.

In setting up the interference, the Primary Examiner was required by Rule 97 to forward to the Interference Division "a statement disclosing the *applications involved in interference*, fully identified, *arranged in the inverse chronological order of the filing of the completed applications*". That requirement coupled with Rule 116 precluded the Primary Examiner from determining upon extraneous evidence, before setting up the interference, whether Hunt, was or was not entitled to the benefit of the joint application. He could not, on his own motion, raise and determine without evidence whether Hunt could satisfy the requirements of *In re Roberts*. He could not raise that issue between the parties before the interference was declared for until then there were no parties and no issues.

Consequently, Rule 116 had to govern the whereabouts of the burden of proof, unless and until, upon a motion to shift the burden of proof, it was *judicially* determined, upon proper evidence, by a proper tribunal, whether the presumption of Rule 116 had or had not been overthrown. In view of the Acts of 1927 and 1939 and Rules 97, 101, 102, 116, 122, 124 and 159 the Commissioner was without power

or jurisdiction to determine that question under a non-existent appellate power; under a power incidental to appellate jurisdiction, or by misstating, as ministerial, the character of his order.⁵

Jurisdiction of a tribunal to make a challenged order or decree is a *sine qua non* of due process within the Fifth Amendment to the Constitution of the United States.⁶

A-61 The un rebutted affidavit of Mr. Ericson sets forth (A-69) that in Civil Action No. 20,023 no evidence meeting the requirements of *In Re Roberts* was adduced.

The Commissioner accepted without appeal, the decision in Civil Action No. 20,023 wherein Hunt adduced no evidence meeting the requirements of *In re Roberts*. Having accepted that decision in which Hunt was permitted to bypass and circumvent the requirements of the decision in *In re Roberts*, the Commissioner's order of July 19, 1946 permits Hunt to use the decision in Civil Action No. 20,023 again to evade, bypass and circumvent the requirements of *In re Roberts*, and escape the burden imposed by Rule 116.

Since the Commissioner made his order binding upon the Board of Interference Examiners, as well as upon other tribunals of the Patent Office, the Commissioner acted not only outside his jurisdiction but also made it indispensable that Coffey (Carter) show affirmatively by Hunt and Olson that they had *not* met the requirements of *In re Roberts*,—or have that Board accept the decision in Civil Action No. 20,023 as conclusive upon the question whether Hunt is entitled to the benefit of the joint application.

The challenged order having heavily weighted the issue against Coffey (Carter), even before the Board of Interference Examiners, he has no plain, adequate and complete relief save in this proceeding.

The Commissioner was wholly without jurisdiction to make the challenged order. His action was arbitrary and capricious.

⁵ *Goss v. Scott*, 1901 C. D. 80, 83-84; 96 O. G. 842; *Manny v. Easley v. Greenwood, Jr.*, 1889 C. D. 179; 48 O. G. 538; *Waite v. Macy*, 246 U. S. 606.

⁶ *Ex parte Radivoeff*, 278 Fed. 227, 229; *Scott v. McNeal*, 154 U. S. 34, 46.

Under the circumstances here present, the decisions of this Court authorize the issuance of the injunction in the nature of a writ of mandamus as prayed for in the complaint.

ARGUMENT.

What was the Commissioner's order of July 19, 1946? What was its scope and effect? Was it in character judicial or ministerial? Was it arbitrary and capricious? Was it made outside his jurisdiction?

Did the Commissioner's jurisdiction to determine the issue of priority between parties to an interference remain the same after the effective dates of the Acts of 1927 and 1939 as before their passage? Was the Commissioner's jurisdiction to "review and reverse" a *decision* of an Examiner of Interferences upon a motion to shift the burden of proof, brought under Rule 122, unaffected by the establishment of Rule 124 which provides:

"No appeal will be permitted from a decision rendered on a motion brought under the provisions of Rules 109 and 122."¹

Could the Commissioner, by labeling his order of July 19, 1946—"Done under supervisory authority"—exercise, under his supervisory authority, the powers and jurisdiction of which he had been deprived by the Acts of 1927 and 1939 and Rule 124?

May both the letter and the spirit of those statutes and that Rule, which has the force of a statute, be wholly nullified by a label placed by the Commissioner upon his order?

May a decision of a District Court for the District of Columbia, in an action under R. S. 4915 brought by "A" against the Commissioner of Patents, to which "C" was not a party or privy, be put in evidence or otherwise given effect in a subsequent interference between "A" and "C"?

Was the admissibility or inadmissibility, the effect or lack of effect as against Coffey, of the decision in Civil Ac-

¹ The effective date of that Rule was October 5, 1939, the day upon which the Act of August 5, 1939 went into effect.

tion 20,023 not to be determined by judicial processes—not summarily by ministerial power?

THE ORDER OF THE COMMISSIONER OF JULY 19, 1946 WAS ARBITRARY AND CAPRICIOUS AND MADE OUTSIDE HIS JURISDICTION.

The basic issue in this case is whether the Commissioner of Patents had jurisdiction to make the specific order made by him on July 19, 1946. Whether the Commissioner had or had not jurisdiction to make some other order, upon his own initiative, or in response to Hunt's petition to—

“review and reverse the ruling of the examiner of Interferences dismissing Hunt's motion to shift the burden of proof”

is not here involved.

The powers of the Commissioner of Patents are not unlimited. Applicants for patents may not be deprived by the Commissioner of their property rights save by due process.² Nor may the Commissioner ignore the will of Congress, as expressed in its pertinent statutes, by which power and jurisdiction are granted to or withdrawn from him. Rules of Practice, which have the force of statutes,³ limit his jurisdiction and power. In paragraph 24 (A-14) of his answer to the amended complaint, the Commissioner expressly concedes that

“the Rules of Practice in the United States Patent Office are binding on the Commissioner of patents.”

² Compliance by government officials with departmental rules is essential to due process. Jurisdiction of a tribunal to make a challenged order or decree is a *sine qua non* of due process. *Scott v. McNeal*, 154 U. S. 34, 46; *Ex Parte Eadioeff*, 278 F. 227, 229.

To condemn without a hearing is repugnant to the due process clause. *Riverside Mills v. Menefee*, 237 U. S. 189, 193.

³ The Rules of the Patent Office have the force of a statute and are as binding upon the Commissioner and all officials of the Patent Office as upon applicants for patents and parties to interferences. *Westinghouse Traction Brake Co. v. Christensen*, 243 Fed. 901, 905 (C. C. A. 3); *Anderson v. Walch*, 152 F. (2d) 975; *Avery v. Chase*, 101 Fed. (2d) 205, 210; *In Re Horton*, 58 Fed. (2d) 682; *Interference Law and Practice*, by Rivise and Caesar, Vol. 1, p. 25, § 10.

The court's decision referred to by the Commissioner in his order of July 19, 1946 was made in the United States District Court for the District of Columbia in *Bendix Aviation Corporation v. Conway P. Coe*, Commissioner of Patents, Civil Action No. 20,023.

It is elementary that a judgment affects only parties and privies and is inadmissible in evidence against others.

Since the foundation of this Government, the law with respect thereto has been as stated by Mr. Justice Story sitting at Circuit in *Taber v. Perrot*, (decided 1815), 23 Fed. Case No. 13,721, pp. 609-611. He there said:

"A former judgment can only be evidence, where it is between the same parties, or their privies. The parties here are not the same; so far, therefore, from its being conclusive evidence against the plaintiff, as a former judgment upon the same cause of action, *it is no evidence at all.*"

In *Hurst v. McNeil* (decided 1804), 12 Fed. Case No. 6936, p. 1039, Mr. Justice Washington sitting at Circuit said:

"If there be a point completely settled, and at rest, it is this; that a verdict between different persons *cannot be given in evidence*, in a suit of one of the parties against a stranger."

That long established rule should of itself have been sufficient to stay the hand of the Commissioner.

But the Commisisoner was also enjoined by Rules 116 and 159 from using the judgment in Civil Action 20,023 against the Commissioner to affect the rights of Coffey (Carter).

Rule 116 is:

"The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the *burden of proof* will rest upon the party who shall seek to establish a different state of facts."⁴

⁴ "To say that a party has the burden of proof, is exactly the same thing as saying that the duty of *proving* the facts in dispute rests upon him."

New Castle Bridge Co. v. Doty, 76 N. E. 557, 558; 37 Ind. App. 84.

The last sentence of Rule 159 provides:

"* * * This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office."

The principle that the judgment to which Coffey (Carter) was neither a party nor privy could not be used to deprive him of his rights under those Rules was expressly laid down by Mr. Justice Nelson sitting at Circuit in *Potter v. Dixon* (decided 1863), 19 Fed. Case No. 11,325, pp. 1145-1146. These were his words:

"* * * a hearing and decision between the applicant for a patent and A, whether in favor of the one or the other, *forms no rule for a decision between the applicant and B, in case of an interference declared between them. The proceedings are independent and inter-alios.*"

Notwithstanding the unambiguous and specific decisional law, given the effect of statute by the last sentence of Rule 159, the Commissioner swept it all aside and arbitrarily and capriciously deprived Coffey of his rights under Rule 116, which have the effect of statutory rights.

After the filing of Hunt's application sole, the joint application was prosecuted to allowance as a valid joint application and then was forfeited and became abandoned for failure to pay the final fee (~~A-98 and 100~~).

The Commissioner could not substitute that abandoned joint application for Hunt's sole application in Interference No. 82,262. Hence, the overthrowing of Rule 116, if it was not an arbitrary and capricious act of the Commissioner, was the result of a balancing of an evidential value assigned by him to the judgment in Civil Action 20,023 against the presumption of priority of invention established

To hold that the burden of proof in "A" v. "C" can be met, even *prima facie*, by a judgment or decision in Action "A" v. "B", to which "C" was not a party or privy, is abhorrent to one's sense of justice, as well as in violation of the due process clause and the settled law. At this late date, such a ruling must be deemed wholly arbitrary and capricious.

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by Rule 116. That would have called for the exercise of judicial processes and functions. That would have been judicial in its nature. Such jurisdiction was withdrawn from the Commissioner by the Acts of 1927 and 1939, and Rule 124.

On page 8 of his brief the Commissioner, refusing to accept the rule that a judgment is not binding *inter alios*, states:

“It is thought to be too clear to require argument that the Patent Office is *bound to accept* the conclusions of the courts in actions under R. S. 4915, at least in the absence of *evidence* which was not before the courts. *If this were not the case, an action under that statute would be idle ceremony.*”

That statement is wholly fallacious.

Here again the Commissioner but carries forward his disregard of his Rule 159. Hence, his reasoning is wholly factitious. The judgment in the case of *Hunt v. The Commissioner* is inadmissible in an interference against Coffey or Henning.

But if Hunt should prevail in those interferences the judgment would then avail Hunt against the Commissioner.

The Commissioner would find support in *Hoover Co. v. Coe*, 325 U. S. 79 for his contention. But that decision gives him no aid. The Commissioner quotes from the opinion in *Hoover Co. v. Coe* that portion thereof which says that the Congress “has made the effect of adjudication in equity the same as that of decision on appeal”. He cites R. S. 4914 to show that the effect of decision on appeal is “to govern the further proceedings in the case”.

Section 4915 R. S., 35 U. S. C. Sec. 63 says with respect to the decision of the Court in a 4915 action that:

“And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law.”

Section 4914 R. S., 35 U. S. C. Sec. 62 says, with respect to the decision of the Court of Customs and Patent Appeals, that:

“After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings *in the case.*”

These statutes make it manifest that the decision of a Court under R. S. 4915 has no effect except “in the case” in which it was made. In *Hoover Co. v. Coe* the Court quoted a statement made to the Court by the Commissioner respecting Patent Office practice.

Therein the Commissioner said:

“Similarly, if another applicant or a patentee is claiming substantially the same subject matter as that held patentable in the Rev. Stat. 4915 suit and a question of priority arises, interference proceedings may be necessary under Rev. Stat. 4904 to determine which of the adverse claimants is the first inventor * * *.”

This statement is by necessary implication an acknowledgement that the decision of the Court in a 4915 suit is without effect in a subsequent interference wherein one of the parties was not a party to the 4915 action. Nowhere in the statement of the Commissioner quoted in *Hoover Co. v. Coe*, or in the Court's opinion in that case, is the contrary said or suggested. This statement plainly indicates that rather than “govern the further proceedings” with respect to one not a party thereto, as the Commissioner contends, the 4915 judgment lies dormant while the successful applicant in the 4915 suit meets the challenge of priority arising subsequent to the equity action.

Hoover Co. v. Coe thus recognizes the soundness of the doctrine of *Potter v. Dixon*, Fed. Cas. 11,325. It refutes the statement in the order of July 19, 1946 that the Patent Office will, or legitimately may, accept the decision of a

Court in an action under R. S. 4915 as affecting in an interference the rights of one not a party or privy to such action.

In *Potter v. Dixon*, 19 Fed. Cases, p. 1145, Case No. 11325, Mr. Justice Nelson, sitting at Circuit, referred to the Eleventh Section of the Act of 1839, corresponding to the foregoing provisions of 35 U. S. C. § 62, saying (p. 1146):

“The 11th section of the act of 1839 does not provide that the commissioner shall issue a patent to the applicant if the decision of the chief justice is in his favor, but simply declares that such decision shall ‘govern the further proceedings of the commissioner in such case;’ and so it should, as it respects the parties concerned, *but not as to other parties who may come in and claim the benefit of the same provision.*”

Indeed, the Commissioner refers to no decision evincing that it is the “settled practice in the Patent Office” in interferences to disregard Rule 159; or that it is there the settled practice to disregard the law that “a hearing and decision between the applicant for a patent and A, whether in favor of one or the other, forms no rule for a decision between the applicant and B in case of an interference between them. The proceedings are independent and *inter alios.*” (Fed. Case 11,325)

In view of the unambiguous language of Rules 116 and 159, the order of the Commissioner cannot be deemed otherwise than arbitrary and capricious.

THE PROVISION OF THE COMMISSIONER’S ORDER THAT “THE PATENT OFFICE WILL ACCEPT THE COURT’S DECISION AS CORRECT UNLESS IT IS SHOWN NOT TO BE SO” HEAVILY WEIGHTED THE ISSUE OF PRIORITY OF INVENTION AGAINST COFFEY (CARTER).

At pages 22-23 of his brief the Commissioner states:

this

“If the Commissioner’s decision in ~~these~~ case is allowed to stand, the appellee can sustain no material

damage. The question as to Hunt's right to the earlier date may be considered at final hearing and on appeal. *The only thing finally determined by the Commissioner's decision would be the order of taking testimony.* The appellee cannot be materially injured by being required to take testimony first. If Coffey is the first inventor he can prove it without waiting to see what testimony Hunt can produce. The matter is a minor one of Patent Office procedure and not of such a nature as to warrant interference by the courts."

The truth of the matter is, of course, that the order of the Commissioner seriously affects the issue of priority of invention. It heavily weights that issue against Coffey (Carter).

That the decision upon the question of burden of proof disposes in many cases of the question of priority of invention, and is not merely a minor matter of Patent Office procedure, was recognized and recorded by a Commissioner of Patents years ago. It was recognized by the Commissioner of Patents in *Raulet and Nicholson v. Adams*,⁵ 1905 C. D. 55; 114 O. G. 1827. He there said:

"The situation presented in this case makes it unusually plain that *the question involved in what is termed the 'burden of proof' relates primarily to the question of priority of invention. It involves the question as to the record dates to which the parties are entitled upon the question of priority of invention. This is essentially a matter of evidence, since it is a question whether the application referred to constitutes legal evidence of invention of the subject-matter in controversy at its date. This is a matter which should be determined by the Examiner of Interferences, whose duty it is to pass upon questions of evidence. The decision upon the question of burden of proof in many cases disposes of the question of priority of invention, since the effective date given to the party made senior is often prior to the date of invention alleged by his opponent. If, therefore, a mistake is made in giving the*

⁵ While this decision was made before 1927, the principle there stated is as sound now as then.

senior party the early date, an erroneous decision upon the question of priority necessarily follows."

In *In re Roberts*, 49 App. D. C. 250, 263 Fed. 646, this Court, on March 1, 1920 stated (p. 647):

"* * * The question for our consideration, therefore, is whether, in a case like the present, *where it appears* that a joint application has been filed through mistake or inadvertence and without fraudulent intent, the sole inventor, one of the joint applicants, is estopped from taking any advantage of that application."

In that case, there was identity of subject matter in the joint application and in the subsequent application sole. The sole application had not there been filed, as in the case at bar (A-98), to incorporate in the application sole matter which the Patent Office had refused, on the ground it was new matter, to allow to be incorporated in the joint application by amendment. *In re Roberts* differs from the case at bar, in that there had there been no prosecution of the joint application to allowance after the filing of the application sole. There was there no occasion for the sole applicant to reconcile the prosecution of the joint application with absence of mistake in its filing. Yet in that case, this Court said (p. 649):

"It perhaps is unnecessary to add that a party who seeks to correct his own mistake must act with reasonable diligence, and also *assume the burden* of establishing his good faith."

As appears from the un rebutted and unquestioned affidavit of Mr. Ericson (A-61), in Civil Action No. 20,023 of *Hunt v. The Commissioner of Patents* (to which neither Coffey nor Henning nor Carter was a party), no evidence establishing Hunt's good faith or that the joint application had been filed through mistake or inadvertence was adduced by Hunt.

The facts so stated in the affidavit must have been known to the Patent Office for the Commissioner of Patents was

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the defendant in Civil Action No. 20,023. Apparently it was not pointed out to Judge Letts in Civil Action No. 20,023 that there had been an utter failure of Hunt to meet the requirements of *In re Roberts*. No appeal was taken by the Commissioner from the decision in that case. Yet, in the case at bar the Commissioner requires the Patent Office tribunals to permit Hunt to avail himself of that judgment in such wise as to enable Hunt again, and perhaps ultimately, to avoid meeting the requirements of *In re Roberts*.

The Patent Office—the Board of Interference Examiners—are, on final hearing, by the challenged order to accept the decision in Civil Action No. 20,023 as correct unless Coffey proves the negatives of what Hunt, under *In Re Roberts*, should be required to prove. If because those facts are known only to Hunt and Olson, Coffey is unable to prove those negatives, Hunt has the benefit, as against Coffey, of the judgment in Civil Action No. 20,023 without ever having to prove the facts which, under *In re Roberts*, constitute the *sine qua non* of Hunt's right to a judgment as against Coffey that he is entitled to the benefit of the joint application.

The Commissioner was not only without jurisdiction to make his order of July 19, 1946 but that order contained such provisions in favor of Hunt and against Coffey as to make it well nigh, if not utterly impossible for Coffey to overthrow that judgment at final hearing before the Board of Examiners of Interference.

Hence, Coffey (Carter), is compelled to look to the Courts for relief.

THE COMMISSIONER WAS DEPRIVED, BY THE ACTS OF CONGRESS OF MARCH 2, 1927 AND AUGUST 5, 1939 AND BY RULES OF PRACTICE OF THE PATENT OFFICE, OF ALL APPELLATE JURISDICTION, AND ALL JURISDICTION INCIDENTAL THERE-TO, TO MAKE THE ORDER OF JULY 19, 1946.

Prior to the enactment of the Act of March 2, 1927 (44 Stat. 1335), the Commissioner of Patents was vested with appellate jurisdiction under R. S. Section 4910, U. S. C. Title 35, Section 58, in interference cases.

Beginning with the statute of March 2, 1927 (44 Stat. 1335), and ending with the Act of August 5, 1939 (53 Stat. 1212), the Congress of the United States divested the Commissioner of Patents of all jurisdiction to determine the issue of priority between applicants for patents.

The Act of 1927 expressly repealed R. S. 4910, U. S. C. Title 35, Section 58, which conferred upon the Commissioner of Patents appellate jurisdiction over decisions of the examiners in chief, who under R. S. 4909, U. S. C. Title 35, Section 57 in their turn had appellate jurisdiction over the examiner in charge of interferences.

The Act of 1927, which repealed R. S. 4910, U. S. C. Title 35, Section 58, created a board of appeals and gave to it the only appellate jurisdiction in interference cases in the Patent Office. The Commissioner of Patents was made a member of that board.

The Act of 1939, by rewriting R. S. 4904, U. S. C. Title 35, Section 52, and R. S. 4909, U. S. C. Title 35, Section 57, deprived the board of appeals of all jurisdiction in interference cases and conferred upon a board of three examiners of interferences the jurisdiction in the Patent Office, to determine the question of priority of invention.

Both the letter and spirit of those Acts deprived the Commissioner of the fact-finding burden, duty and jurisdiction affecting the issue of priority of invention between parties to interferences. That was Congressional action. Yet the Commissioner by his order nevertheless asserts the jurisdiction of which he thereby was deprived.

When deprived by the repeal of Section 4910 R. S. of his appellate jurisdiction over the decisions of the Board of Examiners in Chief in interference cases, the Commissioner lost all jurisdiction, and all powers incidental to his appellate jurisdiction, to determine or to control the determination of the issue of priority in interference cases.

In *Fleischmann Co. v. United States*, 270 U. S. 349, 360, the Supreme Court at page 360 stated:

“The strict letter of an act must, however, yield to its evident spirit and purpose, when this is necessary

to give effect to the intent of Congress. *Holy Trinity Church v. United States*, 143 U. S. 457, 459; *Ozawa v. United States*, 260 U. S. 178, 194. And unjust or absurd consequences are, if possible, to be avoided. *Lau Ow Bew v. United States*, 144 U. S. 47, 59; *Hawaii v. Mankiki*, 190 U. S. 187, 213."

Recognizing the spirit of the Act of 1939 which deprived the Board of Appeals of all jurisdiction to determine the issue of priority in interference cases and conferred that jurisdiction upon a board of three interference examiners, the Commissioner of Patents established Rule 124 as it now exists and made it effective on October 5, 1939, the day upon which the Act of August 5, 1939 went into effect. Thereby he provided that "No appeal will be permitted from a decision rendered on a motion brought under the provisions of Rules 109 and 122."

Motions to shift the burden of proof are brought under the provisions of Rule 122. The establishment of that part of Rule 124, effective on the very day on which the Act of August 5, 1939 went into effect, was a clear recognition by the Commissioner of Patents and the Secretary of Commerce, with whose approval that rule was established, that the letter and spirit of the Act demanded that the Commissioner do nothing that would determine or affect the determination of the issue of priority of invention in interference cases. Upon the adoption of that rule, the Commissioner's judicial powers, with respect to motions to shift the burden of proof in interference cases, were at an end.

In *Butterworth v. Hoe*, 112 U. S. 50, the Secretary of the Interior, then charged with the supervision of public business relating to patents for invention, attempted, as does the Commissioner in the present case, to include within his general power of direction and superintendence the judicial function of hearing appeals in interference matters, even though this function had been expressly confided by law to his subordinates. The Court there held that the executive supervision and direction which the head of a department

may exercise over his subordinates in matters administrative and executive do not extend to matters in which the *subordinate is directed by statute to act judicially*.⁶

The Court, speaking by Mr. Justice Matthews, at page 54 said:

“The direct and immediate question, therefore, for our determination, is, whether the Secretary of the Interior had power by law to *revise and reverse* the action of the Commissioner of Patents in awarding to Gill priority of invention, and adjudging him entitled to a patent.”

The power and authority there claimed by the Secretary of the Interior closely parallel that here claimed by the Commissioner. After referring to the statutes from which the Secretary claimed to derive his power, the Court summarized the Secretary's contentions saying (p. 55):

“* * * this general relation of official subordination, with the accompanying powers of supervision and direction, extends to all the official acts of the Commissioner, without regard to any distinction between those which are merely ministerial and those which are judicial in their nature; and that such supervision and direction may be exerted at any stage of a proceeding, in the discretion of the Secretary, whether in advance, or during its progress, or after its termination, and embraces, therefore, the mode of appeal, though no appeal, in express terms, is actually given.”

In rejecting these claims of the Secretary, the Court points out that four tribunals had been entrusted by law to determine interference matters, originally or on appeal, and the Secretary of the Interior was not included among them. (Pages 60-61) The significance of this fact is made plain by the statement of the Court that (pp. 63-64):

“The law gives express appeals from the decision of the Commissioner, or, in cases where technical appeals

⁶ The Board of Interference Examiners is directed by the Act of 1939 to determine the issue of priority. The Commissioner's order interfered with that judicial duty.

are not given, other modes of review by judicial process. It gives no such appeal from him to the Secretary. If it exists, it is admitted it is only by an implication, which discovers an appeal in the power of direction and superintendence. That power does not necessarily, *ex vi termini*, include a technical appeal; and the principle applies that where a special proceeding is expressly ordained for a particular purpose it is presumably exclusive. It is clear that when the appeal is expressly authorized from the Commissioner to the court, either directly or by means of an original suit in equity, another appeal to the Secretary on the same matter is excluded; and no reason can be assigned for allowing an appeal from the Commissioner to the Secretary in cases in which he is by law required to exercise his judgment on disputed questions of law and fact, and in which no appeal is allowed to the courts, that would not equally extend it to those in which such appeals are provided, for all are equally embraced in the general authority of direction and superintendence. That includes all or does not extend to any. *The true conclusion, therefore, is, that in matters of this description, in which the action of the Commissioner is quasi-judicial, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied.*"

The Commissioner of Patents was not "included," on July 19, 1946, by rule or statute, among the tribunals to which had been confided judicial determination of interference matters.

The Commissioner in the instant case is not only *excluded* by legal intendment, but as well by the express provisions of Rule 124.

In his brief (p. 9) the Commissioner contends that he has supervisory authority with respect to all Patent Office matters including "the conduct of interference proceedings," and therefore jurisdiction to enter orders in conformity with his own conclusions, regardless of whether such matters are ministerial, judicial, or quasi-judicial, or whether jurisdiction over any such matters is conferred upon particular Patent Office tribunals. In the *Butterworth* case a

similar contention made by the Secretary of the Interior was considered by the Court, which rejected it saying (p. 67).

“The conclusion cannot be resisted that, to whatever else supervision and direction on the part of the head of the department may extend, in respect to matters purely administrative and executive, they do not extend to a review of the action of the Commissioner of Patents in those cases in which, by law, he is appointed to exercise his discretion judicially. It is not consistent with the idea of judicial action that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates. Such a subjection takes from it the quality of a judicial act.”⁷

The decision of the Supreme Court of the United States in *Butterworth v. Hoe*, above referred to, would seem conclusively to answer the contentions of the Commissioner. But in the case now before this Court, it is not material that the Commissioner of Patents has, in many cases, power and jurisdiction under his general supervisory power to review and reverse orders made, ministerially, judicially or quas-judicially, by any Patent Office tribunal, for the Acts of 1927 and 1939 and Rules 97, 101, 116, 122, 124 and 159 deprived the Commissioner of jurisdiction to make an order having the scope and effect of his order of July 19, 1946. Having been deprived by those statutes and rules of jurisdiction to make that order, he could not nullify those statutes and rules by claiming jurisdiction so to do under another statute not expressly repealed. For the injury done to plaintiff by the invalid order, plaintiff has no plain, complete and adequate relief save by the affirmance of the decree of the District Court.

⁷ The fourth conclusion of law, made by the Court below is (A-22-23):

“The disposition by the Examiner of Interferences of motions to shift the burden of proof, authorized by Rule 122, is made by that Rule to depend and turn upon the ‘opinion’ of the Examiner of Interferences as to whether ‘they be in proper form.’ In reaching his decision, dismissing Hunt’s motion to shift the burden of proof in Interference No. 82262, the Examiner of Interferences exercised judgment and discretion, and his act in so doing was judicial, or *quasi judicial*, in character.”

THE COMMISSIONER ASSERTED THAT HUNT'S PETITION WAS NOT CONSIDERED AS AN APPEAL AND THAT HIS ACTION TAKEN THEREON WAS BASED ON HIS SUPERVISORY AUTHORITY. BUT THE COMMISSIONER'S ORDER OF JULY 19, 1946 LIES OUTSIDE HIS SUPERVISORY JURISDICTION.

In Coffey's first petition to the Commissioner to vacate his order of July 19, 1946 Coffey alleged (A-68) that Hunt's petition of June 15, 1946 to the Commissioner to "review and reverse" the decision of the Examiner of Interferences "was in fact and in substance an attempted appeal from the said decision of the Examiner of Interferences on the motion to shift the burden of proof." Coffey likewise there alleged that no appeal may be taken to the Commissioner from a decision rendered on a motion to shift the burden of proof.

In denying Coffey's petition the Commissioner stated (A-76):

"Hunt's petition was not considered as an appeal but as a petition to the supervisory authority of the Commissioner, and the action taken on the petition was based on such authority."

It is not here necessary or proper to fix or attempt to fix the boundaries or general character of the powers conferred upon the Commissioner by R. S. 481 (U. S. C. Title 35, § 6) which provides:

*"The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; * * *."*

It is self-evident, however, that the powers possessed by the Commissioner of Patents under that statute with respect to any particular matter, at a particular time, may be limited by the necessity of giving effect to other statutes by which the Congress from time to time expresses its will with respect to the powers of the Commissioner.

By the Acts of March 2, 1927 and August 5, 1939, the Congress expressly took away from the Commissioner the power theretofore possessed by him to determine the issue of priority in interference cases. Those statutes, in their scope and effect, are so sweeping in that regard that it seems clear and certain that any act of the Commissioner which would weight the issue of priority against one of the parties to an interference, and in favor of another, would be in violation and disregard of the intent, spirit, purpose and scope of those statutes. It would seem obvious that the first paragraph of Rule 124, particularly in the light of the timing of its promulgation, is an express recognition by the Commissioner of that fact.

Since the later statutes take from the Commissioner his jurisdiction to determine the issue of priority, the spirit of the acts, recognized and declared by Rule 124, deprived the Commissioner of jurisdiction to accomplish by indirection under older Statutes that which is denied to him by the more recent Statutes.

Did Congress do a nugatory thing in the enactment of the Acts of 1927 and 1939? Did its enactment and the curtailment thereby of the powers and jurisdiction of the Commissioner leave him with jurisdiction under R. S. 481, U. S. C. Title 35, Sect. 6 to exercise all the powers he could have exercised prior to the enactment of the 1927 and 1939 statutes?

By his declaration that the action taken by him on Hunt's petition was based on his supervisory authority, the Commissioner would give an affirmative answer to *each* of the foregoing questions.

Indeed, by that declaration, the Commissioner impliedly, if not expressly, concedes that he had no appellate jurisdiction to—

“review and reverse the ruling of the Examiner of Interferences dismissing Hunt's petition to shift the burden of proof.”

While Coffey confidently contends that the Commissioner was without jurisdiction, either appellate or supervisory, to make his challenged order, the appellate character of the order may not be disregarded, nor may the Commissioner, by his declaration, change the essence and character of that order.

The proceeding by which the decision of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof came before the Commissioner was a so-called "petition" filed by Hunt praying—

"that the Commissioner *review and reverse* the ruling of the Examiner of Interferences dismissing Hunt's motion to shift the burden of proof."

This alleged "petition" to the Commissioner to review and reverse the decision of the Examiner of Interferences was plainly and in all respects an appeal. Being such, the Commissioner was forbidden by Rule 124 to entertain it.

Bourier defines an "appeal" as—

"The removal of a cause from a court of inferior to one of superior jurisdiction, for the purpose of obtaining a review and retrial."

Webster's New International Dictionary defines it thus:

"Appeal—1. Law. To make an appeal; to apply for the removal of a cause from an inferior to a superior judge or court for the purpose of reexamination or for decision."

In *Wiscart v. Dauchy*, 3 Dallas 321, the Supreme Court said (p. 327):

"An appeal is a process of civil law origin, and removes a cause entirely; subjecting the fact as well as the law, to a review and re-trial; * * *."

In *Goss v. Scott*, 1901 C. D. 80; 96 O. G. 842 (1901), the Commissioner stated at pages 83-84:

"* * * As stated in *Woodward vs. Newton* (C. D. 1899: 13; 86 O. G. 490), a petition will not be enter-

tained by the Commissioner when it seeks to obtain indirectly a review of an Examiner's decision from which no direct appeal lies by merely misnaming the action and calling it a petition. (*Manny vs. Easley vs. Greenwood*, C. D. 1889, 179; 48 O. G. 538)."

Woodward v. Newton, 1899 C. D. 13, was a petition taken by Woodward from the decision of the Primary Examiner denying his motion to dissolve an interference between an application of Woodward and an application of Newton and refusing to set a limit of appeal from that decision. The Assistant Commissioner stated at page 15:

"The rule prohibiting an appeal from a favorable decision on patentability applies, whatever reason is given for that decision, since it is well settled that the appeal must be from the decision and not from the reasons advanced in support of it. (*Breul v. Smith*, C. D., 1898, 124; 84 O. G. 809). * * *"

"There being no direct appeal from the Examiner's decision, *Woodward will not be permitted to obtain indirectly a review thereof upon appeal by merely misnaming the action and calling it a petition.*"

In *Manny v. Easley v. Greenwood*, 1889 C. D. 179; 48 O. G. 538, it is stated at page 181:

"* * * Parties cannot confer jurisdiction upon the Commissioner, regardless of the matter involved, by the use of a mere form of words. Beneath the words must be sought the real reason upon which the proceeding is based, and if it be found that such reason *relates to a question determinable by some other tribunal than the Commissioner*, he will rightfully refuse to consider it either upon appeal or petition."

The principle enunciated in the foregoing cases is not a principle confined to the Patent Office but is one of universal application.

Waite v. Macy, 246 U. S. 606, was a bill brought by importers of tea to prevent the appellants, a board of general appraisers known as the Tea Board, from applying

to tea imported by the plaintiffs tests which, it was alleged, were illegal and if applied would lead to the exclusion of the tea.

The statute involved provided for the establishment of standards of "purity, quality, and fitness for consumption, of all kinds of tea imported, and made it 'unlawful * * * to import any merchandise as tea which is inferior in purity, quality, and fitness for consumption to the standards' referred to."

The plaintiffs contended that the government was attempting to apply criteria not allowed by the law. The Court, speaking by Mr. Justice Holmes at pages 608-609 said:

"The Government says that the bill is an attempt to control a board in the performance of its statutory duty and to substitute the judgment of a court for that of the board.

"No doubt it is true that this Court cannot displace the judgment of the board in any matter within its jurisdiction, but it is equally true that the board cannot enlarge the powers given to it by statute and cover a usurpation by calling it a decision on purity, quality or fitness for consumption. *Morrill v. Jones*, 106 U. S. 466. *United States v. United Verde Copper Co.*, 196 U. S. 207, 215. *United States v. George*, 228 U. S. 14, 21."

And at page 610 concluded thus:

"The Secretary and the board must keep within the statute, *Merritt v. Welsh*, 104 U. S. 694, which goes to their jurisdiction, see *Interstate Commerce Commission v. Northern Pacific Ry. Co.*, 216 U. S. 538, 544, and we see no reason why the restriction should not be enforced by injunction, as it was, for instance, in *Bacon v. Rutland R.R. Co.*, 232 U. S. 134, *Philadelphia Co. v. Stimson*, 223 U. S. 605, 620. *Sante Fe Pacific R.R. Co. v. Lane*, 244 U. S. 492. *We are satisfied that no other remedy, if there is any other, will secure the plaintiffs' rights.*"

The order of the Commissioner in the case at bar is not different in character from what the Commissioner might have made had the statutes of 1927 and 1939 not been enacted and Rule 124 not been promulgated.

In view of those statutes and the Rules of the Patent Office, it is believed that the Commissioner was without jurisdiction under his supervisory authority to make his order of July 19, 1946.

THE COURTS OF THE DISTRICT OF COLUMBIA HAVE JURISDICTION TO COMMAND THE COMMISSIONER TO VACATE HIS ORDER OF JULY 19, 1946 AND TO DIRECT THE EXAMINERS AND BOARD OF INTERFERENCE EXAMINERS TO PROCEED IN THE INVOLVED INTERFERENCES IN CONFORMITY WITH THE STATUTE, AND THE RULES OF THE PATENT OFFICE, AND TO DISREGARD THE COMMISSIONER'S ORDER OF JULY 19, 1946.

In Interferences No. 82,554, *Hunt v. Henning*, and No. 82,555, *Coffey v. Hunt*, for the reasons stated by the Primary Examiner in Interference No. 76,591, the Primary Examiner had not granted to Hunt the benefit of the filing date of the joint application Ser. No. 575,025 of Hunt and Olson.

But after the Commissioner made his order of July 19, 1946 in Interference No. 82,262, the Examiner or Interferences entered the following order in Interference No. 82,554 (A-38-39):

“HUNT V. HENNING.

“The Assistant Commissioner having ruled in the companion interference referred to by the party Hunt in his communication dated October 17, 1946, that Hunt should be given the benefit of the date of Hunt-Olson application Ser. No. 575,025 with respect to claims including a claim corresponding to the issue of this interference, without consideration of a motion to shift the burden of proof, the order of the parties in this interference now becomes *Henning v. Hunt*.

“The motion filed by the party Henning on November 12, 1946, is granted and in accordance therewith the time for bringing motions is extended to December 12, 1946.”

At the same time, the Examiner of Interferences entered the following order in Interference No. 82,555 (A-47-48):

“COFFEY V. HUNT

“The Assistant Commissioner having ruled in the companion interference referred to by the party Hunt in his communication dated October 17, 1946, that Hunt should be given the benefit of the date of Hunt-Olson application Ser. No. 575,025 with respect to claims including a claim corresponding to the issue of this interference, without consideration of a motion to shift the burden of proof, the record will be made to show that Hunt is entitled to the filing date of the earlier Hunt-Olson application.

“The motion filed by the party Coffey on November 12, 1946, is granted and in accordance therewith the time for bringing motions is extended to December 12, 1946.”

The law has been long established that a public official may be required by mandamus to undo his acts done outside of his jurisdiction and to restore the injured party to the status he previously occupied.

In *Garfield v. Goldsby*, 211 U. S. 249, 261, the action was brought in the Supreme Court of the District of Columbia for a writ of mandamus against the Secretary of the Interior in his official capacity, to require him to erase certain marks and notations theretofore made by his predecessor in office upon the rolls, striking therefrom the name of the relator Goldsby as an approved member of the Chickasaw Nation, and to restore him to enrollment as a member of the Nation. At page 261 the Court said:

“It is insisted that mandamus is not the proper remedy in cases such as the one now under consideration. But we are of opinion that mandamus may issue

if the Secretary of the Interior has acted wholly without authority of law. Since *Marbury v. Madison*, 1 Cranch, 137, it has been held that there is a distinction between those acts which require the exercise of discretion or judgment and those which are purely ministerial, or are undertaken entirely without authority, which may become the subject of review in the courts."

Then, after referring to the decision in *Noble v. Union River Logging Railroad*, 147 U. S. 165, 171, and quoting therefrom, the Court at page 262 continued:

"We think this principle applicable to this case, and that there was jurisdiction to issue the writ of mandamus.

"In our view this case resolves itself into a question of the power of the Secretary of the Interior in the premises, as conferred by the acts of Congress. We appreciate fully the purpose of Congress in numerous acts of legislation to confer authority upon the Secretary of the Interior to administer upon the Indian lands, and previous decisions of this court have shown its refusal to sanction a judgment interfering with the Secretary where he acts within the powers conferred by law. But, as has been affirmed by this court in former decisions, *there is no place in our constitutional system for the exercise of arbitrary power, and if the Secretary has exceeded the authority conferred upon him by law, then there is power in the courts to restore the status of the parties aggrieved by such unwarranted action.*"

At page 264 the Court there concluded:

"For the reasons given we think this action was unwarranted, and that *the relator is entitled to be restored to the status he occupied before that order was made.*"

An analogous situation was presented in *Steinmetz v. Allen*, 192 U. S. 543, which was a petition in mandamus filed in the Supreme Court of the District of Columbia to compel the Commissioner of Patents to require the Primary Exam-

iner to forward an appeal, prayed by the petitioner, to the board of examiners-in-chief, to review the ruling of the Primary Examiner requiring petitioner to cancel certain of his claims in his application. The Court said page 564:

"A suggestion made is that the inventor must await a decision on the merits, meaning by merits 'lack of invention, novelty or utility,' as expressed in rule 133. But after waiting he would encounter the arbitrary requirement of rule 41."

In the case at bar, Coffey would encounter the arbitrary requirement of the Commissioner's order that "the Patent Office will accept the Court's decision as correct (as against Coffey) unless it is shown not to be so." A remedy at final hearing so weighted against him would not be the plain, complete and adequate remedy to which Coffey (Carter) is believed entitled.

In Proctor & Gamble Co. v. Coe, 68 App. D. C. 246, 96 F. (2d) 518, at pages 521-522 this Court said:

"The following tests have been used to uphold the exercise of judicial restraint upon executive action under valid laws: (1) Where an officer, insisting that he has the warrant of the statute, is transcending its bounds, and thus unlawfully assuming to exercise the power of government (Philadelphia Co. v. Stimson, supra); (2) where an officer attempts to enlarge his power, or to usurp power (Waite v. Macy, supra); or (3) where his act is based upon a clear mistake of law (American School of Magnetic Healing v. McAnnulty, 187 U. S. 94, 109, 110, 23 S. Ct. 33, 47 L. Ed. 90); (4) where the action of the officer or administrative body is clearly beyond its power and in violation of the statute (Interstate Commerce Commission v. Northern Pacific Ry. Co., 216 U. S. 538, 30 S. Ct. 417, 54 L. Ed. 608. See Lane v. Watts, 234 U. S. 525, 540, 34 S. Ct. 965, 58 L. Ed. 1440; Santa Fe Pacific R. Co. v. Lane, 244 U. S. 492, 497, 37 S. Ct. 714, 61 L. Ed. 1275); (5) where an officer has acted, or threatens to act, in a capricious and arbitrary manner (Commercial Solvents Corp. v. Mellon, 51 App. D. C. 146, 277 F. 548, 550, and

cases there cited); (6) where the act of the officer, 'under any view that could be taken of the facts that were laid before him, was ultra vires, and beyond the scope of his authority (and) he has no power at all to do the act complained of, he is as much subject to an injunction as he would be to a mandamus if he refused to do an act which the law plainly required him to do.' *Noble v. Union River Logging R. Co.*, 147 U. S. 165, 171, 172, 13 S. Ct. 271, 273, 37 L. Ed. 123; *Board of Liquidation v. McComb*, 92 U. S. 531, 541, 23 L. Ed. 623."

The plaintiff below exhausted all Patent Office sources for relief before resorting to the Courts.

The challenged order disregarded, it is believed, the very fundamentals of justice. It violated the spirit if not the very letter of the statutes of 1927 and 1939. It swept aside the applicable Patent Office Rules as if the Commissioner were unaffected by those Rules and unrestrained thereby. It was of a scope equal to that which might have been made by him if the Acts of 1927 and 1939 had not been enacted and Rules 97, 101, 116, 122, 124 and 159 had never been promulgated and established. It is arbitrary and capricious. It was made by the Commissioner wholly beyond his jurisdiction. It deprives Coffey (Carter) of rights for which he has no plain, adequate and complete relief save at the hands of this Court.

CASES CITED BY THE COMMISSIONER.

Wigton v. Coe, 62 App. D. C. 367, 68 F. (2d) 414, upon which the Commissioner greatly relies, was decided in 1933 before the enactment of the statute of 1939 and the concurrent establishment of Rule 124 as it now exists. By that clear and unambiguous Rule, so concurrently made, the Commissioner recognized and declared the intent, spirit and purpose of the Acts of 1927 and 1939 and gave effect to those statutes. After the adoption of that Rule—clear, plain, unambiguous and comprehensive—which calls for no interpretation and permits none, the Commissioner was no

longer free to contend that he had jurisdiction to determine whether he had jurisdiction to do what is forbidden and prohibited by Rule 124. He was no longer free to decide whether the Act of 1927 deprived him of his supervisory authority, for the very statute (U. S. C. Title 35, Sec. 6) which confers upon him supervisory jurisdiction empowers him to "establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office," and imparts to Rule 124 the effectiveness and force of the statute itself.

In *Butterworth v. Hoe*, 112 U. S. 50, 63, the Supreme Court said:

"* * * the principle applies that where a special proceeding is expressly ordained for a particular purpose it is presumably exclusive."

At page 67, the Court continued:

"That includes all or does not extend to any. The true conclusion, therefore, is, that in matters of this description, in which the action of the Commissioner is quasi-judicial, the fact that no appeal is expressly given to the Secretary is conclusive that none is to be implied."

That the Examiners, whose jurisdiction the Commissioner took upon himself, are required by Rule 122, upon motions to shift the burden of proof, to exercise judicial or quasi-judicial functions is most apparent. That, coupled with the fact of denial of appellate-judicial-jurisdiction to the Commissioner, would seem to place beyond question the applicability in the case at bar of the foregoing doctrine enunciated in *Butterworth v. Hoe*.

Again, the particular order of the Commissioner here challenged is of a far different scope and character from that involved in *Wigton v. Coe*. In the *Wigton* case, the powers of the Examiner of Interferences might well be said to have become *functus officio* upon his making his first decision. In the case at bar, the Commissioner has arrogated

to himself all the powers and jurisdiction conferred upon The Examiner of Interferences and the Primary Examiner by rules which are binding upon the Commissioner and have the force of a statute. That is usurpation. By the very terms of his challenged order, the Commissioner has attempted to enforce his will upon the Board of Interference Examiners. Thereby, he has probably permitted Hunt (Bendix) again to escape the burdens imposed upon him by the decision of this Court in *In re Roberts*, 49 App. D. C. 250, 263 Fed. 646.

Wigton v. Coe, is believed to be without any real bearing upon the case at bar.

United States v. Coe, 66 App. D. C. 21, 84 F. (2d) 398, was decided in 1936. It did not involve a motion to shift the burden of proof or the right of one of two joint applicants to the benefit of a filing date of a joint application. It makes no reference to the Act of 1927. Rule 124, as it now exists, had not then been adopted. The last paragraph of Rule 124, as it then existed, expressly authorized appeals directly to the Commissioner, save in matters pertaining to dissolution of interferences, "from decisions on such motions as in his judgment should be appealable." Apparently, the only statement in the opinion here pertinent is (p. 399):

"We have held, in a fully considered opinion, that the procedure in interferences is determined by the rules of the Patent Office. *Allen v. United States ex rel. Lowry*, 26 App. D. C. 8."

Svenson v. Coe, 69 App. D. C. 359, 101 F. (2d) 684, was decided in 1938. That was a petition for mandamus to require the Commissioner to hold public-use proceedings in connection with certain interference proceedings. From a judgment dismissing the petition, Svenson appealed. The Commissioner here refers to that case because, in its opinion, the Court included this sentence (p. 685):

"This court has repeatedly refused to regulate his conduct of interference proceedings."

But that sentence is immediately followed by this:

“His *discretionary* action in this respect cannot be controlled by mandamus or injunction.”

The Court held that the decision of the Commissioner “to hold or not to hold public-use proceedings is within his discretion.” Manifestly, this is in accordance with Rule 11 which provides and provided that upon

“* * * a petition for the institution of public-use proceedings, * * * a hearing may be had before the commissioner to determine whether a public-use proceeding should be instituted. * * *”

That case seems unrelated to any issue in the case at bar.

Coffey (Carter) has no quarrel with the Commissioner’s excerpt from the case of *Hammond v. Hull*, 76 App. D. C. 301, 131 F. (2d) 23.

However, Coffey contends that, after the establishment by the Commissioner of Rule 124 as of the date upon which the Act of 1939 went into effect, the clarity of that Rule permitted no interpretation thereof by the Commissioner. His duty was confined to the acceptance of that Rule according to its plain terms.

Butterworth v. Hoe, 112 U. S. 50, was decided in 1884. It has not, so far as Coffey (Carter) is aware, been modified. Its ruling is plain. It says (p. 63)—

“* * * the principle applies that where a special proceeding is expressly ordained for a particular purpose it is presumably exclusive.”

Upon motions to shift the burden of proof, a special proceeding is ordained by Rule 122, considered in the light of Rules 97 and 101. That special proceeding is judicial in character. Yet, the Commissioner took the jurisdiction of the Examiner of Interferences and the Primary Examiner upon himself and disregarded Rules 97, 101, 116, 122, 124 and 159 and, in so doing, nullified those rules with respect to the interferences here involved. Such action on the part

of the Commissioner in the light of the surrounding circumstances would seem to place the case at bar wholly without the doctrine of *Hammond v. Hull* relied on by the Commissioner.

Geophysical Development Corporation v. Coe, 78 App. D. C. 39, 136 F. (2d) 275, was decided in 1943. It was a suit for injunction to require the Commissioner to permit the filing of interrogatories and the taking of testimony upon a motion to dissolve as to a party to an interference on the ground that he was barred from making the claims involved in the interference. The *per curiam* opinion states (p. 276):

“The Commissioner ordered that the motion be considered on the record in the Patent Office, but denied appellants’ request to file interrogatories and take evidence in support of their contentions.”

The opinion does not disclose the circumstances under which the Commissioner made his order. But the procedure in the Patent Office upon a petition to file interrogatories and to take testimony upon a motion to dissolve is not specifically defined and provided for by the Patent Office rules, and, accordingly, determination of such matters is within the jurisdiction of the Commissioner.

The question presented in the case at bar is affected by statutes and rules not there involved. That case seems wholly without relevancy to the case at bar.

Bender v. Hoffman, 1898 C. D. 262, 85 O. G. 1739, was decided in 1898. The statutes here involved had not then been enacted. Rules here involved had not then been put in their present form. That case, consequently, does not touch the questions here presented.

Townsend v. Corey, 1905 C. D. 548; *ex parte Knudsen*, 1895 C. D. 29; *ex parte Pledger*, 1910 C. D. 124; *ex parte Cady*, 1916 C. D. 57; *ex parte Hackett et al.*, 1921 C. D. 63; *ex parte Mattlet*, 1926 C. D. 62; *United States ex rel. Johnson v. Ewing, Commissioner*, 1918 C. D. 93, 256 O. G. 451,

were decisions made prior to the enactment of the statutes of 1927 and 1939 and the establishment of the rules of the Patent Office here involved in their present form. They can have no effect upon the Commissioner's jurisdiction to make his order of July 19, 1946.

It follows that no decision of the Commissioner of Patents or any practice in the Patent Office made or existing prior to 1927 can present or resolve the issues here involved with respect to the Commissioner's order of July 19, 1946.

Excerpts from McCrady's *Patent Office Practice* are general statements. No decision since 1927 is referred to in support of either of the excerpts quoted on page 13 of the Commissioner's brief filed herein. The questions here presented could not have been presented, in any case, prior to October 5, 1939, the date that the Act of 1939 and present Rule 124 became effective. General statements of the character of those made by Mr. McCrady can have no bearing upon the determination of the issues involved in the case at bar.

U. S. ex rel Dwiggins v. Ewing, 43 App. D. C. 204, was decided in 1915. The issues presented in the case at bar were then not even in the making. The decision in the case having been made before 1927, it is wholly without relevancy to the issues here involved.

Moore v. United States ex rel. Chott, 40 App. D. C. 591, was decided in 1913.

Podelsak v. McInnerney, 26 App. D. C. 399, was decided in 1906.

Allen v. United States ex rel. Lowry, 26 App. D. C. 8, was decided in 1905.

The scope, effect and character of the Commissioner's order of July 19, 1946; the effect of the Acts of 1927 and 1939; and the establishment of present Rule 124, effective as of October 5, 1939, involved in the case at bar, broadly distinguish the case at bar from any decisions made prior to 1927 or, indeed prior to October 5, 1939.

United States v. Robertson, 57 App. D. C. 179, 18 F. (2d) 829. In that case, mandamus against the Commissioner was

refused, in that, under the facts there present, it was held that there was an adequate remedy by appeal to this Court.

The facts involved in the case at bar establish, it is believed, that in making the order of July 19, 1946, the Commissioner acted arbitrarily and capriciously, beyond his jurisdiction, and that Coffey (Carter) has no "plain, adequate and complete remedy" save by the interposition of this Court.

CONCLUSION.

The challenged order of the Commissioner of Patents made July 19, 1946 was arbitrary and capricious. It was made wholly outside of any jurisdiction, appellate, judicial, or ministerial, which he then had with respect to the subject matter of that order.

The judgment of the court below should be affirmed.

Respectfully submitted,

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September 20, 1947.

APPENDIX

APPENDIX.**STATUTES INVOLVED.**

Section 482 R. S. (44 Stat. 1335, approved March 2, 1927), U. S. C., Title 35, Sec. 7 is:

“The examiners in chief shall be persons of competent legal knowledge and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioner, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for reissues of patents and in interference cases. Each appeal shall be heard by at least three members of the board of appeals, the members hearing such appeal to be designated by the commissioner. The board of appeals shall have sole power to grant rehearings.”

Sec. 483, R. S. (U. S. C., title 35, sec. 6):

“The Commissioner of Patents, subject to the approval of the Secretary of Commerce, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.”

Section 4909 R. S. (U. S. C. Title 35, Sec. 57) prior to 1927 provided:

“Appeals; from primary examiners to examiners in chief. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief; having once paid the fee for such appeal.”

Section 5 of the Act of March 2, 1927 (44 Stat. 1335)¹ provided:

“That section 4909 of the Revised Statutes of the United States be amended by striking out the words

¹ The Act of March 2, 1927 (44 Stat. 1335) is set out in its entirety later in this appendix.

'board of examiners in chief' and substituting therefor the words 'board of appeals.' "

Section 4910 R.S., U.S.C. Title 35, Sec. 58, prior to 1927 provided:

"If such party is dissatisfied with the decision of the examiners in chief, he may, on payment of the fee prescribed, appeal to the commissioner in person."

Section 6 of the Act of March 2, 1927 (44 Stat. 1335) provided:

"That section 4910 of the Revised Statutes of the United States be, and the same is hereby, repealed."

Section 4904 R.S., U.S.C. Title 35, Sec. 52, prior to August 5, 1939 read as follows:

"Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and *shall direct the primary examiner to proceed* to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, * * * within such time not less than twenty days, as the commissioner shall prescribe."

By the Act of *August 5, 1939*, 53 Stat. 1212,² *Sec. 4904 R.S., U.S.C. Title 35, Sec. 52*, was amended to read as follows:

"Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and *shall direct a board of three examiners of interferences*

² The Act of August 5, 1939 is set out in its entirety later in this appendix.

to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor." *

Section 4911 R.S. was amended by the Act of March 2, 1927 (44 Stat. 1335) to read as follows:

"If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. *If any party to an interference is dissatisfied with the decision of the board of appeals*, he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4915 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said board of appeals shall be withheld pending the final determination of said proceeding under said section 4915."

Section 3 of the *Act of August 5, 1939* (53 Stat. 1212) provides:

"That section 4911 of the Revised Statutes (U.S.C. title 35, Sec. 59a) be amended by changing the words 'Board of Appeals' in the second sentence to read '*board of interference examiners*', and by canceling the last sentence of said section."

* The Act of August 5, 1939 substituted a Board of three Examiners of Interferences for the Primary Examiner and struck out all except first clause of the last sentence.

Section 4915 R.S., U.S.C. Title 35, Sec. 63 prior to Act of March 2, 1927 provided:

“Whenever a patent on application is refused, either by the *Commissioner of Patents* or by the Court of Appeals of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.”

By the *Act of March 2, 1927* (44 Stat. 1335) *Section 4915 R.S., U.S.C. Title 35, Sec. 63*, amended that statute as theretofore existing. For the clause ending with the first semicolon it substituted the following:

“Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; * * * ”

(At the end of the statute, the *Act of March 2, 1927* (44 Stat. 1335) added two sentences not here pertinent).

Section 4 of the *Act of August 5, 1939* (53 Stat. 1212) provided:

“That section 4915 of the Revised Statutes (U.S.C., title 35, Sec. 63) be amended by changing the first sentence thereof to read:

“ ‘Whenever a patent on application is refused by the Board of Appeals or *whenever any applicant is dissatisfied with the decision of the board of interference examiners*, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear.’ ”

ACT OF MARCH 2, 1927 (44 STAT. 1335-1336)

“CHAP. 273.—An Act Amending the statutes of the United States as to procedure in the Patent Office and in the courts with regard to the granting of letters patent for inventions and with regard to interfering patents.

“Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That Section 4894 of the Revised Statutes of the United States be amended by striking out the words ‘one year’ wherever they appear and substituting therefor the words ‘six months.’

“Sec. 2. That section 4897 of the Revised Statutes of the United States be amended by striking out the words ‘two years’ wherever they appear and substituting therefor the words ‘one year,’ and by striking out the words ‘And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact.’

“Sec. 3. That section 482 of the Revised Statutes of the United States be amended to read as follows:

“ ‘Sec. 482. The examiners in chief shall be persons of competent legal knowledge and scientific ability. The Commissioner of Patents, the first assistant commissioner, the assistant commissioner, and the examiners in chief shall constitute a board of appeals, whose duty it shall be, on

written petition of the appellant, to review and determine upon the validity of the adverse decisions of examiners upon applications for patents and for re-issues of patents and in interference cases. Each appeal shall be heard by at least three members of the board of appeals, the members hearing such appeal to be designated by the commissioner. The board of appeals shall have sole power to grant rehearings.'

"Sec. 4. That section 4904 of the Revised Statutes of the United States be amended by striking out from the last sentence thereof the words 'or of the board of examiners in chief, as the case may be.'

"Sec. 5. That section 4909 of the Revised Statutes of the United States be amended by striking out the words 'board of examiners in chief' and substituting therefor the words 'board of appeals.'

"Sec. 6. That section 4910 of the Revised Statutes of the United States be, and the same is hereby, repealed.

"Sec. 7. That section 9 of the Act of February 9, 1893, entitled 'An Act to establish a court of appeals for the District of Columbia, and for other purposes' (Twenty-seventh Statutes at Large, page 434), be, and the same is hereby, repealed.

"Sec. 8. That section 4911 of the Revised Statutes of the United States be amended to read as follows:

" 'Sec. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions

appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said board of appeals shall be withheld pending the final determination of said proceeding under said section 4915.'

"Sec. 9. That section 4912 of the Revised Statutes of the United States be amended by striking out the words 'Supreme Court of the District of Columbia' and substituting therefor the words 'Court of Appeals of the District of Columbia.'

"Sec. 10. That section 4913 of the Revised Statutes of the United States be amended by striking out the words 'And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded.'

"Sec. 11. That section 4915 of the Revised Statutes of the United States be amended to read as follows:

" 'Sec. 4915. Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office

shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

“Sec. 12. That section 4918 of the Revised Statutes of the United States be amended to change the phrase ‘may adjudge and declare either of the patents void in whole or in part’ to read as follows: ‘may adjudge and declare either or both of the patents void in whole or in part, upon any ground.’

“Sec. 13. That section 4934 of the Revised Statutes of the United States be amended by striking out the following words: ‘On an appeal for the first time from the primary examiners to the examiners in chief, \$10. On every appeal from the examiners in chief to the commissioner, \$20,’ and substituting therefor the words ‘on an appeal for the first time from the primary examiners to the board of appeals, \$15. On every appeal from the examiner of interferences to the board of appeals, \$25.’

“Sec. 14. That where the day, or the last day, fixed by statute for taking any action or paying any fee in the United States Patent Office falls on Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

“Sec. 15. That this Act shall take effect two months after its approval; but it shall not affect appeals then pending and heard before the examiners in chief or pending before the Commissioner of Patents or in the Court of Appeals of the District of Columbia, and that in all cases in which the time for appeal from a decision of the examiners in chief or of the Commissioner of Patents or for amendment or renewal of application had not expired at the time this Act takes effect, appeals and other proceedings may be taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended or repealed.

“Approved, March 2, 1927.”

ACT OF AUGUST 5, 1939 (H.R. 6837) 53 STAT. 1212.

"To amend sections 4904, 4909, 4911 and 4915 of the Revised Statutes (U.S.C., title 35, secs. 52, 57, 59A and 63).

"Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 4904 of the Revised Statutes (U.S.C., title 35, sec. 52) be amended to read as follows:

" 'Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.'

"Section 2. That section 4909 of the Revised Statutes (U.S.C., title 35, sec. 57) be amended to read as follows:

" 'Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.'

"Sec. 3. That section 4911 of the Revised Statutes (U.S.C., title 35, sec. 59a) be amended by changing the words 'Board of Appeals' in the second sentence to read 'board of interference examiners', and by canceling the last sentence of said section.

"Sec. 4. That section 4915 of the Revised Statutes (U.S.C., title 35, sec. 63) be amended by changing the first sentence thereof to read:

" 'Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is *dissatisfied with the decision of the board of interference examiners*, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof,

on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear.'

"Sec. 5. That this Act shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

"Approved, August 5, 1939."

Sec. 4914. R. S. (U. S. C., Title 35, Sec. 62.) The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

PATENT OFFICE RULES INVOLVED, NOT INCLUDED IN APPELLANT'S BRIEF.

Rule 97:

"When an interference is found to exist and the applications are prepared therefor, the primary examiner shall forward to the interference division the files and drawings; notices of interference for all the parties (as specified in rule 103) disclosing the name and residence of each party and those of his attorney or agent, and of any assignee, and, if any party be a patentee, the date and number of the patent; the ordinals of the conflicting claims and the title of the invention claimed; and the issue, which shall be clearly and concisely defined in so many counts or branches as may be neces-

sary in order to include all interfering claims. Where the issue is stated in more than one count the respective claims involved in each count shall be specified. The primary examiner shall also forward a statement *disclosing the applications involved in interference, fully identified, arranged in the inverse chronological order of the filing of the completed applications*, and also disclosing the issue or issues and the ordinals of the conflicting claims, the name and residence of any assignee, and the names and residences of all attorneys or agents, both principal and associate."

Rule 101:

"Upon the institution and declaration of the interference, as provided in rule 102, *the examiner of interferences will take jurisdiction* of the same, which will then become a contested case."

Rule 102:

"When the notices of interference are in proper form, the examiner of interferences shall add thereto a designation of the time within which the preliminary statements required by rule 110 must be filed, and shall, pro forma, institute and declare the interference by forwarding the notices to the several parties to the proceeding."

Rule 124:

"No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

"Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable."

(Rule 124 went into effect as above October 5, 1939, the day upon which the Act of August 5, 1939 (53 Stat. 1212) went into effect. For years prior to the passage of the Act of March 2, 1927 (44 Stat. 1336) Rule 124 read thus:

"124. Where, on motion for dissolution, the law examiner renders an adverse decision upon the merits of

a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the *Examiners in chief in the first instance* and will be heard *inter partes*. If the appeal be not taken within the time fixed, it will not be entertained except by permission of the Commissioner.

"No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same.

"Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable."

Upon the passage of the Act of March 2, 1927, Rule 124 was amended by striking out the words "examiners in chief in the first instance" and substituting therefor the words "Board of Appeals." In other respects Rule 124 remained unchanged until October 5, 1939. It was then put in its present form.

Rule 159:

"Evidence touching the matter at issue will not be considered on the hearing which shall not have been taken and filed in compliance with these rules. But notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that, as soon as the party became aware of the ground of objection, he gave notice thereof to the office, and also, to the opposite party, informing him at the same time that, unless it be removed, he (the objector) will urge his objection at the hearing. *This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office.*"

REPLY BRIEF FOR THE APPELLANT

United States Court of Appeals

DISTRICT OF COLUMBIA

APPEAL NO. 9574

LAWRENCE C. KINGSLAND, COMMISSIONER OF PATENTS,
APPELLANT

v.

CARTER CARBURETOR CORPORATION, APPELLEE

APPEAL FROM THE JUDGMENT OF THE DISTRICT COURT OF
THE UNITED STATES FOR THE DISTRICT OF COLUMBIA

W. W. COCHRAN,

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*United States Court of Appeals
for the District of Columbia*

FILED NOV 28 1947

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REPLY BRIEF FOR THE COMMISSIONER OF PATENTS

ISSUES RAISED BY APPELLEE'S BRIEF

The brief of the appellee seems to narrow the issues in some respects and to seek to extend them in others. Thus, on page 27 of the brief it is stated that "the Commissioner of Patents has, in many cases, power and jurisdiction under his general supervisory power to review and reverse orders made ministerially, *judicially or quasi-judicially*, by any Patent Office tribunal" [italics added]. This appears to be a clear concession that the lower court's twelfth conclusion of law, which holds that supervisory authority does not extend to judicial or quasi-judicial acts, is incorrect or, at least, does not apply to the Commissioner of Patents.

Further, the appellee's brief, pages 41 and 42, dismisses a number of decisions involving the question of the Commissioner's jurisdiction under his supervisory authority as not being pertinent because they were rendered prior to 1927; and on page 27 of the brief the following statement appears:

* * * for the Act of 1927 and 1939 and Rules 97, 101, 116, 122, 124 and 159 *deprived* the Commissioner of jurisdiction to make an order having the scope and effect of his order of July 19, 1946. Having been *deprived* by those statutes and rules of jurisdiction to make that order * * * [italics added].

A similar statement appears on page 17 of the brief. Since the Commissioner obviously could not be deprived of jurisdiction which he did not possess these statements clearly amount to admissions that the Commissioner, prior to 1927, had jurisdiction to make the kind of order which he made in this case. The issue as to jurisdiction is therefore narrowed to whether or not anything has happened since 1927 to change this situation.

On the other hand, the appellee's brief appears to argue at great length that the action taken by the Commissioner was improper even if it was within his jurisdiction. The lower court made no finding as to whether or not the Commissioner's action, on its merits, was proper. That court's findings are limited to the question of jurisdiction. However, this matter is discussed in the appellant's main brief, and will be briefly considered further herein.

The supervisory authority of the Commissioner has not been changed since 1926

As to whether the Acts of 1927 and 1939 affected the Commissioner's supervisory authority, this Court's decision in *Wigton v. Coe*, 62 App. D. C. 367, 68 F. 2d 414, which is discussed at length in appellant's main brief, is thought to be controlling. Appellant has cited no decision of this Court overruling or modifying the holdings made in that case, and such holdings obviously apply equally well to the Act of 1939 as to that of 1927. The action taken by the Commissioner in the *Wigton* case, and held proper by this Court, was clearly a much more direct interference with the right of the lower tribunal to determine priority than was the action taken in the present case.

In no less than four different places in the Appellee's brief (pp. 24, 37, 39, and 41) language is used which clearly gives the impression that prior to the amendment of Rule 124 on October 5, 1939, the Patent Office Rules permitted an appeal from a decision on a motion to shift the burden of proof, and that the amendment to Rule 124 was designed to eliminate this appeal. Thus, on page 24 of the brief it is said that:

* * * Upon the adoption of that rule [Rule 124 as amended October 5, 1939] the Commissioner's judicial powers, with respect to motions to shift the burden of proof in interference cases, were at an end.

This language seems to admit of no other interpretation than that the amendment to Rule 124 elimi-

nated an appeal on motions to shift which had previously been permitted, and this is true of similar statements appearing on pages 37, 39, and 40 of the brief.

As a matter of fact, however, appeals from decisions on motions to shift the burden of proof have been expressly prohibited by the Rules of Practice of the Patent Office, continuously from February 28, 1905, until the present time.

The final paragraph of Patent Office Rule 122 as revised February 28, 1905, was as follows:

Motions to shift the burden of proof should be made before and will be determined by the examiner of interferences. No appeal from the decision on such motion will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

A similar provision forbidding appeal was continuously retained in Rule 122 through the revision of February 1, 1939. At the last-mentioned time, the final paragraph of this rule was as follows:

At the hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. No interlocutory appeal from the decision on a motion to shift the burden of proof will be entertained, but the matter may be reviewed at final hearing and on appeal.

It may also be noted that the Commissioner's decision in *Raulet and Nicholson v. Adams*, 1905 C. D. 55,

114 O. G. 1827, which was rendered in 1905 and which is one of the authorities relied on by the appellee, expressly states that "no appeal will be permitted" from a decision on a motion to shift the burden of proof.

The amendment to the Rules on October 5, 1939, on which the appellee seems to base its case to such a large extent, had no effect on the right of appeal from decisions on motions to shift the burden of proof, but merely transferred the prohibition against such appeals from Rule 122 to Rule 124. The reason for this transfer was that appeals from all other motions under Rule 122 were abolished in the revision of October 5, 1939, and it was convenient to group all such motions together in Rule 124. The revision clearly was not designed to effect any change in the practice as to appeals from decisions on motions to shift the burden of proof.

Moreover, as pointed out in appellant's main brief, the Commissioner could not, even if he so desired, limit his supervisory powers by rule, since his right to make rules is limited (R. S. 483) to rules which are "not inconsistent with law," and since the law (R. S. 481) requires him to "superintend or perform all duties respecting the granting and issuing of patents directed by law."

Since the Commissioner's supervisory authority has not been and could not be limited by any change in the rules, and since it has not been modified by any of the changes in the statutes since 1926, it follows that such authority is now the same as it was in 1926,

at which time, as conceded by the Appellee, the type of action here complained of might, if sound as to its merits, properly have been taken.

Rule 124 does not apply to the present situation

Rule 124 relates to an appeal from "a decision rendered on a motion brought under the provisions of Rules 109 and 122." Appellee's brief seems to assume that the action of the examiner of interferences in refusing to set a motion for hearing because it is not in proper form is a decision of the type contemplated by Rule 124. However, Rule 122 provides that motions to shift the burden of proof "will be heard and determined by the primary examiner," and it is clearly this determination, rather than the preliminary formal ruling by the examiner of interferences, which constitutes the decision mentioned in Rule 124. No such decision has been made in this case, and the rule, therefore, does not apply.

The appellee's brief generally fails to recognize the distinction between appeals and supervisory action by the Commissioner either in response to petitions or on his own volition. This distinction is fully discussed in the appellant's main brief, but it is desirable to insert here a quotation from the decision of this Court in *Moore et al. v. United States ex rel Chott*, 40 App. D. C. 59, which clearly shows that the lack of a right of appeal from a decision does not deprive the Commissioner of his supervisory authority. The quotation is as follows:

In *ex parte* cases the public is represented by the Commissioner. No right of appeal is pro-

vided from the decision of the Primary Examiner or the Board of Examiners-in-Chief in behalf of the public. It cannot be that one or both of these tribunals is given final jurisdiction to an extent which forbids any review by the Commissioner; for appeal only lies from the action of the Commissioner when the Commissioner, as executive head of the Bureau has been satisfied that an error has been committed by which the public will be damaged."

The Commissioner's action was proper on its merits

The appellee argues that the Commissioner is in effect treating the decision of the District Court in *Bendix v. Coe*, Civil Action No. 20,023 as *res judicata* here. That decision held Hunt to be entitled to a filing date prior to that of any of his opponents in the interferences here involved. Actually, the Commissioner (Joint App. 35) expressly stated that this decision was not *res judicata* as to Coffey, and that Coffey was entitled to attack it. The Commissioner merely held that until the decision had been successfully attacked it was to be presumed to be correct and that the burden of proof should have been fixed in accordance with this presumption. This was clearly proper. At the time when the interferences were declared, there was, of course, no evidence therein to show that the Court's decision was wrong, and it obviously could not be presumed to be wrong merely because Coffey was entitled to attack it.

It is also to be noted that, as stated by the Commissioner (Joint App. 35) the holding of the District

Court that the claims involved in the present interferences are patentable to Hunt was based on the holding that Hunt was entitled to the benefit of the earlier joint filing date. If Hunt is not so entitled, these claims are unpatentable to him, and the interferences should not have been declared. Accordingly, the declaration of the interferences involved an acceptance of this holding of the District Court as *prima facie* correct; and it would clearly be illogical to fix the burden of proof in these same interferences on a contrary supposition. The appellee does not seem to argue that the Patent Office could properly have disregarded the District Court's decision to the extent of refusing to declare the interference at all, but this would be the logical conclusion to which his argument on the effect of that decision would lead. Manifestly it was improper to declare an interference on the assumption that Hunt was entitled to the earlier filing date and to fix the burden of proof in the interference on the assumption that he was not so entitled. This, however, is exactly what was done by the examiner, and this anomalous situation will continue unless the decision here appealed from is set aside.

Interferences Nos. 82554 and 82555

In these two interferences, no action was taken by the Commissioner. The examiner of interferences, on his own initiative and in view of the Commissioner's action in interference No. 82262, made Hunt the senior party. The District Court's Order in the present case, therefore, does not direct the Commissioner to

vacate any action which he has taken *in these interferences*, but requires him to instruct the interference examiner to vacate the action taken by him. [Italics added.] This holding was made despite the fact that the District Court has held that the Commissioner has no jurisdiction to issue such instructions on his own initiative.

The appellee's brief seeks to justify this action on the theory that the Commissioner acted outside his jurisdiction in interference No. 82262, and that he can be required to undo the effects of that action. It seems evident, however, that the remedy for one action outside jurisdiction cannot be the requirement of another such action. If the Commissioner is without jurisdiction to take an action, the District Court cannot confer such jurisdiction upon him, and if he cannot control the actions of the interference examiner on his own initiative, no matter how flagrantly wrong such actions may be, then he cannot do so at the instance of the Court.

If the theory of jurisdiction urged by the appellee and adopted by the District Court is correct, then the actions as to interferences Nos. 82,254 and 82,255 should have named the examiner of interferences as defendant. The fact that the examiner relied on a decision of the Commissioner which was allegedly made without jurisdiction is not material. If the supervision of interlocutory actions in interferences is to be by the District Court, rather than by the Commissioner, then that Court should issue its instructions to the examiners directly rather than to the

Commissioner who, the Court holds, has no jurisdiction over their quasi-judicial actions.

Respectfully submitted.

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OCTOBER 1947.

